

REMARKS

Claims 1-3, 5-19, 21-27, and 54-59 were presented for examination and were rejected.

In the second numbered paragraph of her non-final Office Action, the Examiner rejected claims 1, 2, 5-19, 21-27, and 54-59 under 35 U.S.C. §102(e) as being anticipated by Lachman, III et al., U.S. patent publication no. 2002/0166063 (hereinafter "Lachman 2").

In the fourth numbered paragraph of her non-final Office Action, the Examiner rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Lachman 2 in view of U.S. patent 5,710,757 to May (hereinafter "May").

Applicants are hereby amending claims 1, 7-10, 18, 21, 22, and 54-59; and canceling claim 6. Support for all amendments is found in the application as originally filed. Reconsideration of the application as amended, and allowance of all claims remaining herein, claims 1-3, 5, 7-19, 21-27, and 54-59 as amended, are hereby respectfully requested in light of the following arguments:

I. THE EXAMINER'S USE OF LACHMAN 2 AS PRIOR ART AGAINST THE INSTANT APPLICATION IS IMPROPER.

Lachman 2, filed February 28, 2002, claims priority to U.S. provisional patent application serial no. 60/272,712, filed March 1, 2001 (hereinafter "Lachman 1"). Lachman 2 has a publication date of November 7, 2002, which date is also the earliest date by which the public had access to either Lachman 1 or Lachman 2. 35 U.S.C. §122(a). Applicants note that Lachman 2, according to the USPTO's PAIR database, has been abandoned since at least June

25, 2007. The filing date of the instant application is October 19, 2001, which date falls between the filing dates of Lachman 1 and Lachman 2, and precedes both the filing date and the publication date of Lachman 2.

The Examiner's position, expressed at numbered paragraph 2 and at page 11 of the Office Action, is that Lachman 2 is a 35 U.S.C. §102(e) reference that may be used as prior art against the instant application. This position is flawed, for at least the following reasons.

A. The Examiner used the wrong legal standard to determine that subject matter in Lachman 2 is prior art that may be used against the instant application.

The Examiner's position is presented at page 11 of the Office Action:

“(a) The provisional application, Lachman I (60/272,712), for which Lachman III (US Patent Application Publication 2002/0166063 A1) claims benefit discloses subject matter which is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application (US Patent Publication 2002/0166063 A1) was filed, had possession of the claimed invention. Therefore, Lachman III can be used as prior art against the instant application.” Office Action, p. 11, underlining added.

The above statement is ambiguous, at least because the Examiner failed to state which of the two specifications is intended in the underlined phrase “the specification.” The ambiguity is particularly significant because the disclosures of Lachman 1 and Lachman 2 are significantly different: Lachman 2, having a 16,000 word specification and including 40 Figures, evidently contains substantial new matter relative to Lachman 1, which is only 6,000 words in length and includes only 13 Figures.

As best understood by Applicants, the Examiner may be contending that the written description in Lachman 1 demonstrated that the Lachman 2 inventors were in possession, as of the filing date of Lachman 2, of the invention claimed in Lachman 2 and, therefore, Lachman 2 can be used as prior art against the instant application. The Examiner appears to be invoking the rule discussed at MPEP 2163 I (citing Capon v. Eshhar, 418 F. 3d 1349, 1357) that an application's written description is required to demonstrate that the patentee was in possession of the invention as claimed in the application. As detailed below, meeting this written description requirement is a necessary but far from sufficient condition for Lachman 2 to be used as prior art against the instant application.

For Lachman 2 to be prior art to the instant application, it must be accorded a 102(e) critical reference date as of Lachman 1's filing date. As explained at MPEP 2136.03 III, this means, as a threshold matter, that Lachman 2 must be entitled to the benefit of the filing date of Lachman 1. To be so entitled, Lachman 1 must meet ***all of*** the requirement of 35 U.S.C. §112, first paragraph, with respect to the claims of Lachman 2, not just the written description requirement. 35 U.S.C. §119(e)(1). Furthermore, Lachman 1 must meet ***all of*** the requirements of 35 U.S.C. §112, first paragraph with respect to the subject matter relied upon in making the rejection. MPEP 2136.03 III.

As required by 35 U.S.C. §119(e)(1), in order for Lachman 2 to be entitled to the benefit of Lachman 1's filing date, Lachman 1 must disclose the invention claimed in Lachman 2 "in the manner provided by the first paragraph of section 112". This requirement of §119(e)(1) compels more than a mere showing that the applicants were "in possession of" the invention claimed in

Lachman 2 at the time of filing Lachman 2. It requires that **Lachman 1** fully comply with the written description, enablement, and best mode requirements of the first paragraph of §112. In her Office Action, the Examiner failed to even assert that the invention claimed in Lachman 2 is disclosed in Lachman 1 in the manner provided by the first paragraph of §112.

Finally, even if the claims in Lachman 2 were adequately supported in the written description of Lachman 1, yet more is required: Lachman 2 may be accorded a 102(e) critical reference date as of Lachman 1's filing date only if, in addition, Lachman 1 properly supports the *subject matter relied upon to make the rejection* in compliance with 35 U.S.C. §112, first paragraph. MPEP 2136.03 III. In her Office Action, the Examiner failed to even assert that the subject matter relied upon in making the rejection (taken from Lachman 2) is properly supported in Lachman 1.

The Examiner rejected claims 1, 2, 5-19, 21-27, and 54-59 under 35 U.S.C. §102(e) as being anticipated by Lachman 2. For the reasons given above, the Examiner's assertion that Lachman 2 may be used as prior art against the instant application is flawed. As a result, the Examiner has failed to establish a *prima facie* case of anticipation.

For the above reasons, Applicants hereby request the Examiner to withdraw her §102(e) rejections and to allow claims 1, 2, 5, 7-19, 21-27, 54-59 as amended.

The Examiner rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Lachman 2 in view of May. Claim 3 is a dependent claim depending upon claim 1. As demonstrated above, a *prima facie* case of anticipation with respect to claim 1 has not been

established. The addition of May to the rejection does nothing to counter the patentability of claim 1. Therefore, it follows that claim 3 is patentable.

For the above reasons, Applicants hereby request the Examiner to withdraw her §103(a) rejection of claim 3, and to allow claim 3 as amended.

B. Lachman 2 is not properly accorded a 102(e) critical reference date as of Lachman 1's filing date.

As discussed above, the Examiner failed to meet her burden of establishing a *prima facie* case for the rejections, because she failed to demonstrate, or even assert, that Lachman 1 provides §112, first paragraph, support for the claims of Lachman 2 and the subject matter relied upon in making the rejections. Even assuming, *arguendo*, that Lachman 1 did somehow provide the requisite support, the rejection would still be improper, at least because it is improper to accord Lachman 2 with a 102(e) critical reference date as of Lachman 1's filing date.

Applicants are aware of the USPTO examination guidelines, first published in the January 14, 2003 Official Gazette, stating:

“The 102(e) date of a reference ... is its earliest effective U.S. filing date, taking into consideration any *proper* priority or benefit claims to prior U.S. applications under 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection.” Examination Guidelines for 35 U.S.C. §102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. §102(g), Discussion Section IV(4)(b), emphasis added, copy provided herewith (Enclosure 1).

For the reasons detailed hereinbelow, this policy is inadequate to support the Examiner's position that Lachman 2 may be used as prior art against the instant application.

1. Courts have strictly limited the circumstances in which “secret” references are allowed to defeat an applicant’s patent right.

35 U.S.C. §102(e) provides for a limited exception to the general rule that a prior art reference must be publicly accessible. Prior to the enactment in 1999 of the American Inventors Protection Act (hereinafter, the “AIPA”), 35 U.S.C. §102(e) simply codified the U.S. Supreme Court rule of Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390 (1926) in providing that a person shall be entitled to a patent unless (*inter alia*):

“(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent...”.

The rule of Milburn, and §102(e) as it existed prior to the AIPA, was summarized by Judge Giles Rich as follows:

“...a complete description of an invention in a U.S. patent application, filed before the date of invention of another, if it matures into a patent, may be used to show that that other was not the first inventor.” In re Hilmer, 359 F. 2d 859, 877 (CCPA 1966); hereinafter, “Hilmer I”, copy provided herewith (Enclosure 2).

In Milburn, a copy of which is provided herewith (Enclosure 3), an earlier-filed patent application disclosing the invention claimed in a later-filed patent application did not issue (and was not publicly available) until after the filing date of the later-filed application. The Supreme Court assumed there “would have been no bar to [the later filer’s] patent if [the earlier filer] had written out his prior description and kept it in his portfolio uncommunicated to anyone”. Milburn at 400. But because the first filer “had done all that he could do to make his description public... [and] had taken steps that would make it public as soon as the Patent Office did its

work”, the earlier filed application defeated the later filer’s patent rights, even though it was not publicly available at the time the later application was filed Id at 401. Judge Rich, in another CCPA opinion, summarized the rationale of the Milburn holding as “that ‘but for’ the delays in the Patent Office, the patent would have earlier issued and would have been prior art known to the public.” In re Wertheim and Mishkin, 646 F. 2d 527, 536 (CCPA 1981), copy provided herewith (Enclosure 4).

As widely referred to in numerous subsequent cases, the so-called Milburn Doctrine is an exception to the general rule that prior knowledge must be public in order to defeat another’s patent rights. Ex parte Osmond, 191 U.S.P.Q. (BNA) 334, 337 (USPTO BPAI 1973), copy provided herewith (Enclosure 5). The Milburn Doctrine has been “held to be limited to its own factual situation and that in order to be applicable a patent must issue.” Id.

Here, the relevant facts are inapposite to the Milburn “factual situation”, at least because the filing of Lachman 1 did nothing to make the disclosure thereof public. On the contrary, the applicant in Lachman 1 merely preserved for twelve months the option of filing a utility patent application claiming the benefit of Lachman 1, while also preserving the opportunity to benefit from the provisions of 35 U.S.C. §122 and avoid disclosing its contents to the public. At least because the Lachman 1 applicants failed to do all that they could do to make their description public, Lachman 1 is not properly available, under Milburn, as a reference.

2. Courts have rejected past attempts by the USPTO to “read together” provisions of 35 U.S.C. §102(e) and 35 U.S.C. §119.

Only by conflating the priority-granting provisions of §119 with the patent-defeating provisions of §102(e) is it possible to conclude that Lachman 2 should be accorded a 102(e) critical reference date prior to Applicants’ filing date. This “reading together” of §119 and §102(e) was strongly criticized by the court’s holding in Hilmer I:

“We see no reason for reading these two provisions together and the board has stated none. We believe, with the dissenting board member, that 119 and 102(e) deal with unrelated concepts and further that the historical origins of the two sections show neither was intended to affect the other, wherefore they should not be read together in violation of the most basic rule of statutory construction, the “master rule,” of carrying out the legislative intent. Additionally, we have a long and consistent administrative practice in applying an interpretation contrary to the new view of the board, confirmed by legislation ratification in 1952.” Hilmer I at 872.

Hilmer I, of course, was decided before §119 was amended by adding subsection (e) providing for provisional applications. As discussed below, nothing suggests a legislative intent, when adding subsection (e) to section 119, to overturn Hilmer I by authorizing “reading together” §102(e) and §119(e).

3. Under the USPTO’s Board of Patent Appeals and Interferences precedent, Lachman 2 is entitled to an effective date as a reference only as of its publication date, not its filing date, much less the Lachman 1 filing date.

Judge Rich’s analysis in Hilmer 1 demonstrated the error in reading §119 and §102(e) together to accord an effective date to a reference that was earlier than the reference’s actual U.S. filing date. In light of Board of Patent Appeals and Interferences (BPAI) precedent, Lachman 2, moreover, should not be accorded an effective date earlier than Lachman 2’s **publication** date.

The BPAI has held that subsequent publication of an abandoned U.S. patent application is not evidence of prior knowledge as of the filing date of such application. Ex parte Osmond at 338. Rather, a disclosure in such an application is evidence of prior knowledge only as of the date by which public access to the disclosure is first provided. Id. There is no policy reason why a U.S. patent application that is published and then abandoned should have a different prior art effect than a U.S. patent application that was first abandoned, and then published. Here, Lachman 1 and Lachman 2 were first published after Lachman 1's expiration; then Lachman 2 was abandoned after the publication date. Under Ex parte Osmond, the effective date of Lachman 2 is its publication date, not its filing date, because that is the date when public access to the disclosures was first provided.

4. Statutory revisions providing for provisional applications and 18 month publication rules should be construed narrowly in light of the Milburn Doctrine, Hilmer I, and related cases.

a) The [GATT] Uruguay Round Agreements Act (hereinafter, the "1994 Act")

The 1994 Act amended, *inter alia*, 35 U.S.C. §111 and §119 to provide respective subsections §111(b) and §119(e) relating to U.S. provisional patent applications. The 1994 Act did not amend §102(e). Nor was any legislative intent expressed to overturn the case law discussed above.

Nevertheless, according to the USPTO, under the 1994 Act,

"Section 119(e)(1) of title 35, United States Code, provides that if all of the conditions of 35 U.S.C. 119 (e)(1) and (e)(2) are met, an application for patent filed under 35 U.S.C. 111(a) or 363 shall have the same effect as though filed

on the date of the provisional application. Thus, the effective United States filing date of an application for patent filed under 35 U.S.C. 111(a), and entitled to benefits under 35 U.S.C. 119(e), is the filing date of the provisional application. Any patent granted on such an application, is prior art under 35 U.S.C. 102(e) as of the filing date of the provisional application.” 60 FR 20195, 20197 (1995), emphasis added, copy provided herewith (Enclosure 6).

This interpretation of the legal effects of the 1994 Act, provided in the “Supplemental Information” section of the Federal Register dated April 25, 1995 entitled “Changes to Implement 20-Year Patent Term and Provisional Applications”, is noteworthy in two respects. First, the interpretation fails to cite a legal authority, or make reference to stated legislative intent, for directly contravening Hilmer I by “reading together” provisions of Section §119 and §102(e). Second, the USPTO’s interpretation of the 1994 Act provides only that a “*patent granted* on such an application, is prior art under 35 U.S.C. 102(e) as of the filing date of the provisional application.” The statement provides no authority for the present Office Action, which rejects claims on the basis of an *unissued* (in fact, *abandoned*) patent *application*.

As to the first point, it must be presumed that Congress, when adapting the 1994 Act, was aware of Hilmer I, and the respective legislative histories of 35 U.S.C. §119 and §120. Prior to 1994, §119 addressed only foreign priority, whereas §120 dealt with domestic priority. Although §120 and §119 employ an identical phrase, “shall have the same effect, as to such invention”, the court in Hilmer I, after a painstaking analysis of the legislative history of each section, dismissed the use of the same expression as “mere happenstance”. Hilmer I at 879. Furthermore, Hilmer I specifically disapproved of the USPTO’s position that the expression “shall have the same effect, as to such invention” should have the same meaning with respect to §120 domestic priority as to §119 foreign priority. In adapting the 1994 Act, Congress chose to modify §119, not §120, even

though provisional applications, as domestic filings, might more logically be related to the latter section. As at least one commentator has observed, however,

“Provisional applications have in common with foreign priority applications a feature not shared by regular §111(a) applications: provisional applications, like foreign priority applications, can never become a U.S. patent.” Patch, Andrew J., Provisional Applications and 35 U.S.C. 102(e) in View of *Milburn, Hilmer and Wertheim*, 77 J. Pat. & Trademark Off. Soc’y 339, 346 (1995), copy provided herewith (Enclosure 7).

In light of the foregoing, and in the absence of evident legislative intent to the contrary, the USPTO’s interpretation of the 1994 Act at 60 FR 20195, 20197 (which was not implemented by way of any amendment to CFR Title 37) is untenable.

In addition, as noted above, the USPTO pronouncement addressed only the prior art effect of an *issued patent* claiming priority to a provisional application, notwithstanding public comments relating to a broader question:

“13. Comment: Several comments requested that the PTO clarify whether a 35 U.S.C. 111(a) application will be accorded an effective date as a reference under 35 U.S.C. 102(e) as of the filing date of the provisional application for which benefit under 35 U.S.C. 119(e) is claimed...

Response: If a patent is granted on a 35 U.S.C. 111(a) application claiming the benefit of the filing date of a provisional application, the filing date of the provisional application will be the 35 U.S.C. 102(e) prior art date. A pending application will be rejected under 35 U.S.C. 102(e) on the basis that an invention was described in a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application by another filed in the U.S. before the invention thereof by the applicant for patent.” 60 FR 20195, 20206 (1995), emphasis added.

First, Applicants note that this response, for the reasons discussed above, is an inaccurate interpretation of the law. Nor was the rule implied by this response ever implemented by an

amendment to CFR Title 37. Second, although the comment requested clarification as to the effective date as a 102(e) reference of an *application* claiming the benefit of the filing date of a U.S. provisional patent application, the response provided the USPTO's position as to the effective date "If a patent is granted" on such nonprovisional application. It appears that the USPTO was cognizant, at least in 1995, that there was no authority for according a pending--not to mention an abandoned--patent application an effective date as a reference as of the filing date of the provisional application for which benefit under 35 U.S.C. §119(e) is claimed. Nothing in the 1994 Act suggested an intention to thus overrule the Milburn Doctrine. Consistent with that doctrine, where a reference is an unissued patent application--and particularly, an *abandoned* patent application--the effective date of that reference can only be the date at which the application became publicly accessible.

b) The AIPA

The AIPA amended, *inter alia*, 35 U.S.C. §102(e) to provide for eighteen-month publication of (some) patent applications. 35 U.S.C. §102(e) was amended to provide, in relevant part, that a person shall be entitled to a patent unless (*inter alia*):

"(e) the invention was described in -- (1) an application for patent, published under section 122(b) [35 U.S.C. §122(b)], by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent..."

To implement provisions of the AIPA and related technical amendments to §102(e), the USPTO promulgated examination guidelines signed December 11, 2002 published in the Official

Gazette on January 14, 2003 (the "Guidelines"). In Discussion Section IV(4)(b) of the Guidelines, the USPTO advised:

The 102(e) date of a reference ... is its earliest effective U.S. filing date, taking into consideration any proper priority or benefit claims to prior U.S. applications under 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection.

As discussed above, the Examiner has failed to even allege that Lachman 1 properly supports the subject matter (found in Lachman 2) used to make her rejection. Even assuming, *arguendo*, that the Examiner's rejections somehow complied with the Guidelines quoted above, the rejection is still fatally flawed, because the Guidelines themselves, which do not have the force of law, improperly construe the statutory language of §102(e) and §119(e) in derogation of the common law discussed above.

The Guidelines provide no authority--and Applicants are aware of none--for the proposition that §102(e) can be read together with §119(e) in contravention of Hilmer I. If the two provisions are not so conflated, then Lachman 2 can be accorded an effective date as a 102(e) reference no earlier than its own filing date. Indeed, under Osmond, Lachman 2 cannot be properly accorded an effective date earlier than Lachman 2's **publication** date. The Examiner provided no authority -- and Applicants are aware of none -- for her assumption that published applications, once abandoned, are even proper §102(e) references in the first instance. Treating such abandoned patent applications as §102(e) references produces the anomalous result that an application published after abandonment has an effective date as a reference as of its publication date (Osmond, *supra*), but that an application, abandoned after publication, has an effective date

as of its filing date. To avoid this anomaly, absent expressed legislative intent to the contrary, the language of 35 U.S.C. §102(e), “application for patent, published under section 122(b)” must be construed as not encompassing abandoned patent applications. Lachman 2, accordingly, is not a proper 35 U.S.C. §102(e) reference, but, rather, only a 35 U.S.C. §102(a) or §102(b) reference having an effective date as of its publication date (November 7, 2002).

The Examiner rejected claims 1, 2, 5-19, 21-27, and 54-59 under 35 U.S.C. §102(e) as being anticipated by Lachman 2. For the reasons given above Lachman 2 may *not* be accorded an effective date as a reference prior to its own publication date. Lachman 2’s publication date is later than the instant application’s filing date, so Lachman 2 may not be used as a prior art reference in the instant case. As a result, the Examiner has failed to establish a *prima facie* case of anticipation.

For the above reasons, Applicants hereby request the Examiner to withdraw her §102(e) rejections and to allow claims 1, 2, 5, 7-19, 21-27, and 54-59 as amended.

The Examiner rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Lachman 2 in view of May. Claim 3 is a dependent claim depending upon claim 1. As demonstrated above, a *prima facie* case of anticipation with respect to claim 1 has not been established. The addition of May to the rejection does nothing to counter the patentability of claim 1. Therefore, it follows that claim 3 is patentable.

For the above reasons, Applicants hereby request the Examiner to withdraw her §103(a) rejection of claim 3, and to allow claim 3 as amended.

II. LACHMAN 1 FAILS TO ANTICIPATE OR SUGGEST APPLICANTS' INVENTION AS PRESENTLY CLAIMED.

Even assuming, *arguendo*, that the disclosure of Lachman 1 may somehow properly be used as prior art against the instant application, Applicants' claims, for the reasons detailed below, are still allowable, because the disclosure of Lachman 1 fails to teach, or even suggest, the instant invention as presently claimed.

A. Claim 1, as amended, recites that a content portion of a data packet transiting a network access point is inspected by a data enabling device (DED) containing content match information; an inspected data packet is forwarded when information within the content portion of a data packet is not substantially similar to content match information; and when information within the content portion of a data packet is substantially similar to content match information, the inspected data packet is temporarily stored while the DED initiates issuance of a message to a user workstation, and invokes a regional transaction processor (RTP) to process a transaction, where the RTP authorizes forwarding of the data packet only when the transaction result indicates that said forwarding is appropriate.

Lachman 1 discloses techniques for passively detecting "denial of service" attacks and providing countermeasures to such attacks. Lachman 1, page 4, lines 4-6. As described in Lachman 1, data packets are screened by a packet sniffer, which compares incoming packets to a stored signature database, the signature database being derived from common denial of service attack patterns. Following receipt of a "suspicious" packet, the source address of the suspicious

packet may be traced, and defensive measures put in place to protect a host computer network from further attacks from that source.

Lachman 1 fails to disclose inspecting at least the content portions of data packets transiting a network access point, where each data packet has a content portion, a header, and a trailer.

Lachman 1 discloses that “packets are compared to a stored signature database” in the packet sniffing portion of the method (page 5 line 4), but is vague as to the definition of “signature”. In all of the examples in Lachman 1 that are relevant to the locations within the packets where the comparisons are performed, Lachman 1 discloses that the comparisons are performed in the header portions of the packets, as opposed to the content portions. Lachman 1, page 6 line 20, page 10 lines 20-22, page 11 line 5, page 12 line 4, page 13 line 16, page 13 line 21, page 14 line 4, page 14 line 19, and page 16 lines 22-23. This is not surprising, given that the purpose of Lachman 1 is to thwart denial of service attacks (Lachman 1, page 4 line 5). Indeed, the word “content” is used only once in the sixty-four paragraph disclosure of Lachman 1 (at page 4 line 19), and the word “payload” (synonymous with “content portion of a packet”) is not used anywhere.

Even assuming, *arguendo*, that Lachman 1 somehow suggests inspecting the content portion of a data packet, Lachman 1 specifically teaches away from inspecting packets *transiting a network access point*. According to Lachman 1, their A.N.T. system “sits between the host router and the main server on a protected network.” Lachman 1, page 11, lines 11-12. As such,

their A.N.T. is utterly incapable of inspecting packets transiting a network access point.

Compare Lachman 1, Figure 1 with Figure 1 of the instant application.

Lachman 1 fails to suggest that when information within the content portion of a data packet is substantially similar to content match information, a DED, disposed at a network access point, initiates issuance of a message to a user workstation and invokes an RTP to process a transaction, whereupon the RTP instructs the DED to forward or prevent forwarding the data packet based on a result of the transaction. In her Office Action at page 11, numbered paragraph 5 (b), the Examiner asserted that an A.N.T. system disclosed by Lachman 2 reads on Applicants' DED and that an "offensive countermeasure server" discussed in Lachman 2 reads on Applicants' RTP. In response to this assertion, Applicants first note that the disclosure of Lachman 1 fails to use the term "offensive countermeasure server" so it is not clear where, if at all, Lachman 1 discloses the item that the Examiner believes reads on Applicants' RTP. Second, Applicants note that, according to Lachman 1, an A.N.T. system "sits between the host router and the main server on a protected network." Lachman 1, page 11, lines 11-12. Accordingly, the A.N.T. system of Lachman 1, contrary to the DED of the present invention, is *not* disposed at a network access point.

B. Claims 2, 5, 7-17, and 54-59 depend from claim 1, and thus their patentability flows from the patentability of claim 1. Furthermore, these dependent claims include additional features that distinguish them from the prior art.

C. Claim 18 as amended contains substantially the same limitations that are recited in amended claim 1. Therefore, the arguments submitted above in favor of the patentability of claim 1 also pertain to the patentability of claim 18, mutatis mutandis.

D. Claims 19 and 21-27 are dependent claims depending upon claim 18. Therefore, their patentability flows from the patentability of claim 18. Furthermore, these dependent claims contain additional limitations not suggested by the prior art.

For the above reasons, Applicants hereby request the Examiner to withdraw her §102(e) rejections and to allow claims 1, 2, 5, 7-19, 21-27, and 54-59 as amended.

E. In the fourth numbered paragraph of her Office Action, the Examiner rejected claim 3 under Lachman 2 in view of U.S. patent 5,710,757 to May.

Claim 3 is a dependent claim depending upon claim 1. As demonstrated above, amended claim 1 is patentable. The addition of May to the rejection does nothing to counter the patentability of claim 1. Therefore, it follows that claim 3 is patentable.

For the above reasons, Applicants hereby request the Examiner to withdraw her rejection of claim 3, and to allow claim 3 as amended.

Applicants believe that this application is now in condition for allowance of all claims remaining herein, claims 1-3, 5, 7-19, 21-27, and 54-59 as amended, and therefore an early Notice of Allowance is respectfully requested. If the Examiner disagrees or believes that, for any

other reason, direct contact with Applicants' attorney would help advance the prosecution of this case to finality, she is invited to telephone the undersigned at the number given below.

Respectfully submitted,

date of signature: April 4, 2008



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enclosures

cc: IP/T docket CH (w. encl.)
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United States Patent and Trademark Office OG Notices: 14 January 2003



Examination Guidelines for 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. 102(g) (Revised i)

This notice sets forth the interpretation by the United States Patent and Trademark Office (USPTO or Office) of 35 U.S.C. 102(e) and 374, as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (H.R. 2215) (Pub. L. 107-273 (2002)). This notice also clarifies the Office's policy on prior art rejections based on 35 U.S.C. 102(g).

Generally, 35 U.S.C. 102(e), after enactment of the AIPA and H.R. 2215, is similar to the pre-AIPA 102(e), with two significant differences, which may be summarized as: (1) in addition to U.S. patents, now certain publications of U.S. and international applications may be applied as of their filing dates in a prior art rejection; and (2) certain international filing dates are now U.S. filing dates for prior art purposes under 102(e), and U.S. patents and certain application publications may now be applied as of these international filing dates in a prior art rejection.

Specifically, this notice provides guidance that prior art, as defined by 102(e) of the patent code in effect on November 29, 2000, includes U.S. patents, publications of U.S. patent applications and World Intellectual Property Organization's (WIPO) publications of international applications, provided such references do not directly or indirectly result from an international application filed before November 29, 2000. If a U.S. patent resulted from an international application filed before November 29, 2000, the U.S. patent will have a prior art date per 102(e) in effect prior to November 29, 2000, which is the earlier of the date of compliance with 371(c)(1), (2) and (4) of the patent code (e.g. National Stage entry) or the filing date of the later-filed U.S. application that claimed the benefit of the international application. A U.S. or WIPO publication of an international application filed prior to November 29, 2000 will have no prior art effect under 102(e). Such publications do, however, have prior art effect under 102(a) or (b) as of their publication dates.

Furthermore, all pending U.S. patent applications being examined, and all U.S. patents being reexamined, or otherwise being contested, whenever filed, are subject to the amended version of 102(e).

This notice also provides examples of the determination of 102(e) dates for references based on the most common factual scenarios. The examples that best highlight the recent change to 102(e) and 374 are the examples that involve a WIPO publication of an international application under PCT Article 21(2), a U.S. publication of an international application, or a U.S. patent derived from an international application.

Enclosure 1 to Amendment G - 10/037,593
(response to non final Office Action mailed Jan. 8, 2008)

The policy and practice set forth in the Official Gazette Notice entitled "Examination Guidelines for 35 U.S.C. 102(e)(2), as amended by the American Inventors Protection Act of 1999," 1243 O.G. 1037 (Feb. 27, 2001) and guidelines provided in the Manual of Patent Examining Procedure (MPEP) concerning the changes made by the AIPA to 35 U.S.C. 102(e) (e.g., MPEP 706.02(a), Part II; 901.03; 1895.01, Part E; 1896; and 2136 et seq., Eighth Edition (August 2001)) are superceded by this notice and should no longer be followed.

SIGNIFICANT PROVISIONS:

A. Effective Date Provisions of the Amendments.

The technical correction legislation in H.R. 2215 provides for the application of revised 35 U.S.C. 102(e) in the examination of all applications, whenever filed, and the reexamination of, or other proceedings to contest, all patents. The filing date of the application is no longer relevant in determining what version of 102(e) to apply in determining the patentability of that application, or the patent resulting from that application. The revised statutory provisions supercede all previous versions of 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000 (discussed further in section D below). Furthermore, the provisions amending 102(e) and 374 in H.R. 2215 are completely retroactive to the effective date of the relevant provisions in the AIPA (November 29, 2000).

B. U.S. and WIPO application publications may have a 102(e)(1) prior art date.

Paragraph (e) of 35 U.S.C. 102 was amended by the AIPA to create two separate clauses, namely, 102(e)(1) for publications of patent applications and 102(e)(2) for patents. Section 102(e)(1), in combination with amended 374, created a new category of prior art by providing prior art effect for certain publications of patent applications, including international applications, as of their effective United States filing dates (which will include certain international filing dates). Under H.R. 2215's revised 102(e), an international filing date, which is on or after November 29, 2000, is a United States filing date for prior art purposes under 35 U.S.C. 102(e) if the international application designated the United States and was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. Publication under PCT Article 21(2) may result from a request for early publication by an international applicant or after the expiration of 18-months after the earliest claimed filing date in an international application. An applicant that has designated only the U.S. would continue to be required to request publication from WIPO as the reservation under PCT Article 64(4) continues to be in effect for such applicants.

C. A patent from an international application may have a 102(e)(2) prior art date of its international filing date.

Paragraph (e) of 35 U.S.C. 102 was also amended by the AIPA to eliminate the reference to fulfillment of the 35 U.S.C. 371(c)(1), (2) and (4) requirements. As a result, United States patents issued directly from international applications filed on or after November 29, 2000 will no longer be available as prior art under 102(e) as of the date the requirements of 371(c)(1), (2) and (4) have been satisfied. Under 102(e)(2), as amended by the AIPA and H.R. 2215, an international filing date, which is on or after November

29, 2000, is a United States filing date for purposes of determining the earliest effective prior art date of a patent if the international application designated the United States and was published in the English language under PCT Article 21(2) by WIPO.

D. International filing dates prior to November 29, 2000 cannot be used under 102(e) for prior art purposes.

No international filing dates prior to November 29, 2000 may be relied upon as a prior art date under 102(e) in accordance with the last sentence of the effective date provisions (reproduced below in section I). Patents issued directly, or indirectly, from international applications filed before November 29, 2000 may only be used as prior art based on the provisions of 102(e) in effect before November 29, 2000. Thus, the date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371(c)(1), (2) and (4), or the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application. Publications of international applications filed before November 29, 2000 (which would include WIPO publications and U.S. publications of the National Stage (371)) do not have a 102(e) date at all. Specifically, under 374, the international application must be filed on or after November 29, 2000 for its WIPO publication to be "deemed a publication under section 122(b)" and thus available as a possible prior art reference under 102(e) as amended by the AIPA.

E. Additional requirements for international applications filed on or after November 29, 2000.

If an international application was filed on or after November 29, 2000, the international application must have designated the U.S. and been published in English under PCT Article 21(2) by WIPO in order for its international filing date to be a U.S. filing date for purposes of 102(e) and be relied upon as a prior art date.

F. When an international application cannot serve as a bridge to an earlier-filed application.

International applications, which: (1) were filed prior to November 29, 2000, (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e).

DISCUSSION: Sections I - V below set forth the USPTO's examination procedures for the amendments to 35 U.S.C. 102(e) made by the AIPA and H.R. 2215.

I) Statutory Language of 35 U.S.C. 102(e) and 374:

Pre-AIPA 102(e): Now, only applies to Patents derived from International Applications filed before November 29, 2000:

"A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent, or".

Revised 102(e): For examining all Applications, whenever filed, and

for reexamining of all Patents, and for determining the prior art dates ii of Patents and certain Application Publications:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

Pre-AIPA 374: For WIPO Publications of International Applications filed prior to November 29, 2000:

The publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.

Revised 374: For WIPO Publications of International Applications filed on or after November 29, 2000:

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in sections 102(e) and 154(d) of this title.

Effective Date Provisions for the amendments to 102(e) and 374 iii, as amended by H.R. 2215:

Except as otherwise provided in this section, sections 4502 through 4504 and 4506 through 4507, and the amendments made by such sections, shall be effective as of November 29, 2000, and shall apply only to applications (including international applications designating the United States) filed on or after that date. The amendments made by section 4504 shall additionally apply to any pending application filed before November 29, 2000, if such pending application is published pursuant to a request of the applicant under such procedures as may be established by the Director. Except as otherwise provided in this section, the amendments made by section 4505 shall be effective as of November 29, 2000 and shall apply to all patents and all applications for patents pending on or filed after November 29, 2000. Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.

II) Impact of Statutory Changes and Effective Date of the Changes

As shown above, 35 U.S.C. 102(e) has been amended to have two separate clauses, namely, (e)(1) for publications of patent applications, and (e)(2) for patents.

With respect to revised 35 U.S.C. 102(e)(1) and 35 U.S.C. 374, a new

category of prior art is created for publications of patent applications. This new category includes the following two types of published patent applications:

(1) U.S. publications of patent applications filed in the United States by another which are published under 122(b) of title 35, United States Code; and

(2) U.S. and WIPO publications of international applications, filed on or after November 29, 2000, by another that designated the United States and were published in the English language under PCT Article 21(2) by WIPO.

In summary, under amended 102(e)(1) and 374, certain publications of patent applications, including certain WIPO publications of international applications (under PCT Article 21(2)) which are filed on or after November 29, 2000, are considered to be prior art as of their earliest effective United States filing date. It is important to note that a U.S. application publication of a National Stage of an international application or a WIPO publication of an international application under 102(e)(1) and 374, as amended by H.R. 2215, can be prior art as of the international filing date if the international application had an international filing date on or after November 29, 2000, designated the United States, and was published in English under PCT Article 21(2) by WIPO. Prior to the AIPA amendments to 102(e) and 374, a WIPO publication of an international application could only be prior art under 102(a) or (b) as of the publication date (and there were no U.S. application publications).

Paragraph (e) of 35 U.S.C. 102 was also amended to modify what U.S. patents are available as prior art under this subsection. Section 102(e)(2) no longer recognizes the date of fulfillment of the 35 U.S.C. 371(c)(1), (2) and (4) requirements for prior art purposes. Section 102(e)(2), however, considers an international filing date that is on or after November 29, 2000 as a United States filing date for purposes of determining the earliest effective prior art date of a patent if the international application designated the United States and was published in the English language under PCT Article 21(2) by WIPO.

The AIPA and H.R. 2215 also establish when the amendments to 102(e) and 374 must be applied. First, the AIPA and H.R. 2215 set forth that the amendments to 102(e) apply to all applications being examined and all patents under reexamination. See the third sentence of

4508 of the AIPA, as amended by H.R. 2215 (addressing 4505 of the AIPA). In other words, the revised version of 102(e) is completely retroactive, and it applies to all applications, no matter when filed, and all patents, with only one exception, which pertains to applying, as prior art under 102(e), patents or publications based on international applications filed prior to November 29, 2000. Further, the amendments to 374, which "deems" certain WIPO publications of international applications under PCT Article 21(2) as U.S. publications of applications filed under 35 U.S.C. 111(a), are only effective for international applications filed on or after November 29, 2000. Therefore, an international application must be filed on or after November 29, 2000 for its WIPO publication to be "deemed a publication under section 122(b)," and thus available as a possible prior art reference under 102(e)(1).

III) Prior Art Rejections based on 35 U.S.C. 102(g)

35 U.S.C. 102(g) issues such as conception, reduction to practice and diligence, while more commonly applied to interference matters, also arise in other contexts.

35 U.S.C. 102(g) may form the basis for an ex parte rejection if: (1) the subject matter at issue has been actually reduced to practice by another before the applicant's invention, and (2) there has been no abandonment, suppression or concealment. See, e.g., *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1205, 18 USPQ2d 1016, 1020 (Fed. Cir. 1991); *New Idea Farm Equipment Corp. v. Sperry Corp.*, 916 F.2d 1561, 1566, 16 USPQ2d 1424, 1428 (Fed. Cir. 1990); *E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1434, 7 USPQ2d 1129, 1132 (Fed. Cir. 1988); *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 1444-46, 223 USPQ 603, 606-08 (Fed. Cir. 1984). To qualify as prior art under 35 U.S.C. 102(g), however, there must be evidence that the subject matter was actually reduced to practice, in that conception alone is not sufficient. See *Kimberly Clark*, 745 F.2d at 1445, 223 USPQ at 607. While the filing of an application for patent is a constructive reduction to practice, the filing of an application does not in itself provide the evidence necessary to show an actual reduction to practice of any of the subject matter disclosed in the application as is necessary to provide the basis for an ex parte rejection under 35 U.S.C. 102(g). Thus, absent evidence showing an actual reduction to practice (which is generally not available during ex parte examination), the disclosure of a United States patent application publication or patent falls under 35 U.S.C. 102(e) and not under 35 U.S.C. 102(g). Cf. *In re Zletz*, 893 F.2d 319, 323, 13 USPQ2d 1320, 1323 (Fed. Cir. 1990) (the disclosure in a reference United States patent does not fall under 35 U.S.C. 102(g) but under 35 U.S.C. 102(e)).

In addition, subject matter qualifying as prior art only under 35 U.S.C. 102(g) may also be the basis for an ex parte rejection under 35 U.S.C. 103. See *In re Bass*, 474 F.2d 1276, 1283, 177 USPQ 178, 183 (CCPA 1973) (in an unsuccessful attempt to utilize a 37 CFR 1.131 affidavit relating to a combination application, applicants admitted that the subcombination screen of a copending application which issued as a patent was earlier conceived than the combination). 35 U.S.C. 103(c), however, states that subsection (g) of 35 U.S.C. 102 will not preclude patentability where subject matter developed by another person, that would otherwise qualify under 35 U.S.C. 102(g), and the claimed invention of an application under examination were owned by the same person or subject to an obligation of assignment to the same person at the time the invention was made. See MPEP 706.02(1) and 2146 (Eighth Edition (Aug. 2001)).

For additional examples of 35 U.S.C. 102(g) issues such as conception, reduction to practice and diligence outside the context of interference matters, see *In re Costello*, 717 F.2d 1346, 219 USPQ 389 (Fed. Cir. 1983) (discussing the concepts of conception and constructive reduction to practice in the context of a declaration under 37 CFR 1.131), and *Kawai v. Metlesics*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973) (holding constructive reduction to practice for priority under 35 U.S.C. 119 requires meeting the requirements of 35 U.S.C. 101 and 112).

- IV) Examination Procedures under 35 U.S.C. 102(e) and 374
(1) Determine the effective filing date(s) of the application being

examined.

See the Manual of Patent Examining Procedure (MPEP), sections 706.02, 1893.03(b), 1893.03(c), 1895 and 1895.01, Eighth Edition (Aug. 2001) as revised by this notice.

(2) Determine and perform an appropriate prior art search.

The Examiner should search for the most relevant prior art under 35 U.S.C. 102 and 103, including U.S. and WIPO publications of patent applications, and U.S. patents accorded prior art dates under 102(e).

(3) Determine if the potential reference under 102(e) is "by another."

The inventive entity of the application must be different than that of the reference in order to apply a reference under 102(e). Note that, where there are joint inventors, only one inventor need be different for the inventive entities to be different and a rejection under 102(e) may be applicable even if there are some common inventors. See MPEP 706.02(a), Eighth Edition (Aug. 2001) as revised by this notice.

(4) Determine the appropriate 102(e) date for each potential reference by following the guidelines below and examples set forth under Part V:

(a) The potential reference must be a U.S. patent, a U.S. application publication (35 U.S.C. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 102(e).

(b) Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (c) below. The 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper priority or benefit claims to prior U.S. applications under 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection. See MPEP 706.02(a), Eighth Edition (Aug. 2001) as revised by this notice.

(c) If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

i. If the international application meets the following three conditions:

1. an international filing date on or after November 29, 2000;
2. designated the United States; and
3. published under PCT Article 21(2) in English, the international

filing date is a U.S. filing date for prior art purposes under 102(e). If such an international application properly claims benefit to an earlier-filed U.S. or international application, or priority to an earlier-filed U.S. provisional application, apply the reference under

102(e) as of the earlier filing date, assuming all the conditions of 102(e), 119(e), 120, or 365(c) are met. Note, where the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S. and had been published in English under PCT Article 21(2)).

ii. If the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date for use under 35 U.S.C. 102(e) as a prior art date. In this situation, do not apply the reference as of its international filing date, its date of completion of the 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 102(a) or (b) as of its publication date, or 102(e) as of any later

U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

iii. If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of 102 and 374, prior to the AIPA amendments:

1. For U.S. patents, apply the reference under 102(e) as of the earlier of the date of completion of the requirements of 371(c)(1), (2) and (4) or the filing date of the later-filed U.S. application that claimed the benefit of the international application.

2. For U.S. application publications and WIPO publications of international applications under PCT Article 21(2), never apply these references under 102(e). These references may be applied as of their publication dates under 102(a) or (b).

3. For U.S. application publications of applications that claim the benefit of an international application filed prior to November 29, 2000, apply the reference under 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

iv. Examiners should be aware that although a publication of, or a U.S. Patent issued from, an international application may not have a 102(e) date at all, or may have a 102(e) date that is after the effective filing date of the application being examined (so it is not "prior art"), the corresponding WIPO publication of an international application will likely have an earlier 102(a) or (b) date.

(d) Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a)-(d) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 102(e) dates for prior art purposes. This would include international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a).

(5) Determine whether 35 U.S.C. 103(c) common assignee considerations apply.

If a 102(e) reference is applied in an obviousness rejection under 35 U.S.C. 103(a) (including provisional rejections) in an application filed on or after November 29, 1999 iv, the examiner should ascertain whether there is evidence that the claimed invention and the reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the claimed invention was made. A clear statement of entitlement to the prior art exclusion by applicant(s) or a registered practitioner would be sufficient evidence to establish the prior art exclusion. A double patenting rejection, however, based on the 102(e) reference could be applied, if appropriate, even if the reference is disqualified from being used a rejection under 103(a). See MPEP 706.02(1), Eighth Edition (Aug. 2001).

(6) Apply the reference(s) under 102 or 103, based on the provision of 102 that gives the best prior art date for the disclosure. If a reference is prior art under both 102 (a) and (e), but not 102(b), the reference should be applied under both provisions.

(a) Examiners should provide a copy of the appropriate statutory language under which the rejection is made in the first Office action utilizing such a rejection. Only revised (October 2002, or more current) Form Paragraphs pertaining to 102(e) should be used.

(7) Final rejection practice: If a second or subsequent action contains a new ground of rejection necessitated by the change to 35 U.S.C. 102(e) that was not also necessitated by an

amendment to the claims or as a result of certain information disclosure statements, that action cannot be made final. See MPEP 706.07(a), Eighth Edition (Aug. 2001).

V) Examples

In order to illustrate the prior art dates of U.S. and WIPO publications of patent applications and United States patents under 102(e), nine examples are presented below. The examples only cover the most common factual situations that might be encountered when determining the 102(e) date of a reference. Examples 1 and 2 involve only U.S. application publications and U.S. patents. Example 3 involves a priority claim to a foreign patent application. Examples 4-9 involve international applications. The time lines in the examples below show the history of the prior art references that could be applied against the claims of the application under examination, or the patent under reexamination.

The dates in the examples below are arbitrarily used and are presented for illustrative purposes only. Therefore, correlation of patent grant dates with Tuesdays or application publication dates with Thursdays may not be portrayed in the examples.

Example 1: Reference Publication and Patent of 111(a) Application with no Priority/Benefit Claims

For reference publications and patents of patent applications filed under 35 U.S.C. 111(a) with no claim for the benefit of, or priority to, a prior application, the prior art dates under 102(e) accorded to these references are the earliest effective United States filing date. Thus, a publication and patent of a 111(a) application, which does not claim any benefit under either 35 U.S.C. 119(e), 120 or 365(c), would be accorded the application's actual filing date as its prior art date under 102(e).

Insert (See O.G. for drawing)

The 102(e) (1) date for Publication is: 08 Dec 2000
The 102(e) (2) date for the Patent is: 08 Dec 2000

Example 2: Reference Publication and Patent of 111(a) Application with Priority/Benefit Claim to a Prior U.S. Provisional or Nonprovisional Application

For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 102(e) accorded to these references are the earliest effective United States filing dates. Thus, a publication and patent of a 111(a) application, which claims priority under 35 U.S.C. 119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C. 120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under 102(e), assuming the earlier-filed application has proper support for the subject matter as required by 119(e) or 120.

Insert (See O.G. for drawing)

The 102(e) (1) date for Publication is: 01 Jan 2000
The 102(e) (2) date for the Patent is: 01 Jan 2000

Example 3: Reference Publication and Patent of 111(a) Application with 119(a)-(d) Benefit Claim to a Prior Foreign Application

For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 102(e) accorded to these references are the earliest effective United States filing dates. No benefit of the filing date of the foreign application is given under s 102(e) for prior art purposes (In re Hilmer, 149 USPQ 480 (CCPA 1966)). Thus, a publication and patent of a 111(a) application, which claims benefit under 35 U.S.C. 119(a)-(d) to a prior foreign-filed application, would be accorded its United States filing date as its prior art date under 102(e).

Insert (See O.G. for drawing)

The 102(e)(1) date for Publication is: 21 Jun 1999
The 102(e)(2) date for the Patent is: 21 Jun 1999

Example 4: References based on the National Stage (371) of an International Application filed on or after November 29, 2000 and which was published in English under PCT Article 21(2).

All references, whether the WIPO publication, the U.S. application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000, designated the U.S., and was published in English under PCT Article 21(2) by WIPO, have the 102(e) prior art date of the international filing date or earlier effective U.S. filing date. No benefit of the international filing date (nor any U.S. filing dates prior to the IA), however, is given for 102(e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English.

Insert (See O.G. for drawing)

The 102(e)(1) date for the IA publication by WIPO is: 01 Jan 2001
The 102(e)(1) date for Publication by USPTO is: 01 Jan 2001
The 102(e)(2) date for the Patent is: 01 Jan 2001

Additional Priority/Benefit Claims:

. If a later-filed U.S. nonprovisional (111(a)) application claimed the benefit of the IA in the example above, the 102(e) date of the patent or publication of the later-filed U.S. application would be the international filing date, assuming the earlier-filed IA has proper support for the subject matter relied upon as required by 120.

. If the IA properly claimed priority to an earlier-filed U.S. provisional (111(b)) application or the benefit of an earlier-filed U.S. nonprovisional (111(a)) application, the 102(e) date for all the references would be the filing date of the earlier-filed U.S. application, assuming the earlier-filed application has proper support for the subject matter relied upon as required by 119(e) or 120.

Example 5: References based on the National Stage (371) of an International Application filed on or after November 29, 2000 and which was not published in English under PCT Article 21(2).

All references, whether the WIPO publication, the U.S. application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000 but was not published in English under PCT Article 21(2)

by WIPO, have no 102(e) prior art date at all. According to 102(e), no benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 102(e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English regardless of whether the international application entered the National Stage. Such references may be applied under 102(a) or (b) as of their publication dates, but never under 102(e).

Insert (See O.G. for drawing)

The 102(e)(1) date for the IA publication by WIPO is: None

The 102(e)(1) date for Publication by USPTO is: None

The 102(e)(2) date for the Patent is: None

The IA publication by WIPO can be applied under 102(a) or (b) as of its publication date (01 July 2002).

Additional Priority/Benefit Claims:

. If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 102(e) date for all the references.

. If a later-filed U.S. nonprovisional (111(a)) application claimed the benefit of the IA in the example above, the 102(e) date of the patent or publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application.

Example 6: References based on the National Stage (371) of an International Application filed prior to November 29, 2000 (language of the publication under PCT Article 21(2) is not relevant)

The reference U.S. patent issued from an international application (IA) that was filed prior to November 29, 2000 has a 102(e) prior art date of the date of fulfillment of the requirements of 35 U.S.C. 371(c)(1), (2) and (4). This is the pre-AIPA 102(e). The application publications, both the WIPO publication and the U.S. publication, published from an international application that was filed prior to November 29, 2000, do not have any 102(e) prior art date. According to the effective date provisions as amended by H.R. 2215, the amendments to 102(e) and 374 are not applicable to international applications having international filing dates prior to November 29, 2000. The application publications can be applied under 102(a) or (b) as of their publication dates.

Insert (See O.G. for drawing)

The 102(e)(1) date for the IA publication by WIPO is: None

The 102(e)(1) date for Publication by USPTO is: None

The 102(e) date for the Patent is: 01 July 2002

The IA publication by WIPO can be applied under 102(a) or (b) as of its publication date (01 July 2001).

Additional Priority/Benefit Claims:

. If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 102(e)(1) date for the U.S. and WIPO application publications, and the 102(e) date for the patent will still be 01 July 2002 (the date of fulfillment of the requirements under 371(c)(1), (2) and (4)).

. If a later-filed U.S. nonprovisional (111(a)) application

claimed the benefit of the IA in the example above, the 102(e)(1) date of the application publication of later-filed U.S. application would be the actual filing date of the later-filed U.S. application, and 102(e) date of the patent of the later-filed U.S. application would be 01 July 2002 (the date that the earlier-filed IA fulfilled the requirements of 371(c)(1), (2) and (4)).

. If the patent was based on a later-filed U.S. application that claimed the benefit of the international application and the later filed U.S. application's filing date is before the date the requirements of 35 U.S.C. 371(c)(1)(2) and (4) were fulfilled (if fulfilled at all), the 102(e) date of the patent would be the filing date of the later-filed U.S. application that claimed the benefit of the international application.

Example 7: References based on a 111(a) Application which is a Continuation of an International Application, which was filed on or after November 29, 2000, designated the U.S. and was published in English under PCT Article 21(2)

All references, whether the WIPO publication, the U.S. application publication or the U.S. patent of, or claiming the benefit of, an international application (IA) that was filed on or after November 29, 2000, designated the U.S. and was published in English under PCT Article 21(2) by WIPO, have the 102(e) prior art date of the international filing date or earlier effective U.S. filing date. No benefit of the international filing date (nor any U.S. filing dates prior to the IA), however, is given for 102(e) purposes if the IA was published under PCT Article 21(2) by WIPO in a language other than English.

Insert (See O.G. for drawing)

The 102(e)(1) date for the IA publication by WIPO is: 01 Mar 2001
The 102(e)(1) date for Publication by USPTO is: 01 Mar 2001
The 102(e)(2) date for the Patent is: 01 Mar 2001

Additional Priority/Benefit Claims:

. If the IA properly claimed priority to an earlier-filed U.S. provisional (111(b)) application or the benefit of an earlier-filed U.S. nonprovisional (111(a)) application, the 102(e) date for all the references would be the filing date of the earlier-filed U.S. application, assuming the earlier-filed application has proper support for the subject matter relied upon as required by 119(e) or 120.

. If a second, later-filed U.S. nonprovisional (111(a)) application claimed the benefit of the 111(a) application in the example above, the 102(e) date of the patent or publication of the second, later-filed U.S. application would still be the international filing date of the IA, assuming the earlier-filed IA has proper support for the subject matter relied upon as required by 120 and 365(c).

Example 8: References based on a 111(a) Application which is a Continuation of an International Application, which was filed on or after November 29, 2000 and was not published in English under PCT Article 21(2)

Both the U.S. publication and the U.S. patent of the 111(a) continuation of an international application (IA) that was filed on or after November 29, 2000 but was not published in English under PCT Article 21(2) by WIPO have the 102(e) prior art date of its actual U.S. filing date under 111(a). No benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for

102(e) purposes if the IA was published under PCT Article 21(2) in a language other than English. The IA publication under PCT Article 21(2) does not have a prior art date under 102(e)(1) because the IA was not published in English under PCT Article 21(2). The IA publication under PCT Article 21(2) can be applied under 102(a) or (b) as of its publication date.

Insert (See O.G. for drawing)

The 102(e)(1) date for the IA publication by WIPO is: None
The 102(e)(1) date for Publication by USPTO is: 01 May 2003
The 102(e)(2) date for the Patent is: 01 May 2003

The IA publication by WIPO can be applied under 102(a) or (b) as of its publication date (01 Sept 2002).

Additional Priority/Benefit Claims:

. If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 102(e)(1) date for the IA publication by WIPO, and the U.S. application publication and patent would still have a 102(e) date of the actual filing date of the later-filed 111(a) application in the example above (01 May 2003).

. If a second, later-filed U.S. nonprovisional (111(a)) application claimed the benefit of the 111(a) application in the example above, the 102(e) date of the patent or publication of the second, later-filed U.S. application would still be the actual filing date of the 111(a) application in the example above (01 May 2003).

Example 9: References based on a 111(a) Application which is a Continuation (filed prior to any entry of the National Stage) of an International Application, which was filed prior to November 29, 2000 (language of the publication under PCT Article 21(2) is not relevant)

Both the U.S. publication and the U.S. patent of the 111(a) continuation (filed prior to any entry of the National Stage) of an international application (IA) that was filed prior to November 29, 2000 have the 102(e) prior art date of its actual U.S. filing date under 111(a). No benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 102(e) prior art purposes if the IA was filed prior to November 29, 2000. The IA publication under PCT Article 21(2) does not have a prior art date under 102(e)(1) because the IA was filed prior to November 29, 2000. The IA publication under PCT Article 21(2) can be applied under 102(a) or (b) as of its publication date.

Insert (See O.G. for drawing)

The 102(e)(1) date for the IA publication by WIPO is: None
The 102(e)(1) date for Publication by USPTO is: 01 Dec 2000
The 102(e) date for the Patent is: 01 Dec 2000

The IA publication by WIPO can be applied under 102(a) or (b) as of its publication date (01 Sept 2000).

Additional Priority/Benefit Claims:

. If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 102(e)(1) date for the IA publication by WIPO, and the U.S. application publication and patent would still have a 102(e)

date of the actual filing date of later-filed 111(a) application in the example above (01 Dec 2000).

. If a second, later-filed U.S. nonprovisional (111(a)) application claimed the benefit of 111(a) application in the example above, the 102(e) date of the patent or publication of the second, later-filed U.S. application would still be the actual filing date of the 111(a) application in the example above (01 Dec 2000).

FOR FURTHER INFORMATION CONTACT: Jeanne Clark or Robert Clarke, Legal Advisors in the Office of Patent Legal Administration, by telephone at (703) 305-1622, by fax at (703) 305-1013, or by e-mail addressed to Jeanne.Clark@USPTO.gov or Robert.Clarke@USPTO.gov.

STEPHEN G. KUNIN
Deputy Commissioner for Patent Examination

i An original version of this Notice, signed on November 4, 2002, was posted on the Office's web site, and disseminated in paper copy form as a Pre-OG Notice as it was expected that the Notice would soon publish in the Official Gazette. In view of comments received, however, this revised version of the Notice additionally includes a clarification of Office policy in "(7) Final Rejection Practice" in Section IV of the Discussion portion, some further applicability notes in Examples 5 and 6 in Section V of the Discussion portion, and some minor edits. In addition, Item B of the Significant Provisions portion, the third paragraph of Section II of the Discussion portion and part (c)(ii) of "(4) Determine the appropriate 102(e) date for each potential reference by following the guidelines below and examples set forth under Part V" in Section IV of the Discussion portion have been revised to note that the filing dates of international applications that designate the U.S. (which are filing dates in the U.S.) are only treated as prior art dates under 35 U.S.C.

102(e) under certain circumstances. This revised Notice signed December 11, 2002, therefore, supercedes the original Notice.

ii If the reference is a patent based on an International Application filed prior to November 29, 2000, 102(e) prior to the AIPA is used to determine its 102(e) prior art date.

iii The amendments to 102(e) were set forth in section 4505 of the AIPA, as amended by H.R. 2215. The amendments to 374 were set forth in section 4507 of the AIPA, as amended by H.R. 2215.

iv The revision to 35 U.S.C. 103(c) was made in 4807 of the AIPA and is applicable only to applications filed on or after November 29, 1999.



LEXSEE 359 F. 2D 859

IN RE HANS HILMER, GERHARD KORGER, RUDI WEYER AND WALTER
AUMULLER

No. 7482*

* Petition for rehearing denied July 28, 1966.

United States Court of Customs and Patent Appeals

53 C.C.P.A. 1288; 359 F.2d 859; 1966 CCPA LEXIS 420; 149 U.S.P.Q. (BNA) 480

Oral argument November 2, 1965

April 28, 1966

PRIOR HISTORY: [***1] APPEAL from Patent
Office, Serial No. 750,887**DISPOSITION:** Reversed and remanded.**COUNSEL:** Eugene O. Retter, John Kekich, George E.
Frost, Henry W. Koster for appellants.Clarence W. Moore (Joseph Schimmel, of counsel) for
the Commissioner of Patents.**OPINION BY:** RICH**OPINION**[**861] [*1289] Before WORLEY, Chief Judge,
and RICH, MARTIN, SMITH, and ALMOND, Jr., As-
sociate Judges.

RICH, Judge, delivered the opinion of the court:

[1] The sole issue is whether a majority of the Patent Office Board of Appeals erred in overturning a consistent administrative [*1290] practice and interpretation of the law of nearly forty years standing by giving a United States patent effect as prior art as of a foreign filing date to which the patentee of the reference was entitled under 35 USC 119.

Because it held that a U.S. patent, cited as a prior art reference under 35 USC 102(e) and 103, is effective as of its foreign "convention" filing date, relying on 35 USC 119, the board affirmed the rejection of claims 10, 16, and 17 of application serial No. 750,887, filed July 25, 1958, for certain sulfonyl ureas.

This opinion develops the issue, considers the precedents, and explains why, [***2] on the basis of legislative history, we hold that section 119 does not modify the express provision of section 102(e) that a reference patent is effective as of the date the application for it was "filed in the United States."

The two "references" relied on are:

Habicht (filed in the United States		
January 23, 1958, found to be entitled		
to priority as of the date of filing		
in Switzerland on January 24, 1957)	2,962,530	Nov. 29, 1960
Wagner et al. (filed in the United		
States May 1, 1957)	2,975,212	Mar. 14, 1961

The rejection here is the aftermath of an interference (No. 90,218) between appellants and Habicht, a priority dispute in which Habicht was the winning party on a

single count. He won because appellants conceded priority of the invention of the count to him. The earliest date asserted by appellants for their invention is their German filing date, July 31, 1957, which, we note, is a few

months later than Habicht's priority date of January 24, 1957.

After termination of the interference and the return of this application to the examiner for further ex parte prosecution, the examiner rejected the appealed claims on Habicht, as a primary reference, [***3] in view of Wagner et al., as a secondary reference, holding the claimed [**862] compounds to be "unpatentable over the primary reference in view of the secondary reference which renders them obvious to one of ordinary skill in the art."

Appellants appealed to the board contending, inter alia, that "The Habicht disclosure cannot be utilized as anticipatory art." They said, "The rejection has utilized * * * the disclosure of the winning party as a basis for the rejection. The appellants insist that this is contrary to the patent statutes." Explaining this they said:

* * * the appellants' German application was filed subsequent to the Swiss filing date [of Habicht] but prior to the U.S. filing date of the Habicht application. The appellants now maintain that the Habicht disclosure cannot be utilized as anticipatory in view of 35 U.S.C. 119 which is entitled "Benefit of Earlier Filing Date in Foreign Countries: Right of Priority." This section defines [*1291] the rights of foreign applicants and more specifically defines those rights with respect to dates to which they are entitled if this same privilege is awarded to citizens of the United States. There is no question [***4] [but] that Section 119 only deals with "right of priority." The section does not provide for the use of a U.S. patent as an anticipatory reference as of its foreign filing date. This interpretation of Section 119 is also set forth in the Manual of Patent Examining Procedure (Section 715.01). The Manual refers to *Viviani vs. Taylor vs. Herzog*, 72 USPQ 448, wherein Commissioner Coe clarified the question of priority rights with respect to foreign and domestic filing.

Appellants further pointed out that, "The interference only decided the priority of the interference issue [i.e. the count]; there was no decision made nor was there any attempt to decide who was the inventor of the disclosure. The appellants readily admit the priority of Habicht as to the interference issue, but there is no admission as far as the remaining subject matter is concerned."

The board, one member dissenting with an opinion, affirmed the rejection. In the majority opinion there are four statements of the issue. The first is:

As stated by appellants in their reply brief, the main issue presented by this appeal is the availability of the Habicht patent as a reference. This question was argued at [***5] length at the hearing and appellants were re-

quested to file, and filed, a further legal memorandum concerning it. [Emphasis ours.]

The third statement (second to follow later) involves an expression of the board's view on the relevance of the interference to the issue and reads:

It is noted that the instant application was involved in an interference with Habicht (before the patent issued), with claim 1 of the patent as the count, and appellants conceded priority to Habicht. However, no questions of estoppel or res judicata can be raised concerning the [presently claimed] cyclohexyl substituted compound; Habicht did not disclose (or even suggest) any cyclohexyl or cycloalkyl compounds, no count to a cyclohexyl compound, or broad enough to include cycloalkyl compounds could have been added to the interference, nor could appellants have relied on such compounds to show priority. Appellants are free to attempt to secure claims to such compounds and to show that they preceded Habicht's date as to them, the question being which date of Habicht is the controlling one. [Emphasis ours.]

We deemed this to be a clear statement that Habicht did not claim and could not have claimed [***6] the subject matter now claimed by appellants, that therefore there could have been no interference, or priority contest, with Habicht with respect thereto, that for this reason no estoppel or res judicata may be asserted against appellants as a result of the [**863] interference, wherefore the question is the effective date of the Hibicht patent.¹

1 The board's opinion contains no clear recognition of another rejection by the examiner, different from the rejection above stated, based on the issue of the interference in view of Wagner et al. This opinion deals only with the issue the board chose to deal with. As to the other rejection, see the end of this opinion under "Reason for Remand."

[*1292] The Board's fourth statement of the issue reads:

With respect to claims 10 and 16, the issue in this case is:

When the claimed subject matter of a U.S. patent is used as a basis for rejecting a claim in an application and the reference patent is found to be entitled to the date of a prior foreign [***7] application under 35 USC 119, is the date of the reference which must be overcome, in order to remove it [as a reference], its actual filing date in the United States or the priority date to which the patent is entitled for that subject matter? [Emphasis ours.]

We note that there are two restrictions in this statement not present in any of the others. First, it refers only

to claimed subject matter of the "reference" patent. That this was deliberate is shown by a footnote to the very end of the majority board opinion in which the majority said:

13. Whether the foreign filing date can be used for such matters as mere descriptions of prior art, disclosures of species not within the scope of any of the claims of the U.S. patent, etc., which may appear in the specification of the latter, is not decided since such matters are not involved herein.

As we see the facts here, however, the board relied on subject matter not claimed. We regard the restriction as without legal significance because: (1) *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), discussed *infra*, creating the rule of 35 USC 102(e), here relied on as basic support for the rejection, abolished [***8] the distinction between claimed and unclaimed disclosure; (2) within a few months of the decision herein the board decided *Ex parte Zemla*, 142 USPQ 499 (1964), and *Ex parte Rapala* (unreported, Appeal No. 225-56, decided Sept. 18, 1964), discussed *infra*, in which this distinction is not mentioned, so that the board now seems to think, as do we, that, as a question of law, whether the disclosure is claimed is irrelevant.² Another reason why we shall disregard the limitation to claimed subject matter is that authority higher than the Patent Office, namely the *District Court for the District of Columbia in Eli Lilly & Co. v. Brenner*, 248 F.Supp. 402, 147 USPQ 442 (1965), discussed *infra*, has effectively removed this restriction in a parallel case as shown in the quotation we later make from its opinion. Lilly was *Rapala*, *supra*, in the Patent Office.

2 See, however, footnote 1 and the section at the end of this opinion headed "Reason for Remand."

The second restriction in the Board's fourth statement of the [***9] issue is that "the reference patent is found to be entitled to the date of a prior foreign application under 35 USC 119 * * *." To some degree this loads the question. There is in it an implicit assumption that if the patent is "entitled to the date of a prior foreign application," it is entitled to it, and that is that. But one must examine closely into what is meant by the word "entitled." In essence, that [*1293] is the problem in this appeal and we wish to point to it at the outset to dispel any mistaken assumptions. A patent may be "entitled" to a foreign filing date for some purposes and not for others, just as a patent may be "used" in two ways. A patent owner uses his patent as a legal right to exclude others, granted to him under 35 USC 154. Others, wholly unrelated to the patentee, use a patent, not as a legal right, but simply as evidence of prior invention or prior art, i.e., as a "reference." This is not an exercise of the patent right. This is how the Patent Office is "using" the Habicht patent. These are totally different [**864] things, governed

by different law, founded on different theories, and developed through different histories.

We have seen [***10] that 35 USC 119 is involved with respect to the so-called "priority date" of the Habicht reference patent. The other statutory provision involved in this case, applicable to both of the references, is 35 USC 102(e). Section 102 has been aptly described (Meyer article, *infra*) as containing "patent defeating provisions." They fall into two classes, events prior to an applicant's date of invention and events prior to filing his U.S. application, related respectively to the requirement of novelty and to provisions for loss of right through delay in filing after certain events have made the invention public. Subsection (e) is one of the novelty provisions, one of the "conditions for patentability," and if the facts of an applicant's case bring him within it, his right to a patent is defeated. This subsection together with the heading and introductory line of the section reads:

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless -

* * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, [***11] * * *. [Emphasis ours.]

[2] Thus, though both references here were patents copending with appellants' application, issuing after it was filed, 102(e) makes them available as of their U.S. filing dates which are earlier than appellants' U.S. filing date. However, since 102(e) refers to the applicant's date of invention, not to his filing date, he is entitled to an opportunity to establish his date of invention to show that his invention possessed statutory novelty when he made it. In this case appellants did this by showing that they filed a German application earlier than the U.S. filing dates of the references, specified in 102(e), and that they were entitled to its date for "priority" under section 119. This right is not in question. The board ruled:

Appellants have overcome the U.S. filing date of Habicht by claiming the benefit under 35 USC 119 of an application filed in Germany on July 31, 1957. The specification of this German application has been examined and is found [*1294] to contain a full disclosure of the subject matter of the claims, and the U.S. filing date of Habicht is considered overcome.

We can now summarize the issue and simultaneously state [***12] the board's decision. Continuing the above quotation, the board said:

The Examiner insists, however, that the effective date of the Habicht patent is January 24, 1957, the date

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of an application filed in Switzerland which is claimed by Habicht under 35 USC 119. Appellants have not overcome this earlier date of Habicht. The issue is hence presented of whether the foreign priority date of a United States patent can be used as the effective filing date of the patent when it is used as a reference. [Emphasis ours, and this is the second statement of the issue by the board.]

* * *

Our conclusion is that the priority date governs * *

.*

This is the decision alleged to be in error. We think it was error.

Background of the Issue as to the Availability of Habicht as a Reference

The issue in this case involves a question of statutory interpretation basic to the operation of the patent system. This issue has arisen because after decades of a uniform practice, and interpretation of law which has existed in part since 1903 and in whole since 1926, the Patent Office has made an abrupt about-face; having refused for at least 30 years, after expressly ruling on the question, to apply [***13] U.S. patents as references as of foreign "priority" dates, it has changed its [**865] practice as made manifest in an unknown number of board decisions. One of them is here on appeal. Another, as will presently appear, has been reviewed under 35 USC 145 in the District Court for the District of Columbia where the Patent Office was affirmed, *Lilly v. Brenner, supra*. A third has been published, *Ex parte Zemla*, 142 USPQ 499.

There has been a spate of writing on the question of law here involved, all of which we have read. The same ground has been plowed and replowed by authors as well as different panels of the Patent Office Board of Appeals. In chronological order, the following articles and opinions have appeared:

August 1963, "Effective Filing Dates of U.S. Patents Based on 35 U.S.C. Sec. 119," by Leon Chasan and Frederick H. Rabin, 45 JPOS 601-612, attacking the problem "as to which date - the actual U.S. filing date or the earlier convention date - shall be considered as that of filing under 35 U.S.C. § 102(e)." They conclude that "the answer to the question * * * is not free from doubt * * *." The closing sentence is: "It appears likely that the courts will have to [***14] rule expressly on this point, possibly in the near future, and it is also quite possible that the position taken by the Patent Office will be reversed." (Herein "Chasan-Rabin article.")

[*1295] February 25, 1964, the Hilmer opinion below, then unpublished, majority opinion by Examiner-in-

Chief Federico joined by Acting Examiner-in-Chief Rosdol, dissenting opinion by then Acting Examiner-in-Chief Behrens, holding that the convention date is the effective date of a U.S. patent as a reference with respect to "claimed subject matter" therein and "the disclosure in the specification relevant to the claimed invention."

March 1964, "An Analysis of the Combined Effect of 35 USC § 119 and 35 USC § 102(e)," by David S. Fishman of the Connecticut Bar, 46 JPOS 181-213, saying "this paper will attempt to demonstrate that such patents [claiming priority to a foreign filing date] should be accorded the foreign filing date for reference purposes * * *." In the context of the article this means as references to defeat claims to patents by all others and with respect to all matter disclosed whether or not claimed, and whether used to show complete anticipation or in support of a claim of [***15] obviousness 35 USC 102, 103. (Herein "Fishman article.")

May 27, 1964, a Commissioner's Notice issued (published June 9, 1964, 803 O.G. 305) revoking a very long-standing section of the Manual of Patent Examining Procedure (MPEP), 715.01 "Reference Claims Foreign Filing Date," based on a Commissioner's decision of May 9, 1935, *Viviani v. Taylor v. Herzog*, 72 USPQ 448, and providing that an applicant need not antedate the foreign filing date of a reference. The Notice stated that "foreign filing date is considered the effective date in those situations where claimed subject matter of the domestic patent (or disclosed matter related thereto) is being used as the basis for rejection, and where no question of interference exists."

June 8, 1964, this Hilmer appeal filed in this court with transcript of record making the board's opinion a public record.

July 31, 1964, decision rendered by the Board of Appeals in *Ex parte Zemla, supra*, opinion by Examiner-in-Chief Kreek, joined by Examiner-in-Chief Friedman and Acting Examiner-in-Chief Andrews, holding that a U.S. patent "may be used for all that it discloses as of the date that the same disclosure was made in a foreign country under [***16] the Convention." No mention is made of restriction to claimed subject matter or of any interference situation. The basis of the decision is a verbatim copy of the key segment of the Hilmer board opinion, but the limitations of the Hilmer decision are omitted and Hilmer is, of course, not mentioned.

August 1964, "Re: 'Ex parte Blumlein'," by Robert J. Patterson, 46 JPOS 597, calls attention to the omission in the Fishman article of a decision of this court, *In re Walker*, 41 CCPA 913, 213 F.2d 332, 102 USPQ (1954), affirming *Ex parte* [**866] *Blumlein*, 103 USPQ 223 (1952), reconsideration denied, 103 USPQ 224 (1953), which Fishman characterized as "completely untenable"

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and "logically [*1296] unsound" (pp. 205, 206), and saying: "One cannot but wonder if the author of the article would have said anything differently had he realized that the CCPA affirmed the Decision of the Board of Appeals."

August 1964, "Re: 'An USC Section 119 and 35 USC Section 119 and 35 USC Section 102(e)'," by William E. Currie, 46 JPOS 598-599, expresses disagreement with the Fishman article and points to flaws in its reasoning. Currie points out that Fishman omits mention of the caption and [***17] the second paragraph of section 119, both of which refer to priority. Currie's view is that section 119, contrary to Fishman's view, thus does contain language restricting the meaning of the words "the same effect" so that they do not include effect as an "anticipation" but are limited to priority issues. Currie concludes:

Therefore, in view of this Section 102(e) should be read to mean just what it says, "filed in the United States." There is nothing in Section 119 to carry over to Section 102(e). Scope of the priority right is discussed in detail in "Foreign Priority Rights under Section 119 of the Patent Act of 1952," Briskin, 39 JPOS 94-121.

Statutory enactment was required to prevent an applicant from establishing anticipation by using his foreign reduction to practice, but in that case there was no basis for interpretation, as there is here. It would seem to be illogical, and adverse to the interests of United States inventors, to give a foreign patent application the status of a reduction to practice for purposes of anticipation.

The last quoted paragraph refers, of course, to 35 USC 104, which originated, as a statutory enactment, in section 9 of the Boykin Act, Aug. [***18] 8, 1946, 60 Stat. 943, both discussed infra.

September 18, 1964, decision rendered by the Board of Appeals in Ex parte Rapala (unpublished, Appeal No. 225-56, heard June 25, 1964), opinion by Examiner-in-Chief Federico joined by Examiner-in-Chief Rosa and Acting Examiner-in-Chief Stone. The opinion substantially duplicates the contents of Hilmer, contains the legal discussion used in Zemla, but like the latter does not limit the use of the disclosure of the U.S. patent held effective as of its British priority date to claimed subject matter or disclosure "relevant to" it. The following statement appears at the outset:

Appellant is aware of the fact that several recent decisions of the Board of Appeals have dealt with the question presented, but inasmuch as these decisions are not public they cannot be used as precedents and the question must be considered anew.

Therefore we find a repetition of most of the Hilmer opinion. As of now, of course, three board opinions are public. See Lilly v. Brenner, discussed infra.

November 1964, a Commentary, by Gary A. Samuels, 46 JPOS 827-828, critical of the Chasan and Fishman articles, the May 27 [*1297] Notice, and the Board [***19] of Appeals decision, expressing the view that the extension of the effective date of U.S. patents used as references backward in time to their foreign filing dates is contrary to the intent of Congress, referring to items of legislative history.

June 1965, "Are Patents Effective References as of Foreign Filing Dates?," by Harold S. Meyer of the Ohio Bar (Mr. Meyer was a member of the Coordinating Committee which helped to write the 1952 Patent Act - see Rich, "Congressional Intent - Or, Who Wrote the Patent Act of 1952?," pp. 61-78, Patent Procurement and Exploitation, BNA, Washington, 1963), 47 JPOS 391-410. Referring to all of the foregoing items, Meyer says: "Those publications and decisions which favor the foreign application date as the effective date of a reference have left out of consideration some significant factors which lead to exactly the contrary conclusion." His article develops this thesis in detail and concludes as to "what the law was intended [**867] to be when it was enacted as the present statute, and what it therefore is" in these words: "The provisions of the International Convention and 35 USC 119 * * * establish only priority rights for the claimed subject [***20] matter, and do not change the effective dates of references under 35 USC 102(a), (b), and (e)." (Herein the "Meyer article.")

October 6, 1965, Manual of Patent Examining Procedure amended by inserting new section 715.01 corresponding in substance to the May 27, 1964 Notice and Hilmer.

November 1965, a Commentary, by L. Chasan (see August 1963, supra), 47 JPOS 922-924, on the Meyer article in which this co-author says his former position was that while the answer to the problem of statutory construction "was not free from doubt, on balance the case law and the authorities that have considered this have arrived at the conclusion that it is the Convention date which should control." He then tries to discredit some of Meyer's authorities, ignoring the mainstream of his argument and ends by saying:

The matter is of sufficient interest that even the forthcoming CCPA hearings on, e.g., In re Hilmer, Korger, Weyer and Aumuller, may not be conclusive. The issue will undoubtedly be raised in interparte [sic] matters of sufficient importance for possible ultimate resolution by the Supreme Court.

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December 20, 1965, opinion of the District Court, District of Columbia, in *Lilly v. Brenner*, [***21] 147 USPQ 442-470. This was a suit under 35 USC 145 to review the decision of the board in *Ex parte Rapala*, supra, and so far as we know is the last item to date in the general picture. The opinion adopted by the District Court supports the granting of a summary judgment requested by the Patent Office dismissing Lilly's complaint. On the question of law presented, namely, the effective date of a single U.S. patent cited as a reference to support a rejection under 35 USC 103 for obviousness, [*1298] the court agreed with the Patent Office that the effective date was the convention filing date in Great Britain, a date the applicant could not overcome. Had the reference been held effective only as of its actual date of filing in the United States, as plaintiff urged, the Patent Office motion for summary judgment would have been denied. We have most carefully studied this opinion as it is the most recent decision dealing with all of the arguments which have been brought to bear on this problem, contributing not a few new ones. We cannot agree with it.

To make clear what we disagree with, we quote the District Court's own summary statement of its position (USPQ at 448):

[5] [***22] The important question to be settled in this case is one of first impression in this court. The issue may be stated to be whether, in a situation where a foreign inventor has been granted a United States patent on a United States patent application which is entitled under 35 U.S.C. § 119 to the benefit of an earlier application filing date in a foreign country, this United States patent is available as a reference under 35 U.S.C. 102(e) for all disclosed subject matter, whether claimed or unclaimed, as of the filing date of the earlier foreign application. This court agrees with defendant [Patent Office] and holds that the foreign filing date is the effective reference date as to all subject matter which is disclosed, whether claimed or not, in the foreign application, to the extent that such disclosures are brought forward and included in both the United States application and the United States patent granted on this application, the latter, of course, being the basis for a 35 U.S.C. § 102(e) rejection. [Emphasis ours.]

We regret that we find ourselves in conflict with the District Court, especially with an erstwhile colleague, on a question of patent law, and correspondingly [***23] in disagreement with several members of the board, but we find ourselves in agreement with the Meyers article, with the Patterson, Currie, and Samuels [**868] commentaries, and with the dissenting views of Examiner-in-Chief Behrens who found the history of sections 102 and 119 to give "scant comfort to the majority's interpretation." We find it indeed strange that it has suddenly become

imperative to reinterpret a statute which was enacted in 1903, later construed in the light of a Supreme Court decision of 1926, and to invert a practice under which a generation of lawyers since the latter date has obtained for clients close to two million United States patents, counting for their validity on a construction of the statutory law not only followed but promulgated by the Patent Office. Furthermore, in 1952 this law, already a quarter of a century old in toto, was carried forward by Congressional action without change, insofar as it was already statutory, and insofar as it was case law it was codified without change, the particulars of which will be dealt with later. This change in long an continuous administrative practice has also been made without any advance notice, hearing, or [***24] stated basis in policy, economics, [*1299] or international relations. While it may be that the world is shrinking and the very concept of "foreign" should be abolished for the good of mankind, this is not a constitution we are expounding but specific statutes enacted to accomplish specific purposes, the meaning of which should stay put, absent intervening Congressional modifications, for well-understood reasons.

Turning from the general to the specific, we will now consider our specific reasons for construing the applicable statutes as they have for so long been construed, contrary to the recent innovation of the Patent Office.

OPINION

The District Court in *Lilly* opens its opinion by observing that the question before it was one of first impression in that court. Here it is otherwise. In 1954 this court decided *In re Walker*, 41 CCPA 913, 213 F.2d 332, 102 USPQ 79. The casual reader of the opinion alone might get the impression, as apparently the District Court did in *Lilly* (USPQ at 466), that *Walker* did not involve the issue here. On careful examination, especially with the aid of the record and briefs, it will be seen to be otherwise. Since it is the one case in [***25] point in this court we shall examine *Walker* first, after which we shall approach the problem of statutory construction primarily in a chronological fashion.

Walker was an appeal from the board decision in *Ex parte Blumlein*, 103 USPQ 223 (1952), decided below prior to the effective date of the 1952 Patent Act but afterward in this court. The discrepancy in names is due to the death of Alan D. Blumlein, said to be a well known British TV inventor, and his U.S. application was filed by his executrix, Doreen Walker (formerly Doreen Blumlein). As here, Blumlein was given an invention date by reason of the priority statute (then R.S. 4887) as of the filing of his British application on June 5, 1942. Involved as a reference was a U.S. patent to Whiteley, the U.S. filing date of which, February 5, 1943, was after

Blumlein's date but the British filing date of which was earlier, February 17, 1942. Blumlein was making the same contention in that case that appellants are making here, that as a reference the effective date of the Whiteley U.S. patent was its U.S. filing date. The board of appeals agreed with that contention. The board also expressly held that Whiteley's British priority [***26] date was of "no consequence," apart from the effect of the outcome of an interference between Blumlein and Whiteley.

In the interference with Blumlein, Whiteley was able to assert his priority date which enabled him to antedate Blumlein and win the interference on his claims 1 and 2. In subsequent ex parte [*1300] prosecution the examiner's rejection which went to the board was restated in his Statement (now called an Answer) in these terms:

Whiteley is considered to be a valid reference for what it shows, since the decision in the above interference was adverse to applicant, and Whiteley [**869] proved a foreign filing date prior to applicant's foreign filing date.

* * *

* * * Applicant has failed to show any special circumstances whereby the Whiteley patent is not a reference against his claims.

In essence applicant argues that Whiteley is not an effective reference for what it shows, but only for what it claims. The effect of such a holding would be to grant applicant the benefit of his British filing date, but to deny it to Whiteley who successfully contested common subject matter with applicant.

The board, while agreeing with appellant's view that Whiteley [***27] was a reference only as of its U.S. filing date, gave a somewhat equivocal opinion about the effect of the interference, saying:

* * * we are of the opinion that in view of the adverse decision on priority, appealed claims 11 to 17 and 20 were properly rejected as unpatentable over the issue of the interference. Accordingly, we sustain the rejection of these claims.

Two subsequent opinions on reconsideration did not satisfy appellant, or clarify for him the exact ground relied on and in appealing to this court three questions were presented: (1) Whether the appealed claims were patentably distinct from claims 1 and 2 of Whiteley; (2) whether under 35 USC 119 Blumlein had to overcome Whiteley's British priority date; and (3) whether Blumlein was estopped by the interference from claiming the subject matter of his appealed claims. The court had to and did consider all three questions. This court's opinion expressly considers point "(2)" supra, as the argument

"that 'By carrying his [Blumlein's] invention back of the domestic filing date of the application which matured into the Whiteley patent, the appellant overcame that patent as a reference for the integrating circuit which [***28] is disclosed but not claimed therein,' citing in support thereof the relevant provision of the code, 35 U.S.C. 119 * * *." (Emphasis ours.) The court answered the argument by quoting a paragraph from the Patent Office Solicitor's brief in which he conceded appellant to be correct, that as to structure not claimed by Whiteley it would be "quite permissible" to allow a claim to a later applicant who showed he invented the claimed structure before the filing date of the domestic application of Whiteley. The court then placed its own interpretation on the quoted paragraph saying, "In other words, the solicitor frankly concedes that appellant's quoted argument on the point in issue is 'absolutely correct, on the facts stated', but the solicitor contends, and we think properly, that appellant's argument is too broad and inapposite with respect to the case at bar." (Emphasis ours.)

[*1301] Having passed on that point, the court then proceeded, in effect, to pass on points "(1)" and "(3)", supra, and to hold that the claims were not patentably distinct from the claims lost by Blumlein in the interference and to say that was the true ground of the decision below, which it affirmed on [***29] that ground. We therefore have in this Walker-Blumlein case decisions by both the board and this court that as to non-interfering subject matter the foreign priority date of a U.S. reference patent is of "no consequence" and that only the United States filing date has to be overcome. The final decision adopted the first of three possible courses of action for the court as submitted in Walker's brief in the following words:

1. It may affirm the decision below on the ground that the appealed claims and the interference counts are for the same invention and that, therefore, they are res judicata as to the appellant.

But in the process of arriving at that course of action the court did pass on the law applicable where there is no res [**870] judicata, as in the present case.³ The court's views at that time were in complete accord with the legal expertise in the Patent Office.

3 We trust this explanation of what this court did in Walker is a sufficient answer to the curiosity expressed by the District Court in Lilly (USPQ 467, col. 1) as to our "reaction" to the argument that we passed on a rejection not relied on by the Board of Appeals. This court did pass on the question as it was presented to it. The confusion as to what the ground of rejection actually was required the court to do so.

***30] We note that in Lilly, in discussing Walker, the court ignored all of the relevant matters discussed above and proceeded on the assumption it could not possibly have passed on a point on which it did pass. It also ignores the Blumlein decision in the Patent Office on the very issue here involved.

We further note that in the instant case the board's opinion finds "confusion" as to the ground on which this court in Walker sustained the rejection, which we think is clearly stated, and that the board errs in stating the contention of the solicitor and the court's supposed approval of it. The solicitor did not contend that all "subject matter recited in the [Whiteley] claims" was available as prior art as of the priority date. Far from it, he said in his brief, "The issue here in no way involves a foreign filing date of the patentee Whiteley. * * * The rejection here is not upon Whiteley's foreign filing date. The rejection is based upon the adverse award of priority * * *." That is what the court "indicated * * * was proper." We think the board erred further in reading the second opinion on reconsideration in Blumlein (which it refers to as "Walker") in saying that in that ***31] opinion "the foreign date was considered relevant with respect to the disclosed but unclaimed components of the combination claimed." We find nothing remotely resembling such a view. In a very short opinion in answer to several requests to [*1302] clarify its position, what the board did was to reiterate its position that Blumlein's claims were to subject matter "not patentably distinct" from the issue of the interference which he lost. It said nothing at all about "unclaimed components of the combination claimed," as stated by the board here.

On the other hand, appellants here rely on Walker and accurately state what happened in Blumlein and in Walker, contending it is precedent supporting their contention "that the domestic filing date of a patent obtained by a foreign applicant is the critical date to be considered when it is desired to use the patent for anticipation purposes," that is, as an ordinary prior art reference. We fully agree. For the same reasons, we disagree with the Lilly opinion (USPQ at 466) where it says: "the [Walker] case does not really support plaintiff's position."

The Patent Office Solicitor has nothing to say on Walker for the interesting ***32] reason that he did not really file a brief for the Patent Office position. In his brief he says:

Inasmuch as the decision [opinion] of the Board of Appeals sets forth in full and exact detail the reasons why the priority date is considered the effective date of the Habicht patent under 35 USC 102(e), it is believed to be unnecessary and undesirable to repeat or to paraphrase the decision in this brief.

In other words, the opinion of the board is the brief in this case. That was the position the solicitor took at oral argument.

We turn now to a chronological review and to the other statutes and precedents relied on by the parties.

The board's conclusion is that the foreign priority date of a U.S. patent is its effective date as a reference. In identical language in its opinion in this case and in the Zemla and Rapala (Lilly) opinions, the board's statement is:

Our conclusion is arrived at simply by considering sections 102(e) and the ***871] first paragraph of section 119 of the statute together.

* * * [Here the statutes are quoted] * * *

Section 119 refers to two applications for the same invention stemming from the same inventor, one a first application ***33] filed in a foreign country and the other a later application filed in the United States. * * * Section 119 provides that under the specified circumstances, and subject to the requirements of the second paragraph which are not in question here, the second application, filed in the United States, "shall have the same effect" as it would have if filed in the United States on the date on which the application was filed in the foreign country. This language is plain; it gives the application the status of an application filed in the United States on a particular date. Section 102(e) provides that a patent may not be obtained if the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant. This paragraph makes the filing date of a U.S. patent [note the omission of "in the United States"] the effective date as a reference. It refers to an application filed in the United States and since section 119 provides that the application shall have the same effect as if filed in this country [*1303] on a particular date, these two provisions must be read together and the filing date of the ***34] foreign application becomes the effective date of the United States reference patent. [Emphasis ours.]

This is so plausible that one's impulse is to say "Q.E.D." * We find the reasoning at fault, however, and the interpretation untenable. To discuss it we must have section 119 before us, insofar as applicable:

4 This construction is reminiscent of the many misreadings of the former statutory definition of the patent rights as "the exclusive right to make, use, and vend the invention or discovery," R.S. 4884, which was so often asserted to give the patentee some positive right to make or use or sell things embodying his patented invention. The

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Supreme Court put this idea to rest in *Bloomer v. McQuewan*, 55 U.S. 539, 549 (1852), but it did not die until the 1952 Act changed the statute to read "the right to exclude others from making, using, or selling the invention * * *." 35 USC 154. Even now its ghost seems to hover over the opinion in the Lilly case (147 USPQ at 451, col. 2, 452.)

§ 119. Benefit [***35] of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless [here follows the [***36] requirement for filing certain papers in the Patent Office and claiming priority not in question here, as the board held] * * *. [Emphasis ours.]

The board's construction is based on the idea that the language of the statute is plain, that it means what it says, and [**872] that what it says is that the application filed abroad is to have the same effect as though it were filed here - for all purposes. We can reverse the statement to say that the actual U.S. application is to have the same effect as though it were filed in the U.S. on the day when the foreign application was filed, the whole thing being a question of effective date. We take it either way because it makes no difference here.

Before getting into history, we note first that there is in the very words of the statute a refutation of this literalism. It says "shall have the same effect" and it then says "but" for several situations it shall not have the same effect, namely, it does not enjoy the foreign date with respect to any of the patent-defeating provisions based on publication or patenting anywhere in the world or public use or [*1304] being on sale in this country more

than one year before the [***37] date of actual filing in this country. ⁵

5 These patent-defeating one-year time-bars are also contained in 35 USC 102(b) (formerly R.S. 4886) and have always been included in 119 (formerly R.S. 4887) to assure that it would not have the "same effect" if giving effect to a priority date would avoid these time-bars.

As to the other statute involved, we point out that the words of section 102(e), which the board "simply" reads together with section 119, also seem plain. Perhaps they mean precisely what they say in specifying, as an express patent-defeating provision, an application by another describing the invention but only as of the date it is "filed in the United States."

[3] The great logical flaw we see in the board's reasoning is in its premise (or is it an a priori conclusion?) that "these two provisions must be read together." Doing so, it says 119 in effect destroys the plain meaning of 102(e) but the board will not indulge the reverse construction in which the plain words of 102(e) limit the [***38] apparent meaning of 119. We see no reason for reading these two provisions together and the board has stated none. We believe, with the dissenting board member, that 119 and 102(e) deal with unrelated concepts and further that the historical origins of the two sections show neither was intended to affect the other, wherefore they should not be read together in violation of the most basic rule of statutory construction, the "master rule," of carrying out the legislative intent. Additionally, we have a long and consistent administrative practice in applying an interpretation contrary to the new view of the board, confirmed by legislation ratification in 1952. We will consider these matters separately.

Section 119

We shall now take up the history and purpose of section 119. The board opinion devotes the equivalent of four pages in the printed record to a scholarly and detailed review of the history of section 119 with all of which we agree, except for the interwoven conclusions as to its meaning as it bears on the effective date of a U.S. patent used as a reference.

The board shows that the predecessor statute (R.S. 4887), containing the words "shall have the same force and [***39] effect," was enacted March 3, 1903 (32 Stat. 1225). Theodore Roosevelt signed it into law. The bill was drafted and proposed by a Commission created by Act of Congress in 1898 (30 Stat. 431) to study the effect of the Convention of Paris for the Protection of Industrial Property of 20th March 1883, which was under revision at Brussels even as the Commission deliberated, the revision being adopted at Brussels [*1305] on 14th

December 1900. (It was last revised at Lisbon on 31st October 1958.) The Commission made a report November 27, 1900, printed in 1902, entitled "Report of the Commissioners Appointed to Revise the Laws Relating to Patents, Trademarks, and Trade Names, with Reference to Existing Conventions and Treaties," which is fairly descriptive of its purpose. The section entitled "The Revision of the Patent Law," which we have read, [**873] extends from page 6 to page 39. It begins by saying (p. 6):

We have found it desirable in considering the question of revision of the patent law to first consider what changes in the law are needed to give full force and effect to the treaty obligations which the United States has undertaken touching the protection of inventions [***40] made by the subjects or citizens of certain foreign countries. [Emphasis ours.]

Under the heading "Priority Under the Convention," it says (p. 12):

The second provision of the Convention to be noticed, and one which may be of very great advantage to those of our citizens who desire to secure patents in foreign countries for their inventions, is that contained in article 4, and relates to the so called "delay of priority," or "period of priority."

It then explained that in most countries no valid patent can be obtained if before the application is filed, the invention has been described in a printed publication, either in the country of application or even, as in the case of France and six other countries, in any country; that the same was true as to public use of the invention; and that the convention gives applicants in member countries a period (then 7 months, soon extended to 12) in which they can file applications in other countries after the filing in their own country and obtain valid patents notwithstanding publication or use in the interval and before the filing of the foreign application. This, it explained, is the "delay of priority." In plain English, it was the [***41] right of an applicant to have the foreign application treated at law as prior to the intervening publication or public use, though in fact it was not, by giving a right to that applicant to delay filing in the foreign country, instead of filing simultaneously with the home application. This is what today we call simply "Convention priority," or just "priority." The foreign filing date is the "convention date" or the "priority date."

This priority right was a protection to one who was trying to obtain patents in foreign countries, the protection being against patent-defeating provisions of national laws based on events intervening between the time of filing at home and filing abroad. Under the heading "Recapitulation of Advantages Secured by the Convention," the Commission said, so far as relevant here (p. 14-15):

The advantages to our citizens in the matter of patents directly afforded by the convention may be thus recapitulated.

[*1306] First. The enjoyment in foreign countries of equal rights with subjects or citizens of those countries.

Second. The "delay of priority" of seven months within which to file applications abroad after filing in this country.

Third. [***42] The privilege of introducing articles embodying the invention manufactured in this country into foreign countries to a certain extent without thereby causing the forfeiture of the patents taken out there.

Note the emphasis repeatedly placed in the Commission Report on advantages to United States citizens. It was felt we should do what was necessary to comply with the reciprocity provisions to enjoy the benefits of the convention for our own citizens. It was also believed that by reason of Opinions of Attorneys General, Vol. 19, 273, "the International Convention, in so far as the agreements therein contained are not in accordance with the present laws of the United States, is without force and effect; that it is not self-executing, but requires legislation to render it effective * * * and * * * it is our opinion that such legislation should be adopted * * *." (Report p. 19.)

Specific to the question here, the Commission Report says (p. 24):

We are, therefore, of the opinion that an amendment to the law should be made, providing that the foreign [**874] application shall have, in case an application is filed in this country by the applicant abroad within the specified [***43] period, the same effect as if filed here on the day it was filed abroad.

The board thinks this "shows the intention of the Commissioners" to create "a status of [an application] having been filed in the U.S. for all purposes * * *." (Emphasis ours.) In the context of this case, that means for the purpose of using a U.S. patent, obtained with a claim of priority, as a prior art patent to defeat the right of a third party to a patent on subject matter which does not patentably distinguish from anything that happens to be disclosed in such patent - or at least from anything disclosed "relevant to the [there] claimed invention," depending on which recent board opinion one looks at. We have read every word of the Commission Report looking for any suggestion of such a concept and have found none. All the board found was the above question. We deem it wholly inadequate as a basis for finding an intent to create a "status" for an application - to say nothing of the patent granted thereon - "for all purposes."

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There are other factors to consider which negative any such legislative intent.

There is another sentence in the Commission Report we should consider on page 26. It called [***44] attention to the fact that in most foreign countries the patent is granted to the first to apply and said:

The Convention has created an exception to the rule and made an application in any State of the Union for the Protection of Industrial Property of the same effect as an application in the country where an application is subsequently made within the time specified as a period of priority. [Emphasis ours.] [*1307] This couples very nicely with the wording of the first recommendation for a change in U.S. Laws on page 27 where it was said:

First. The application for a patent filed within seven² months of the filing of an application for a patent for the same invention in any foreign country which is a party to the International Convention should be given the same force as regards the question of priority that it would have if filed on the date on which the foreign application was filed. (Fn. ²: Extended to twelve months.) [Emphasis ours.]

[4] The Commission, page 36, recommended proposed legislation, which is, in substance, the amendment to R.S. 4887 which was passed and is, with no change in substance, what we have today in *section 119*. The proposed bill in the [***45] Commission Report was entitled "A BILL to give effect to treaty stipulations relating to letters patent for inventions." The Act passed was entitled "An Act to effectuate the provisions of the additional act of the International Convention for the Protection of Industrial Property." Throughout, the same phrase has always appeared, "shall have the same force and effect," until it was simplified in the 1952 condification to "shall have the same effect." This change was mere modernization in legislative drafting. The Revisers Note to the section says: "The first paragraph is the same as the present law with changes in language." The Federico Commentary on the 1952 Act, 35 U.S.C.A., says (p. 29):

This so-called right of priority was provided for in the second paragraph of R.S. 4887 which is the basis for the first paragraph of *section 119* of this title. * * * [he here states the 4 conditions for obtaining the right] * * * The new statute made no changes in these conditions of the corresponding part of the old statute except to revise the language slightly * * *.⁶

6 In the two and a half page analysis of *section 119*, referred to always as giving a "right of priority," there is no hint that the foreign filing date has anything to do with the effective date of a U.S. patent as a prior art reference. The Commentary was published in 1954. Thus, the pre-

sent interpretation by Mr. Federico, speaking as an Examiner-in-Chief, represents a later development.

[***46] [**875] We need not guess what Congress has since believed to be the meaning of the disputed words in *section 119*, for it has spoken clearly. World wars interfere with normal commerce in industrial property. The one-year period of priority being too short for people in "enemy" countries, we had after World War I a Nolan Act (41 Stat. 1313, Mar. 3, 1921) and After World War II a Boykin Act. Foreign countries had reciprocal acts. One purpose was to extend the period of priority. House Report No. 1498, January 28, 1946, by Mr. Boykin, accompanied H.R. 5223 which became Public Law 690 of the 79th Cong., 2d Sess., Aug. 8, 1946, 60 Stat. 940. Section 1 of the bill, the report says, was to extend "the so-called period of priority," which then existed under R.S. 4887. On p. 3 the report says:

In this connection, it may be observed that the portion of the statute which provides that the filing of a foreign application - shall [*1308] have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country -

is intended to [***47] mean "shall have the same force and effect," etc., insofar as applicant's right to a patent is concerned. This statutory provision has no bearing upon the right of another party to a patent except in the case of an interference where the two parties are claiming the same patentable invention.

We emphasize none of those words because we wish to emphasize them all. We cannot readily imagine a clearer, more definitive statement as to the legislature's own view of the words "same effect," which now appear in *section 119*. This statement flatly contradicts the board's view. The board does not mention it.

In *Lilly* the District Court (USPQ at 461-463) attempts to depreciate the above quotation to the vanishing point by saying it is nothing but reiteration of an erroneous Commissioner's decision (*Viviani, supra*), was not directly concerned with the Boykin Act, probably was not thoughtfully considered by the whole House or even the full committee, and is not a report on *section 119*, which was not enacted until six years later. If this need be answered, the answer is that the quotation happens to be a precise statement of the construction consistently placed on the statute by the Patent [***48] Office until 1963;⁷ that the Boykin Act was concerned, as its first order of business in section 1, with extending the right of priority; and finally (omitting comment on the reading habits of Congressmen), *section 119* is the very same law as R.S. 4887, the statute about which the report was

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speaking and, in effect, amending. Presumably Mr. Boykin wished to make it clear to Congress and the public that if his bill passed, it would not be pushing the effective date [**876] of references back by several years into the fund of unknown applications reposing in foreign patent offices, waiting to have Boykin act counterparts filed in the U.S., which could have had a most serious effect on the validity of U.S. [*1309] patents issued in the war and post-war period, as well as on applications then pending. ⁸ R.S. 4887, the predecessor of *section 119*, is annexed to the report.

7 To show that this was still the established construction in 1959 we cite McCrady, Patent Office Practice, 4th Ed. (1959), Sec. 142, "Effective Date of Domestic Patent," at p. 198:

Where the reference patent claims benefit of an earlier foreign filing date, it would seem that the validity of such claim cannot be precluded against an applicant except in an inter partes proceeding. Despite the language of 35 USC § 119, that the U.S. application "shall have the same effect as the same application would have if filed in this country on the [foreign filing] date," the Office does not ordinarily use the foreign filing date in rejections n.56, although where the patentee has won an interference with applicant on the strength of his foreign filing date such date becomes the effective date of the patent as to claims similar to the interference counts. n.57

n56 *Viviani v. Taylor* (Comr: 1935) 72 PQ 448, MPEP 715.01

n57 *Ex parte Kinsella* (BA: 1938) 39 PQ 199. *Ex parte Blumlein* (BA: 1952 & 1953) 103 PQ 223

To the same effect was the Patent Office's own MPEP, section 715.01 as it was over a long period until changed on May 27, 1964, quoted *infra*.

8 [***49] We know section 1 of the Boykin Act has a saving clause about "conflicting" rights

of applicants and patentees but under the law then existing believe it refers to interference situations, possibly, and note that it refers specifically to infringement situations. In 1946 U.S. patents were not used as "references" as of their foreign priority dates and "conflicting" would not have connoted such situations.

Another reason for giving great weight to the Committee Report's comments on what R.S. 4887 meant is that the same bill contained a section 9, the predecessor of present 35 USC 104, discussed later, dealing expressly with acts of invention in foreign countries and overruling the effect of the Supreme Court decision in *Electric Storage Battery Co. v. Shimadzu*, 307 U.S. 5 (1939), all of which has a bearing on the problem before us. That section prohibits proof of acts abroad to establish a date of invention, except as *section 119* may have been complied with as to an application filed abroad.

[5] For the foregoing reasons, we are clearly of the opinion that *section 119* is not to be [***50] read as anything more than it was originally intended to be by its drafters, the Commission appointed under the 1898 Act of Congress, namely, a revision of our statutes to provide for a right of priority in conformity with the International Convention, for the benefit of United States citizens, by creating the necessary reciprocity with foreign members of the then Paris Union.

The board has mentioned that it was not limited in its terms to that treaty, which is true, so that it also functions relative to other treaties and reciprocal laws. We are unable to deduce from this any intent to affect the date as of which U.S. reference patents are effective. Nor can we do so by reason of another "deviation" from the Convention the board finds in section 4887 (now 119) as to the protection of third parties.

Section 102(e)

[6] We have quoted this section above and pointed out that it is a patent-defeating section, by contrast with *section 119* which gives affirmative "priority" rights to applicants notwithstanding it is drafted in terms of "An application." The priority right is to save the applicant (or his application if one prefers to say it that way) from patent-defeating provisions [***51] such as 102(e); and of course it has the same effect in guarding the validity of the patent when issued.

Section 102(e), on the other hand, is one of the provisions which defeats applicants and invalidates patents and is closely related in fact and in history to the requirement of *section 102(a)* which prohibits a patent if

[*1310] (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before

the invention thereof by the applicant for patent, * * *.
[Emphasis ours.]

In fact, *section 102(e)* springs straight from 102(a)'s predecessor, R.S. 4886, by decision of the United States Supreme Court in 1926. It was pure case law until 1952 when, having become firmly established, that law was codified by incorporating it in the statute.

We will not undertake to trace the ancestry of 102(e) back of its immediate parentage but clearly it had ancestors or it would never have come to the Supreme Court. We will regard its actual birth as the case of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (March 8, 1926), which we shall call Milburn. It is often called the Davis-Bournonville [***52] case. It was an infringement suit on a patent to Whitford and the defense, under R.S. 4920, was that he was not the first [**877] inventor. R.S. 4920, "Fourth" defense, was: "That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented." This was based on that part of R.S. 4886 corresponding to present 102(a), which read, "not known or used by others in this country, before his invention or discovery thereof". (Emphasis ours.) Defendant produced a patent to Clifford which contained a full description of Whitford's invention, but did not claim it. The law at that time was in confusion as to whether claiming was relevant to the defense and that was the issue the Supreme Court resolved. The Circuit Courts were in conflict, especially the Second and Sixth. No foreign applications were involved. The U.S. filing date of the application for Clifford's patent was earlier than any date relied on by Whitford. In a short three and a half page opinion Mr. Justice Holmes held that the description of Whitford's invention in Clifford's patent, Clifford's application having been filed in the United States Patent Office with the [***53] same description before Whitford's invention, showed that Whitford was not the first inventor, as the law required, and that his patent was therefore invalid.

We need not go into the reasoning of the Milburn case, which has its weaknesses, because all that matters is the rule of law it established: That a complete description of an invention in a U.S. patent application, filed before the date of invention of another, if it matures into a patent, may be used to show that that other was not the first inventor. This was a patent-defeating, judge-made rule and now is *section 102(e)*. The rule has been expanded somewhat subsequent to 1926 so that the reference patent may be used as of its U.S. filing date as a general prior art reference, as shown by *In re Harry*, 51 CCPA 1541, 333 F.2d 920, 142 USPQ (1964), and the December 8, 1965 [*1311] Supreme Court decision in *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 147 USPQ 429.

What has always been pointed out in attacks on the Milburn rule, or in attempts to limit it, is that it uses, as prior knowledge, information which was secret at the time as of which it is used - the contents of U.S. patent applications which are preserved [***54] in secrecy, generally speaking, 35 USC 122. This is true, and we think there is some validity to the argument that that which is secret should be in a different category from knowledge which is public. Nevertheless we have the rule. However, we are not disposed to extend that rule, which applies to the date of filing applications in the United States, the actual filing date when the disclosure is on deposit in the U.S. Patent Office and on its way, in due course, to publication in an issued patent.

The board's new view, as expressed in this case and in the Zemla and Rapala decisions, the latter sustained in Lilly, has the practical potential effect of pushing back the date of the unpublished, secret disclosures, which ultimately have effect as prior art references in the form of U.S. patents, by the full one-year priority period of *section 119*. We think the Milburn rule, as codified in *section 102(e)*, goes far enough in that direction. We see no valid reason to go further, certainly no compelling reason.

We have seen that *section 119* originated in 1903 and that its purpose was to grant protective priority rights so that the United States might be a participating member in [***55] the International Convention by giving reciprocal priority rights to foreign applicants with respect to the obtaining of patents. We have also seen that *section 102(e)* was the codification of a court-developed patent-defeating rule based on a statutory requirement that an applicant's invention must not have been previously known by others in this country. We see no such relation between these two rules of law as requires them to be read together and it is our view that *section 119* should not be so read with 102(e) as to modify the express limitation of the latter to applications "filed in the United States."

[**878] *Section 104*

[7] This brings us to another related section of the statute. We noted above that *section 102(a)* refers to knowledge of an invention in this country as a patent-defeating provision. This had been interpreted, long before the 1952 codification, to mean public knowledge. Federico's Commentary, 35 U.S.C.A. p. 18 says:

In the language of paragraph (a), an invention is not new if it "was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant [***56] for patent." The Committee Report both in the general part and in [*1312] the Revision Notes recognizes that the interpretation of this condition is

somewhat more restricted than the actual language, stating "the interpretation by the courts excludes various kinds of private knowledge not known to the public," and the narrowing interpretations are not changed. The first clause of paragraph (a) indicates that prior knowledge or use in foreign country will not defeat the right to a patent; a separate section, R.S. 4923 [section 72 of former Title 35], in the old statute duplicated this provision and this old section has been omitted as its provisions are covered here and elsewhere. [Emphasis ours.]

The "elsewhere" is *section 104* which has also superseded section 9 of the 1946 Boykin act, above discussed. Before quoting it, we will mention another patent-defeating provision, 102(g) which says a patent may not be obtained on an invention if "before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it." (Emphases ours.) The first sentence of *section 104* reads:

§ 104. Inventions made abroad.

[***57] In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in *section 119* of this title.

The second sentence is an exception not relevant here.

[8] It seems clear to us that the prohibitions of 104, the limitations in *sections 102(a)* and *102(g)* to "in this country," and the specifying in 102(e) of an application filed "in the United States" clearly demonstrate a policy in our patent statutes to the effect that knowledge and acts in a foreign country are not to defeat the rights of applicants for patents, except as applicants may become involved in priority disputes. We think it follows that *section 119* must be interpreted as giving only a positive right or benefit to an applicant who has first filed abroad ' to protect him against possible intervening patent-defeating events in obtaining a patent. Heretofore it has always been so interpreted with the minor exceptions, of little value as precedents, hereinafter discussed. So construed, it has no effect on the effective date [***58] of a U.S. patent as a reference under *section 102(e)*.

9 [9] It is first filing in a foreign convention country that creates the priority right, not the nationality of the applicant. It often happens that American inventors domiciled in the United States file abroad before filing here and claim priority rights in their own country as a result.

As further indication that the Milburn rule never applied to foreign filing dates, and that its statutory version, *section 102(e)*, does not either, is the fact that the Supreme Court dealt with the matter. The lower court had attempted to draw an analogy involving R.S. 4887 on the issue whether the anticipatory subject matter had to be claimed. Mr. Justice Holmes said, "The policy of the statute as to foreign inventions obviously stands on its own footing and cannot [*1313] be applied to domestic affairs." (270 U.S. at 402.) This shows he was at least conscious of the fact that he was [**879] dealing only with "domestic affairs." In discussing this point, [***59] the Lilly opinion (147 USPQ at 453) emphasizes that it is dealing with a 102(e) rejection, involving disclosure which is in a U.S. patent, a rejection "not based on 102(a)." This rather overlooks the fact that Milburn rested on the proposition that Whitford was not the first inventor, that there was no 102(e) in those days, and that the court found the basis for its decision in the R.S. 4886 provision that the invention must not have been "known * * * by others in this country, before his invention * * *." Today this provision is 102(a).

[10] The simple observable fact, therefore, is that the effect of *section 102(e)* is to make a U.S. patent available as a reference, as of its U.S. filing date, and that thereafter the rejection of an application, or the holding of invalidity in the case of a patent, is predicated on some other section of the statute containing a patent-defeating provision to which the reference applies. [11] Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty, obviousness, loss of right or whatever may be the ground of [***60] rejection. In some cases we have examined on this issue, Walker-Blumlein for example, the statutory ground of rejection was that the applicant was not the first inventor, the evidence of that fact being that he lost a count to the same invention, or one patentably indistinguishable from it, in an interference. Yet the "reference relied on" in Walker-Blumlein was the patent granted to Whiteley after the interference, which patent had no relevance as such. There were similar aspects to the present case prior to the board's decision.

Section 120

At oral argument the Patent Office Solicitor argued by "analogy" from 35 USC 120 (a section which he said gives one U.S. application the benefit of an earlier U.S. application under specified circumstances for all purposes) that *section 119* should similarly give to a patent, used as a reference under *section 102(e)*, effect as of an earlier foreign filing date.

We could ignore the issue because it was not before the board here and was not briefed but will consider it

because it is extensively discussed in Lilly (147 USPQ at 449, 445, 462) wherein the Patent Office pursued the same argument. One aspect of it is that sections 119 and 120 [***61] contain the "same phrase," namely "shall have the same effect."

[*1314] We find no substance in this argument because: (1) as above pointed out, our statute law makes a clear distinction between acts abroad and acts here except for patents and printed publications. Section 120, following policy in sections 102(a), (e) and (g) and 104, contains the limitation to applications "filed in the United States," excluding foreign applications from its scope. (2) Use of the same expression is mere happen-stance and no reason to transfer the meaning and effect of section 120 as to U.S. filing dates to section 119 with respect to foreign filing dates. Section 120 was not drafted until 49 years after the predecessor of section 119 was in the statute.

The Cases

With minor exceptions, we deem the few decided cases, which the writers on this issue all discuss, to be of slight significance. What determines the result in this case is statutory history, not judicial precedents. We will therefore treat them as briefly as possible in chronological order. Milburn (1926), of course, is part of the statutory history and does not deal with the issue here at all.

Next came *Federal Yeast [***62] Corp. v. Fleischmann Co.*, 13 F.2d 570 (4th Cir. 1926), affirming 8 F.2d 186 (D. Md. 1925). This was an infringement suit on two patents the validity of which was attacked. The court determined that they were for the same invention and they were both owned by Fleischmann. They could [***880] not both be valid. One of them had a 1915 German filing date, effective under the World War I Nolan Act, and a U.S. filing date in 1920. The other had a filing date in 1919. The patent on the former application was sustained and the patent on the latter application held invalid. There is much dispute as to what the case stands for. If the inventions were the same, as they appear to have been, a priority-type situation existed in which the date of priority and foreign filing would be involved. There was no interference, but in holding valid the patent with the German filing date the court gave the patent the benefit of the "priority" date. It also relied on Milburn, then just decided, subsequent to the District Court decision. The lower court found the patent with the German filing date to be the "prior application" by virtue of the Nolan Act, without discussion, said the respective [***63] filing dates fixed the dates of invention, found the second invention was the equivalent of the first, and under the authorities found there was "no patentable invention" in the second, wherefore it was invalid. The appellate court affirmed, saying validity

was "to be governed by the ordinary rules" and finding, as to the second patent, "in view of the disclosures of Hayduck [the first], their claims in suit cover nothing [*1315] patentable." It also found the two inventions were the same and remarked that "the plaintiff can get all the relief against the defendant [from the claims of the one patent] it could obtain, if both patents were held valid and infringed." While we are not sure what the case stands for, other than the proposition that there cannot be two valid patents on the same invention, we are sure there was no discussion of the problem before us now. We are willing to say on its facts it is some support for the board but it seems to us more like a priority case or a double patenting issue than a decision on the effective date of a U.S. patent as a reference. In fact, the appellate court talked about "priority." On the issue here it is a very unclear precedent, [***64] as most commentators seem to agree.

Nine years pass without a decision and we then come to *Viviani v. Taylor v. Herzog*, 72 USPQ 448 (1935), a Patent Office decision which deals squarely with the issue here, is admitted by the board in *Rapala (Lilly)* to be "of course contrary to the holding herein" whereas in this case the board attempts to distinguish it on the ground there is a difference between matter claimed in a reference and matter not claimed. We quote what the Commissioner said to show the basis of the Patent Office practice for some 30 years.

Section 4887 R.S. [119] does not concern itself with bars against the issuance of patents in this country, such bars being found in section 4886 R.S. [102] (*U.S.C., title 35, sec. 31* [old 35]).

Section 4887 R.S. relates solely to the rights of an applicant in the United States who has filed an antecedent and corresponding application in a foreign country.

* * *

In view of the origin of that [second] paragraph of the section [4887], it is believed to have the same meaning as if it had read, "shall have the same force and effect, in so far as applicant's right to a patent is concerned." This statutory provision [***65] has no bearing upon the right of another party to a patent except in the case of an interference where the two parties are claiming the same invention.

* * *

Section 4887 R.S. cannot be construed as giving greater effect [to a foreign application, which at most is evidence of knowledge of the invention abroad] than is accorded by section 4923 R.S. to knowledge or use in foreign countries which is actually proven. [The last pair of brackets, inexplicably, appears in the original.]

53 C.C.P.A. 1288, *; 359 F.2d 859, **;
1966 CCPA LEXIS 420, ***; 149 U.S.P.Q. (BNA) 480

The Commissioner considered the Fleischmann case, explaining at length why he found the basis of the decision unclear, noting that R.S. 4923 had not been mentioned. That old section, somewhat like 35 USC 104, ruled out knowledge or [*881] use in a foreign country as a ground for invalidating a patent. See *Electric Storage Battery Co. v. Shimadzu*, 307 U.S. 5 (1939).

[*1316] Under Viviani the Patent Office promulgated section 715.01 of its Manual of Patent Examining Procedure under which it and the bar operated until recently. It read:

In overcoming, under Rule 131, a domestic patent where the patentee has an earlier foreign filing date to which he would be entitled in establishing [***66] priority to the invention claimed in the patent, it is not necessary for the applicant to carry his date back to the patentee's foreign filing date. (*Viviani v. Taylor v. Herzog*, 72 U.S.P.Q. 448). [Emphasis ours.]

In 1941 the Court of Appeals for the Second Circuit decided *Celanese Corp. of America v. Ribbon Narrow Fabrics Co.*, 117 F.2d 481, 48 USPQ 447, affirming 33 F.Supp. 137, 45 USPQ 492 (S.D.N.Y. 1940). Suit was on a Dreyfus patent and a reference was a U.S. patent to Sponholz with a U.S. filing date after, and an alleged German filing date before, Dreyfus' date of invention. The wording of both opinions is inept and all writers are confused by it but whatever the statements made and reasons given, it is clear that defendant asserted the German filing date for the reference and the District Court refused it, the Court of Appeals saying "Sponholz had previously applied for a German patent on May 11, 1926 but that is immaterial * * *." It may be a precedent of little value but it is certainly on the side of disallowing the foreign filing date as the effective date of a reference patent.

In 1951 *Young et al. v. General Electric Co.*, 96 F.Supp. 109, 88 USPQ 174, was decided [***67] by an Illinois District Court. It involved validity of a patent in suit and the only pertinent remark is concerned with a Bethenod reference having a U.S. filing date after and a French filing date earlier than the date of invention of the patent in suit. Many other prior art patents were relied on. In footnote 6, USPQ at 195, in a 25 page opinion Judge Barnes said, speaking of Bethenod,

* * * whether it is prior art as to Young No. 2,179,569 depends on the date to which the Bethenod patent is entitled * * *. The court is of the opinion that it is entitled to the earlier date * * * but there is a difference of opinion on this question among the authorities. [Fleischmann and Celanese, supra, cited.] Whether Bethenod be regarded as prior art in this case makes little or no difference. There is a wealth of prior art without it.

This is some support for the board's view, but not much.

Most writers do not bother with the 1952 opinions of the Second Circuit Court of Appeals in *Van der Horst Corp. v. Chromium Corp.*, 197 F.2d 791, 93 USPQ 350; 198 F.2d 748, 94 USPQ 288. The court made the mistake of using, "Under the doctrine of Alexander Milburn," the British filing date of [***68] a British patent cited as prior art. On rehearing, the court, in effect, withdrew that ruling saying, [*1317] "It is not necessary to decide the point and we leave it open * * *." The stated reason for withdrawal was:

We failed to take into consideration § 72 of Title 35, U.S.C.A. which provided that it should not "void" a patent that "the invention or discovery" had been previously "known or used in a foreign country, * * * if it had not been patented or described in a printed publication." It is reasonable to assume that Holmes, J., had § 72 in mind in *Alexander Milburn Co. v. Davis-Bournonville Co.*, supra, 270 U.S. at page 402, * * * when he said that "The policy of the statute as to foreign inventions obviously stands on its own footing and cannot be applied to domestic affairs."

The statute referred to as § 72 is R.S. 4923. Cf. 35 USC 104.

Ellis-Foster Co. v. Reichhold Chemicals, Inc., 198 F.2d 42, 94 USPQ 16 (3rd Cir. 1952), is cited in the Fishman article as significant because, in his opinion, it criticizes Viviani, which we do not find to be the case. The [***882] board herein in a footnote says that the patentee in Ellis-Foster failed to antedate the actual [***69] U.S. filing date of the reference patent, wherefore the issue here was not present. We agree.

The last case was in 1960 and at argument the solicitor indicated that it may have been what triggered the reconsideration of the law by the Patent Office and its subsequent change of position. It is *Sperry-Rand Corp. v. Knapp-Monarch Co.*, 193 F.Supp. 756, 127 USPQ 193 (E.D. Pa. 1961). The examiner here relied on it. The board seems to give it great weight here and in *Rapala (Lilly)*, finding in it the key phrase which is now its guiding principle - that section 119 gives "status to an application." The District Judge ¹⁰ had a problem with a Wimberger patent cited as prior art, whether it was effective as of its Austrian filing date or only as of its U.S. filing date. He called for authority on the point and counsel for both sides supplied it in letters, with arguments, copies of which we have. Counsel for Sperry-Rand presented the "status" argument, which is its origin, so far as we have seen, based on the "same effect" words in section 119. The only cases he cited as authority for his view were Young, Ellis-Foster, and van der Horst, all discussed above. The court decided, in a footnote, [***70] that

section 119 gives "status to an application, as distinguished from mere benefit to an applicant, based on the foreign filing. This status is not limited in its effects to the particular applicant involved. . . Consequently, the Wimberger patent must be considered." His footnote mentions none of his reasons for so deciding, other than the words of *section 119*, cites no cases, and does not discuss the matter further. Viviani was called to his attention as well as MPEP 715.01.

10 Senior Judge William H. Kirkpatrick, United States District Court for the Eastern District of Pennsylvania, who often sits with this court and is so sitting now, but who did not sit in this case.

[*1318] With regret and for the reasons we have fully explained, we must simply express disagreement with the decision of the single judge in *Sperry-Rand*. Like the view of the board, we view his construction of the words of the statute as too literal and in disregard of the history of the law which was not called to his attention. As [***71] to its lack of compelling force as a precedent, we quote from the board herein:

There was a rehearing in which the Court held that it was incumbent on the patentee to produce strong and convincing evidence of any prior date asserted, regardless of the Patent Office acceptance of an affidavit antedating references, 129 USPQ 305, 193 F.Supp. 756 (1961). There was no evidence in court, and hence the patentee had not overcome the filing dates of the other references involved, not even the U.S. filing date of the Wimberger patent. The issue involved here hence became moot and the statements of the Court regarding it are dicta, although this does not mean that they are incorrect. [Emphasis ours.]

Summary as to the Law and Its Legislative Ratification

We have now set forth extracts and digests of the materials produced by legal research to indicate what we believe the "law" to be. This, of course, is no substitute for the much more voluminous original materials. From it the following clear picture emerges.

[12] *Section 102(e)* was a codification of the Milburn doctrine. The Milburn case accorded a U.S. patent effect as a reference as of its U.S. filing date and stated that [***72] the policy of the statute on domestic inventions "cannot be applied to foreign affairs." No foreign date was involved in the case. The codifying statute specifies that the date as of which the patent has effect is the date of filing "in the United States."

R.S. 4887, predecessor of *section 119*, was in effect from 1903 to 1952 when it was incorporated unchanged in the present statutes. An examination of the legislative

history of that statute fails to reveal a scintilla of evidence that it [***883] was ever intended to give "status" to an application or to serve as a patent-defeating provision except insofar as the application, or patent issuing thereon, becomes involved in a priority contest. The Milburn rule, under which U.S. patents are used as prior art references for all matter disclosed in them as of their U.S. filing dates has been consistently and continuously applied since its inception in 1926, if not earlier under lower court decisions, by the United States Patent Office, the agency charged with the administration of the patent system in accordance with the view expressed by the Commissioner of Patents in 1935 in the Viviani case. That view was that R.S. 4887, and [***73] later *section 119*, does not make a U.S. patent effective as a reference as of a foreign priority date to [*1319] which it may be entitled. This view was further actively promulgated by the Patent Office in the first edition of its Manual of Patent Examining Procedure, Section 715.01, November, 1949, and so continued until May 27, 1964, after the expression by the board of its new view as exemplified in this case.

There is no case "law" on the issue here worth considering. Some seven cases have been cited pro and con, the most that can be found in a period of thirty-four years from 1926 to 1960. We believe they can be accurately summarized as follows: Van der Horst is concededly not in point. There are three cases cited as favoring the board's position here: *Fleischmann* is a doubtful precedent of uncertain meaning where one of two patents on a single invention was invalidated on the basis of a priority date to which the other was held entitled; a single judge in *Young* thought the priority date of a patent was its effective date as a reference, recognizing conflict as between two precedents; a single judge in *Sperry-Rand*, briefed on prior cases in letters from counsel but [***74] not on the statutory history, took the same view as the board here. On the other side there are also three cases: Viviani refusing to follow *Fleischmann* and expressly holding that the priority statute does not apply to the effective date of a reference; *Celanese* where a Court of Appeals refused to apply the priority date to a reference and said it is "immaterial"; and *Walker-Blumlein* where this 5-judge appellate court held that only the domestic filing date of a reference is effective, in which case the Patent Office Solicitor conceded that to be the law.

If any "weight of authority" is to be found in this we would say the scales tip more than perceptibly in favor of the restriction of U.S. patents as references to their filing dates in the United States, as stated in *section 102(e)* and in accordance with "in this country" limitations of 102(a), (g), and the prohibitions of *section 104*.

[13] But over and above this as a basis of decision we feel there is a paramount principle which controls.

53 C.C.P.A. 1288, *; 359 F.2d 859, **;
1966 CCPA LEXIS 420, ***; 149 U.S.P.Q. (BNA) 480

The administrative agency known as the Patent Office pursued a uniform policy and interpretation contrary to the new view of the board for the 26 years from 1926 to 1952, at least. The [***75] interpretation was well publicized and well known and must be assumed to have been known to Congress in 1952 when it revised and codified the patent statutes into present Title 35, United States Code. In that codification *section 119* reenacted R.S. 4887 with no change in substance, as above shown.

This legislative ratification of the interpretation of the statutes by the Patent Office determines the meaning and effect of *section 119* for the future. *Helvering v. Winmill*, 305 U.S. 79 (1938), *United States v. Dakota-Montana Oil Co.*, 288 U.S. 459 (1933). Under that interpretation, [*1320] *section 119* does not affect the express provision of 102(e) as to filing "in the United States" and the decision of the board that the Swiss filing date of Habicht is the effective date of his U.S. patent as a reference must be reversed.

Reason for Remand

As our analysis of the board's statements of the issue shows, the board concerned itself with a single question of [**884] law, the effective date of the Habicht patent as a reference under 35 USC 102(e) and 103. The only other question it dealt with was the merits of the rejection, having found Habicht to have an early enough date [***76] to be available as a reference. On the merits, it found the invention of all three appealed claims to be obvious within the meaning of 35 USC 103. We have not considered that finding because of our decision that Habicht is not available as a prior art reference, which makes it unnecessary to pass on the merits of the rejection based on Habicht in view of Wagner et al.

Claim 17 was rejected only on the disclosure of Habicht in view of Wagner et al. and since we have held Habicht to be unavailable, the rejection of that claim stands reversed.

As to claims 10 and 16, however, the examiner made an additional rejection (in his Answer it was the only rejection of these two claims) as "unpatentable over the count of Interference No. 90,218 now claim 1 of the Habicht patent in view of the Wagner et al reference." (The language is quoted from the examiner's Answer.) So far as we can see, the board failed to deal with this rejection. The only possibility that the board dealt with the rejection on the interference issue is in the paragraph we quoted early in this opinion and described as the board's "third statement" of the issue. We are unable to say whether the board agreed or disagreed [***77] with the examiner's rejection on the interference issue in saying "no questions of estoppel or res judicata can be raised concerning" the claimed compounds of appellants.

Since the board predicated its affirmance of the examiner's rejection entirely on its finding that Habicht was available as a reference to show what the statutory prior art was, since we are reversing on that issue, and since we are unable to ascertain the board's decision, if any, on the other outstanding rejection, we remand this case for clarification of the board's position on the rejection of claims 10 and 16 as "unpatentable over" the interference count in view of Wagner et al.

The decision of the board is reversed and the case is remanded for further proceedings consistent herewith.

[*1321] MARTIN, J., took no part in the decision of this case.

DISSENT BY: WORLEY

DISSENT

WORLEY, Chief Judge, dissenting.

It seems to me the majority below has the better of the argument with the majority here. Typical of my misgivings regarding the reasoning and conclusion of the present majority is the effort to fashion *In re Walker* into a controlling precedent for its position. It would be highly presumptuous of me [***78] to assume that merely because of my participation in that decision I became an authority on what the court held. It would be equally presumptuous to assume that I at once became an expert on Congressional intent merely as one of 435 members of the House of Representatives which passed by Boykin Act, or perchance as one of many who suggested or opposed language in that or other measures. The real test of judicial or legislative intent lies in the language employed. What the court held in *Walker* is found in its decision, and what Congress intended is found in the statute. In *Walker* this court expressly said:

The rejection by the tribunals of the Patent Office in the case at bar is based not upon the filing date of Whiteley's foreign application but upon the adverse award of priority of invention against appellant and in favor of Whiteley, the patentee. (Emphasis supplied).

Thus all else is obviously dicta.

There is no real judicial precedent in the cases cited below or here, save the [**885] recent District Court opinion ¹ in *Eli Lilly v. Brenner* where the issue was squarely raised and properly disposed of. ² In view of the unsettled and conflicting case law when the [***79] 1952 Patent Act was passed, it is not possible to ascertain which line of decisions Congress was "legislatively ratifying." Nor am I convinced that under such circumstances Congress was ratifying the then Patent Office practice. ³

53 C.C.P.A. 1288, *; 359 F.2d 859, **;
1966 CCPA LEXIS 420, ***; 149 U.S.P.Q. (BNA) 480

1 The author of that opinion is Judge Joseph R. Jackson who rendered distinguished service on this court for many years. He participated in Walker, and rejected it as precedent on the issue in Lilly.

2 See also *Sperry-Rand Corp. v. Knapp-Monarch Co.* to the same effect, although that discussion is, as in Walker, dicta.

3 The oft-repeated statement that administrative construction of a statutory provision receives legislative approval by reenactment of the provision without material change covers the situation where ambiguities in a statute are resolved by reference to administrative practice prior to reenactment. It does not mean that an interpretation of a provision of one act becomes frozen into another act merely by reenactment of that provision, so that administrative interpretation cannot be changed prospectively through exercise of appropriate administrative discretion. See *Helvering v. Wilshire Oil Co.*, 308 U.S. 90. Nor does it mean that prior construction has become so embedded in the law that only Congress can effect a change. *Helvering v. Reynolds*, 313 U.S. 428. Moreover, any assumed acquiescence of Congress to the Patent Office interpretation of RS 4887 prior to its 1952 enactment of *Section 119* would appear of little import, absent evidence that that interpretation was expressly called to the attention of Congress at the time and expressly adopted. See *Sutherland Statutory Construction*, § 5109 (3 ed. 1943).

[***80] Granted the desirability of following the status quo, this court has never been reluctant to depart, in some instances sua sponte, from [*1322] that principle. ⁴ Thus there is no valid reason in law or logic why this court should prevent the Patent Office from correcting, on its own, what it obviously recognizes to be prior misinterpretation of Congressional intent.

4 See, e.g., *Shoe Corp. of America v. Juvenile Shoe Corp. of America*, 46 CCPA 868, 266 F.2d 793, 121 USPQ 510, reversing Patent Office

practice and judicial precedent which had stood for over 30 years. See also *In re Bremner*, 37 CCPA 1032, 182 F.2d 216, 86 USPQ 74; *In re Nelson*, 47 CCPA 1031, 280 F.2d 172, 126 USPQ 242; *In re Wilke*, 50 CCPA 964, 314 F.2d 558, 136 USPQ 435; *In re Palmquist*, 51 CCPA 839, 319 F.2d 547, 138 USPQ 234; *In re Manson*, 52 CCPA 739, 333 F.2d 234, 142 USPQ 35, many of which are discussed in *Brenner v. Manson*, 383 US 519 (1966).

While it has been said (see *Bate Refrigerating Co. v. Sulzberger*, 157 U.S. 1; *Webster* [***81] v. *Luther*, 163 U.S. 331) that the practical construction given to an act of Congress, fairly susceptible of different constructions, by an executive department of the Government is entitled to respect, and in doubtful cases should be followed by the courts especially where interests have grown up under the practice adopted, it seems to me the meaning of the statute is clear and no prior practice inconsistent with that meaning can be given effect. See *Andrews v. Hovey*, 124 U.S. 694, 716-718. Antecedent administrative interpretation long in force does not render it impossible for the Patent Office to promulgate a new interpretation changing for the future the earlier practice, particularly when the new interpretation appears to comport with the plain meaning of the statute. See *American Chicle v. U.S.*, 316 U.S. 450. *Section 119* states that a United States application based on a foreign application "shall have the same effect as the same application would have if filed in this country on the date on which the application * * * was first filed in such foreign country." There is no language in *Section 119* to restrict that effect in any way, whether for purposes of obtaining a patent or [***82] subsequently utilizing that patent as a prior art reference, i.e. evidence of priority as to the disclosed subject matter, to defeat another's right to a patent. It seems to me the majority here legislates into the [***86] statute words of limitation which Congress has not placed there. That it cannot do. *Bate Refrigerating Co. v. Sulzberger*; *Electric Storage Battery Co. v. Shimadzu*, 307 U.S. 5, 14.

I would affirm.



LEXSEE 191 USPQ 334

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UNITED STATES PATENTS QUARTERLY

Ex parte Osmond, Smith, and Waite

No Number in Original

U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences

191 U.S.P.Q. (BNA) 334

Opinion dated July 27, 1973 Patent issued Dec. 7, 1976

CASE HISTORY and DISPOSITION: Appeal from Group 117.

Application for patent of Desmond Wilfrid John Osmond, Norman Douglas Patrick Smith, and Frederick Andrew Waite, Serial No. 818,249, filed Apr. 22, 1969, continuation in part of application, Serial No. 786,629, filed Dec. 24, 1968. From decision rejecting claims 1-6, 10, and 11, applicants appeal (Appeal No. 121-79). Reversed; Lidoff and Bennett, Examiners in Chief, concurring with opinion; Andrews, Examiner in Chief, submitted Special Opinion.

See also 191 USPQ 340 .

HEADNOTES:
PATENTS

[**1H] 1. Patentability -- Anticipation -- Patents -- In general (51.2211)

Claims are not 35 U.S.C. 102 anticipated by prior art patents that contain isolated disclosures with no teaching of any interrelationship, contain nothing that would direct person skilled in pertinent art to make selections necessary to formulate compositions having specific combination of features claimed, and do not disclose claimed invention in such manner as to give possession of it to person of ordinary skill.

[**2H] 2. Patent grant -- Intent of patent laws (50.15)

Patentability -- Anticipation -- Prior knowledge, use or sale (51.223)

Patentability -- Anticipation -- Publications -- In general (51.2271)

Fact that Congress was aware of judicial interpretation of predecessor of 35 U.S.C. 102(a) as requiring public knowledge and included essentially same language in 35 U.S.C. 102(a) implies that Congress was satisfied with previous interpretation; view is reinforced by fact that provisions permitting publication of applications and making published applications effective as references as of their filing dates were included in preliminary drafts of Title 35 but not in legislation enacted.

[**3H] 3. Patentability -- Anticipation -- Patents -- On copending applications (51.2219)

Patentability -- Anticipation -- Prior knowledge, use or sale (51.223)

Doctrine of Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390, is codified in 35 U.S.C. 102(e) and is exception to general rule that prior knowledge must be public in order to defeat another's patent rights.

[**4H] 4. Applications for patent -- Secrecy of application (15.7)

Patentability -- Anticipation -- Patents -- In general (51.2211)

Patentability -- Anticipation -- Patents -- On copending applications (51.2219)

Patentability -- Anticipation -- Prior knowledge, use or sale (51.223)

Patentability -- Anticipation -- Publications -- In general (51.2271)

Defensive Publication is not patent and cannot fall within exception provided by *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, and 35 U.S.C. 102(e), to general rule that prior knowledge must be public in order to defeat another's patent rights; Defensive Publication, which is no more than publication, cannot defeat another's right to patent prior to its publication date; application forming basis of publication is not available to public until date of abstract's publication, so that publication is not retroactively effective to defeat another's right to patent.

[**5H] 5. Patentability -- Anticipation -- Publications -- In general (51.2271)

Alien Property Custodian publications are effective as references only as of their publication dates.

[**6H] 6. Patentability -- Anticipation -- Prior knowledge, use or sale (51.223)

Patentability -- Anticipation -- Publications -- In general (51.2271)

Defensive Publication application's disclosure is not available as evidence of prior knowledge as of application's filing date.

Particular patents -- Aviation Fuel

Osmond, Smith, and Waite, Aviation Fuel Containing Dissolved Polymer and Having Reduced Tendency to Particulate Dissemination Under Shock, claims 1-6, 10, and 11 allowed.

CLASS-NO: 15.7, 50.15, 51.2211, 51.2219, 51.223, 51.2271

COUNSEL: Cushman, Darby & Cushman, Washington, D.C., for applicants.

JUDGES: Before Roeming, Magil, Lidoff, Andrews, a1 Schneider, Mattern, Serota, Witherspoon, Sturtevant, and Bennett, Examiners in Chief, and Blech, Acting Examiner in Chief.

a1 Since Examiner in Chief Andrews retired as of June 30, 1973, a Special Opinion written by him was mailed on June 29, 1973.

OPINIONBY: Serota, Examiner in Chief.

OPINION:

This is an appeal from the Examiner's decision finally rejecting claims 1 through 6, 10, and 11. Claims 7 and 8, the only other claims remaining in this application, have been indicated to be allowable.

Claim 1, which is representative of the claims on appeal, reads as follows:

1. A liquid hydrocarbon fuel of flash point at least 90 degreesF and suitable for use in gas turbine engined aircraft, characterized in that it has a reduced tendency to particulate dissemination on being subjected to shock, the fuel containing dissolved therein an addition polymer of ethylenically unsaturated monomer which is soluble in said hydrocarbon fuel and which does not precipitate when the fuel is cooled to low temperature in an aircraft, said polymer having a viscosity average molecular weight greater than 10⁶ or of intrinsic viscosity greater than 2.5 dls./gm. in a concentration such that there is molecular overlap of the polymer molecules in the liquid.

The references relied upon are:

Skei et al. 3,013,868 Dec. 19, 1961

Van der Minne

et al. 3,126,260 Mar. 24, 1964

Jacobson, Defensive Publication T-858,018, Multifunctional Polymeric Additive for Mineral Oils, January 21, 1969, based on [*336] Application Serial No. 664,925, filed September 1, 1967.

All the claims on appeal were rejected under 35 U.S.C. 102 "as anticipated by Skei et al., Van der Minne et al. and Jacobson."

The Examiner's position is to the effect that each of the patents and publication relied upon describes the addition of polymers having the here claimed minimum molecular weight to a jet aviation fuel at the claimed concentration of additive to fuel. The Examiner, therefore, concludes that each of the references anticipates the here claimed compositions.

The appellants, on the other hand, contend that none of the references either evidences an appreciation of the problem attacked by the appellants or discloses their solution to the problem. The appellants additionally argue that the references do not contain any examples specifically embodying the here claimed fuel.

An analysis of the claims on appeal reveals that they define a composition having at least the following required combination of features:

(1) a conventional jet aircraft fuel,

(2) a polymer having a viscosity average molecular weight of greater than 1,000,000,

(3) said polymer being an addition polymer of an ethylenically unsaturated monomer which is soluble in the fuel and non-precipitative at low temperature,

(4) said polymer being present at a certain specified concentration.

Go to Headnotes [*1R] [1] In our view, neither the Skei et al. patent nor the Van der Minne et al. patent teaches compositions having the specific combination of features required by the claims on appeal. It may be true, as urged by the Examiner, that the aforementioned patents do teach hydrocarbon liquid compositions containing various polymer additives; that they disclose that the liquid may be jet aircraft fuels; that the polymers may have molecular weights falling within ranges which overlap that recited in the claims, and that the polymers may be present in concentration ranges which overlap that here claimed. These, however, are isolated disclosures with no teaching that there is any interrelationship among these features. There is nothing within the patents which would direct a person skilled in the pertinent art to make the selections necessary to formulate a composition having the specific combination of features here claimed. These patents do not disclose or teach the invention here claimed in such manner as to "give possession of the invention to the person of ordinary skill," cf. In re Borst, *infra*. In such circumstances, we cannot agree with the Examiner that the compositions defined by the claims are "anticipated," within the meaning of 35 U.S.C. 102, by the disclosures of these patents.

With respect to the Jacobson reference, it is clear that the material contained in the published abstract in no way anticipates the claims on appeal. Indeed, one reading the published abstract would not reasonably expect the Jacobson application to have any disclosure dealing with the subject matter defined by the claims. However, the Jacobson application does, in fact, contain disclosure which is relevant to the here claimed subject matter and is considerably more pertinent

to the here claimed subject matter than either of the other two references. Even so, the disclosure would fail as an anticipation for essentially the same reasons given above with respect to Skei et al. and Van der Minne et al.

Lest in the future there be any question of the obviousness of the subject matter here claimed from the Jacobson application disclosure, we feel compelled to consider the further issue raised as to whether the Jacobson application is available as evidence of prior knowledge as of its filing date.

The appellants' application is asserted to be a continuation-in-part of their application Serial No. 786,629, filed December 24, 1968. No issue has arisen concerning the appellants being entitled to the benefit of the filing date of their parent application under 35 U.S.C. 120 with respect to the claims on appeal, and we have, in fact, determined that they are so entitled. Thus, appellants' effective filing date for the purposes of this appeal is December 24, 1968, which date is prior to the January 21, 1969, Jacobson publication date, but is subsequent to the September 1, 1967, filing date of the now abandoned Jacobson application.

The Examiner contends that the Jacobson Defensive Publication "may be used as a reference effective from its filing date * * * under 35 USC 102(a) as evidence that the subject matter of the defensive publication constitutes prior knowledge * * *." The Examiner's position is consistent with section 711.06(a) (page 96.2) of the Manual of Patent Examining Procedure (MPEP), and with the Commissioner's Notice establishing the current Defensive Publication program as published on April 11, 1968, 33 F.R. 5623, 849 O.G. 1221.

The pertinent portion of the above referred to section of the MPEP reads as follows:

An application or portion thereof from which an abstract, abbreviature or defense publication has been prepared, in the sense that the application is evidence of prior knowledge, may be used as a reference under 35 USC 102(a) effective from the actual date of filing in the United States. (Emphasis added)

The pertinent portion of the above noted Commissioner's Notice reads as follows:

After the defensive publication has appeared in the Official Gazette the abstract and suitable drawing copies will be available as prior art from the date of publication under 35 U.S.C. 102(a) or 102(b) as a printed publication. Also, at this time the application will be available as prior art under 35 U.S.C. 102(a) as evidence of prior knowledge from the actual date of filing the application in the Patent Office.

35 U.S.C. 102(a) reads:

A person shall be entitled to a patent unless -

the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Go to Headnotes [**2R] [2] The overwhelming weight of legal authority is to the effect that the knowledge contemplated by section 102(a) is required to be public knowledge. Although there are numerous court decisions on this point, we cite only *In re Lund et al.*, 54 CCPA 1361, 376 F.2d 982, 153 USPQ 625, 633, and cases cited therein; *In re Borst*, 52 CCPA 1398, 345 F.2d 851, 145 USPQ 554 citing *In re Schlittler et al.*, 43 CCPA 986, 234 F.2d 882, 110 USPQ 304; *Minneapolis-Honeywell v. Midwestern Instruments (CA 7)* 131 USPQ 402, aff'g 127 USPQ 149, 149; *Rem-Cru Titanium, Inc. v. Watson, Comr. Pats. (D.D.C. 1957)* 152 F.Supp. 282, 114 USPQ 529. n1 The predecessor statutes of 35 U.S.C. 102(a), including R. S. 4886, have also been interpreted as requiring that the knowledge necessary to defeat another's right to a patent be publicly accessible. See, for example, *Gayler v. Wilder*, 10 Howard 477, (1850). This is recognized in the reports of the Congressional Committees which were instrumental in the passage of the present patent statute. See the Journal of the Patent Office Society, Volume 34, Number 8, particularly pages 556 and 586. The Congress, although aware of the judicial interpretation of R. S. 4886 as requiring public knowledge, included essentially the same language as previously employed in its passage of 35 U.S.C. 102(a). Thus, the implication is that Congress was satisfied with the interpretation of the language previously employed. This view is reenforced by the fact that several preliminary drafts of the bill which became the present Title 35 of the United States Code included provisions permit-

ting the publication of applications and making the published applications effective as references as of their filing dates, but these provisions were not included in the legislation actually enacted.

n1 With respect to the apparently contrary holding in the unpublished decision (findings of fact and conclusions of law) of the District Court for the District of Columbia in *Ruskin v. Watson*, Civil Action 621-54, June 14, 1956, we note that the decision in that case was not followed by the same court (*Rem-Cru Titanium v. Watson*, *supra*), other courts (*Minneapolis-Honeywell v. Midwestern Instruments*, *supra*) or by the Board of Appeals (*Ex parte Stalego* 154 USPQ 52 ; *Ex parte Thelin* 152 USPQ 624) .

Go to Headnotes [**3R] [3] A departure from the general rule with respect to the necessity that the knowledge be publicly available was made by the Supreme Court in the case of *The Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 344 O.G. 817, 1926 C.D. 303. This case, in effect, held that a United States patent is evidence of prior knowledge of all subject matter described therein as of the filing date of the application from which the patent issued. The Milburn doctrine is codified in 35 U.S.C. 102(e) and is considered to be "an exception to the general rule that prior knowledge must be public in order to defeat another's patent rights," *In re Lund et al.*, *supra*, citing *In re Land et al.*, 54 CCPA 806, 368 F.2d 866, 151 USPQ 621 and *In re Hilmer et al.*, 53 CCPA 1288, 359 F.2d 859, 149 USPQ 480, 495-496 , and Committee Report, JPOS, *supra*. The Milburn doctrine has been held to be limited to its own factual situation and that in order to be applicable a patent must issue; cf. *In re Lund et al.*, *supra*, *In re Schlittler et al.*, *supra*, and Judge Baldwin's concurring opinion in the case of *In re Bass et al.*, (CCPA) 177 USPQ 178, 189 .

Go to Headnotes [**4R] [4] A Defensive Publication is not a patent. Therefore, it cannot fall within the Milburn - 102(e) exception to the general rule. A Defensive Publication is in reality no more than a publication, and as such, cannot be effective to defeat another's right to a patent prior to its publication date. The application forming the basis of the publication is not available to the public until the date of the publication of the abstract. See Patent Office Rules 11(b), 14(b), and 139. Therefore, there does not appear to be any legal foundation for making the publication retroactively effective to defeat another's right to a patent. [*338]

Go to Headnotes [**5R] [5] It is interesting to note that prior to the 1968 Commissioner's Notice, abbreviations, abstracts, and Alien Property Custodian publications were effective as references only as of their publication dates, and currently A.P.C. publications are effective as references only as of their publication date; MPEP 901.06(c).

The most recent and the most pertinent decision relating to the utilization of an unpatented application as evidence of prior knowledge under 35 U.S.C. 102(a) is *In re Lund et al.*, *supra*. This case, after considering many precedent cases dealing with this issue (note Judge Smith's citation of authorities in his concurring opinion), ruled as follows:

The question remains whether the disclosure in the abandoned '806 application is otherwise available as evidence of prior knowledge under 35 U.S.C. 102(a). There it is provided that a person shall be entitled to a patent unless the invention was known or used by others in this country * * * before the invention thereof by the applicant for patent. The "knowledge" required by that provision to defeat another's patent rights has long been interpreted to mean public knowledge. See *In re Hilmer*, 53 CCPA 1287, 359 F.2d 859, 878-879, 149 USPQ 480, 480 ; *In re Borst*, 52 CCPA 1398, 345 F.2d 851, 145 USPQ 554 , certiorari denied 382 U.S. 973; *In re Schlittler*, 43 CCPA 986, 234 F.2d 882, 110 USPQ 304 , and cases cited therein. Consistent with those rulings, we think the disclosure in Example 2 of the abandoned Margerison application becomes available as evidence of prior knowledge, if at all, only as of the issue date of the Margerison patent, as public access to the abandoned application is then provided for by Patent Office Rule 14(b).

Go to Headnotes [**6R] [6] Accordingly, it is our conclusion that the disclosure of a Defensive Publication application is not available as evidence of prior knowledge as of the filing date of the application.

The decision of the Examiner is reversed.

Lidoff, Examiner in Chief, with whom Bennett, Examiner in Chief joins, concurring specially.

We agree with the decision of the majority up to the second paragraph in page 336, the point at which the Commissioner's Notice is overruled. Once having held that the Jacobson application disclosure is inadequate to support the Examiner's rejection of the claims based upon 35 U.S.C. 102, we would have terminated the decision at that point since this determination is dispositive of the issues herein. We find no reason to reach out unnecessarily to rule upon and, in fact, to overrule the Commissioner's Notice.

Since the majority sees fit to go further, we express our disagreement with their conclusion.

While we might agree that the failure of the published abstract to include disclosure from the Jacobson application necessary to anticipate the claims might prevent reliance upon the filing date of said Jacobson application, we do not agree with the majority's holding, contrary to the Commissioner's Notice, that in a proper situation the benefit of the filing date of an application abandoned and published under the conditions set forth in the Commissioner's Notice is not available to support a rejection.

In the Federal Register, Volume 33, No. 71, April 11, 1968 announcing the Defensive Publication Program, it was stated that a patent applicant under the provisions of the changed Rules of Practice therein published might waive his rights to an enforceable patent on a pending patent application. It was positively stated (page 5624, column 1, third paragraph) that after publication of an abstract the patent application would become available as prior art under 35 U.S.C. 102(a) as evidence of prior knowledge from the actual date of filing the application in the United States Patent Office.

While it has been held in several decisions that the prior knowledge which is a bar to a patent under 35 U.S.C. 102(a), should be public prior knowledge, the terminology of the statute is not so limited (see also the conclusions of law 1 and, particularly, 2 in *Ruskin v. Watson*, Civil Action No. 621-54 dated June 14, 1956).

It is further quite clear that the so-called Milburn Doctrine (*Milburn Company v. Bournonville*, 270 U.S. 290), now codified in 35 U.S.C. 102(e), recognized the propriety of relying upon the filing date of a United States patent application later published as a patent as proper evidence of prior knowledge even though such prior knowledge was not publicly available at the time of filing the patent application.

It is our opinion, where there is incontrovertible evidence, in a properly filed U. S. patent application later made available to the public, of prior knowledge of an invention, even though not then public knowledge, that a patent on a later filed application should be barred under the provisions of 35 U.S.C. 102(a).

A defensive publication which has been published in accordance with the notice in [*339] the Federal Register indicated above, wherein the applicant has properly filed a patent application and, in consideration of the published offer to afford to the application the benefit of its filing date as evidence of prior knowledge with respect to a later filed application of another, has waived his rights to a patent and permitted publication, constitutes a fair parallel to the patent application which became a patent in the Milburn decision. The applicant of the defensive publication has complied with the published requirements of the Patent Office and has, as an alternative to permitting his application to become a patent, made his invention available to the public by means of the procedure proffered by the Patent Office and published in the amended Rules of Practice. Thus as a parallel to the findings in Milburn, it is our opinion that a defensive application with a proper abstract should be afforded the benefit of its filing date as evidence of prior knowledge of the invention therein disclosed. The disclosure after its filing date has been under the control of the United States Patent Office and is incontrovertible evidence of prior knowledge. Its later publication renders this knowledge available to the public in accordance with procedures outlined by the United States Patent Office.

Andrews, Examiner-in-Chief.

Because I am retiring from the Board of Appeals before the rendering of the opinion of the other members of the panel that heard this appeal, I shall state my conclusions on the merits of the appeal without any prior knowledge as to the ultimate decision which all, or a majority, of the other members of the panel may adopt. My alignment with the views of any subsequently rendered opinion or opinions thus will become self-evident.

It is my view that none of the three references applied by the examiner constitutes an anticipation of the instant claims under 35 U.S.C. 102.

The closest reference, by far, is the defensive publication T858,018, but this reference too lacks the qualities of a full anticipation of the invention, as claimed.

Because this publication does not recognize the property of the fuel composition to reduce the likelihood of explosion on impact, which is the property sought for in the instant invention, the anticipation of the claims here must rest on the proposition that this property is inherent in some particular fuel composition disclosed by the publication. There can be no such inherency for any fuel compositions arrived at by deriving them only through a process of selecting a concentration of the ingredients from one described composition and selecting a different molecular weight of the polymer from another composition.

Since the publication as a whole does disclose sufficiently broad ranges of values that it could appear that the claimed ranges would sufficiently approach or overlap those set out in the claims, it might well be that a case could be made for the prima facie obviousness of the claimed fuel composition. However, this is not the issue before us and because of the absence, at this stage of the prosecution, of any factual development in the case bearing on the issue of obviousness, I would not join in any new ground of rejection under Rule 196(b).

The above, in my view, is dispositive of the appeal but since a holding, contrary to my views, by other members of this board that the defensive publication would not be available as a reference as of its date of filing in the Patent Office, could be considered by them as likewise dispositive of the appeal, without reaching the issue of anticipation (or obviousness), I am impelled to state my views briefly as to the effective date of the defensive publication.

35 U.S.C. 6 provides that the Commissioner may establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Rule 139 and the defensive publication program was such a regulation by the Commissioner and established the effective date of a defensive publication as the filing date in the Patent Office.

35 U.S.C. 102(a) and 102(g) must be considered together to determine whether the program was inconsistent with law or the intent of Congress. The former section of the statute does not specify that the knowledge or use be public. This latter qualification, in other factual situations, has been invoked judicially to prevent secrecy and loss of the public disclosure, contrary to public policy. But this reason does not exist here where the prior inventor did not abandon, suppress or conceal the invention: as was specified in Section 102(g) because he made every effort to publicize the invention. If a prior use or knowledge can bar, in an interference, a later invention while the prior use or knowledge still was maintained in secrecy, other than for the filing of a patent application, as in Section 102(g), there could be no logical reason why a patent application that becomes the subject of a defensive publication should not bar a later invention, for the acceptance of the defensive publication is conclusive evidence that the first inventor had not abandoned, suppressed or concealed the invention.



LEXSEE 646 F. 2D 527

In re Wertheim and Mishkin

No. 80-603

United States Court of Customs and Patent Appeals

646 F.2d 527; 1981 CCPA LEXIS 227; 209 U.S.P.Q. (BNA) 554

April 9, 1981; As Amended April 15, 1981

COUNSEL: [**1] William H. Vogt, III, Morris N. Reinisch, Dennis P. Tramaloni, and Marcus J. Millet, all of New York, N.Y., for appellants.

Joseph F. Nakamura and Gerald H. Bjorge for Patent and Trademark Office.

OPINION BY: RICH

OPINION

[*528] Before Markey, Chief Judge, and Rich, Baldwin, Miller, and Nies, Associate Judges.

Rich, Judge.

This appeal is from the decision of the Patent and Trademark Office (PTO) Board of Appeals (board) affirming the final rejection under 35 USC 103 of claims 37, 38, and 44 in application serial No. 96,285, filed by Wertheim and Mishkin (Wertheim) December 8, 1970, entitled "Drying Method." We reverse.

At the outset, we note the prolonged, if not tortuous, prosecution of the present application. During the past decade, this application has appeared before us once before, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (1976) (Wertheim I), and has been involved in an aborted interference, No. 99,688, with a reference patent used in the instant rejection, United States Patent No. 3,482,990 to Pfluger. Only two of the original forty-three claims are now before us, dependent claims 37 and 38, original

claim 2 having been rewritten as independent claim 44, the principal [**2] claim on appeal.

The Invention

While the present and related inventions were described in Wertheim I, we give a synopsis of the claimed process, which is for freeze-drying coffee extract. Hot water is percolated through roasted and ground coffee beans to produce an aqueous coffee extract. After concentrating the extract to a point where its solids content is between 35% and 60%, it is charged with a gas to yield a foam. The pressure of the foam environment is regulated to be at least atmospheric pressure so as to avoid evaporative cooling, i.e., thermal loss resulting from vaporization of the aqueous portion of the extract. In the preferred embodiment of claim 37, the foam density is maintained between 0.4 grams per cubic centimeter (gm/cc) and 0.8 gm/cc. Finally the foam is frozen at the regulated pressure and freeze-dried in a conventional manner. During these "cold" steps, the foam temperature allegedly must be maintained below the eutectic temperature of the extract, i.e., the lowest possible constant melting point of the mixture to avoid the loss of flavoring compounds through evaporation.

Applications and References

Since both appellants' case and the [**3] effective date of one of the references depend on earlier filing dates, we provide the chronological [*529] table prior to discussing the reference disclosures and the rejection.

Date	References	Appellants
1949	Flosdorf	
March 24, 1961	Pfluger I filed (Ser. No. 98,007)	
July 24, 1963		Alleged actual reduction to practice

Date	References	Appellants
		by Wertheim
August 1963	Sivetz	
September 17, 1963	Pfluger II filed	
	(Ser. No. 309,410)	
April 2, 1965		Swiss filing by Wertheim
January 13, 1966	Pfluger II filed	
	(Ser. No. 520,347)	
March 28, 1966		Wertheim A filed (Ser. No. 537,679)
February 10, 1969	Pfluger IV filed	
December 9, 1969	Pfluger Patent issued	
	(No. 3,482,990)	
December 8, 1970		Wertheim B filed (Ser. No. 96,285, on appeal)

The References

The primary reference, cited by the examiner under 35 USC 102(c), is the Pfluger patent which issued on the last of a series of four applications, as shown above. The patent discloses a foam/freeze-dried coffee process for retaining volatile aromatics during the foaming and freezing steps. Improved retention of these compounds is supposedly achieved by [**4] avoiding evaporative cooling of a concentrated coffee extract. The Pfluger patent, like appellants' application, calls for maintaining the foam below its eutectic temperature. Claim 2 of the Pfluger patent was copied by appellants for interference purposes and is claim 44 on appeal.

The Pfluger application chain developed as follows: Pfluger IV was designated a continuation of Pfluger III, ¹ which was designated a continuation-in-part (CIP) of Pfluger II, which was designated a CIP of Pfluger I.

1 Pfluger III received a notice of allowance but did not issue. Instead, Pfluger filed a continuation, Pfluger IV.

Pfluger I did not support all of the limitations of the claims copied from the Pfluger patent. Specifically, it did not disclose concentrating the extract to a solids content of between 35% and 60% prior to foaming. Express disclosure of this limitation did not occur until Pfluger III. It also did not expressly disclose always creating the foamed extract at at least atmospheric pressure, a limitation [**5] first found in Pfluger II.

The Sivetz publication is a secondary reference which discloses a non-foamed, freeze-dried coffee process. The vacuum drying of this process results in flaked

coffee. The alleged advantage of this type of instant coffee is its excellent solubility in water. However, Sivetz states that "even under ideal freeze-drying conditions, the volatiles of coffee aroma and flavor are not retained any better, if as well, as in spray drying." It goes on to recommend less than 60% water content, and therefore a greater than 40% solids content, in any extract to be freeze-dried.

Flosdorf is an earlier publication also disclosing freeze-drying methods. It states that for economic reasons, one must produce freeze-dried coffee from extracts containing 40% to 50% solids.

The Rejection

In Wertheim I, this court held that interference claims 2 (now 44), 37, and 38 of appellants' still pending application were entitled to the benefit of the Swiss Wertheim application. Approximately eleven months later the PTO declared Interference No. 99,688 between the present application and the Pfluger patent. Appellants were designated senior party because of their Swiss [**6] filing date. Pfluger was made junior party.

After considering four motions by Pfluger, the Primary Examiner moved sua sponte to dissolve the interference and granted his own motion. In support of his decision, he stated that the claims copied by Wertheim were unpatentable under 35 USC 102(e) and/or 35 USC 103 over the Pfluger I and II disclosure in view of Sivetz.

Ex parte prosecution was resumed and the claims on appeal were rejected. The [*530] great-grandparent of the Pfluger patent, Pfluger I, was said to be "carried forward" into the patent. The missing limitation in Pfluger I was supposedly found in Sivetz. Essentially, the rejection

was based on, and was a modification of, the grounds stated in the dissolution decision. Appeal was then taken to the board.

After admitting in his Answer that the 1961 Pfluger application "fails to set forth specifically the values of the solids content within the range set forth in the Wertheim claims (35 to 60%)," the examiner said:

The question which must be considered and answered is what one with ordinary skill in the art would derive from the following teaching on page 3 of the 1961 Pfluger application:

In many applications [**7] such foaming can be considerably increased by concentrating the solution or suspension to a relatively high solids content prior to incorporation of air or other gas such as nitrogen therein by whipping.

The answer to the question presented is that it would be prima facie obvious to those with the ordinary skill in the art [to] which the subject matter relates to pre-concentrate to the values set forth in the Wertheim claims. This conclusion is reached by the following reasoning.

A patent specification is directed to those skilled in the art. Clearly, the data in the 1961 disclosure is not limited to the specific values set forth in the examples. The 1961 Pfluger disclosure teaches "concentrating * * * to a relatively high solids content" (page 3). When this teaching is viewed in the context of what is known in the art in the time frame of the instant subject matter, it would involve no more than ordinary skill of one in the art to pre-concentrate to the value claimed.

As set forth previously, the record of Wertheim establishes that freeze drying is a well known procedure. Because it is expensive, it is economically advantageous to pre-concentrate prior to freeze drying. [**8] Sivetz et al. cited above, amplify on this (page 506 in particular). Sivetz et al. point out that freeze drying is much more expensive than spray drying. Sivetz et al. also point out that (page 506 last two sentences):

In freeze and belt vacuum drying, water content should be less than 60 percent. This reduces water evaporation load and drying cost.

Accordingly when the Pfluger patent is read in light of the 1961 application disclosure, whose date patentees are entitled to for benefit of filing date, taken with Sivetz et al., it would be obvious to the ordinary worker in the art to pre-concentrate to the value set forth in the claims.

The Board

The board reversed the rejection on § 102(e) alone, but affirmed the §§ 102(e)/103 rejection. In doing so, it stated that the "Pfluger disclosure" was available as a

reference under 35 USC 102(e). Yet, the § 102(e) rejection was disapproved because not every material element in the appealed claims was disclosed in what the board called the "principal reference."

In awarding the Pfluger patent the benefit of the Pfluger I filing date, the board found "considerable guidance" from those portions of this court's opinion in [**9] Wertheim I dealing with process claims 6-14 and 16-29, supra 541 F.2d at 266 et seq., 191 USPQ at 99 et seq. It further noted that the disclosure from Pfluger II had been "carried forward into the patent." The Pfluger II disclosure was then compared to the Pfluger I disclosure, which states in pertinent part (quoted by the board):

In accordance with the present invention the foregoing objectives are achieved with improved results along the lines indicated by:

(1) freezing a foam containing food or pharmaceutical solids in suspension and/or solution to convert the water content thereof to a crystalline state; and

(2) freeze drying the foamy mass thus created to a stable moisture content while maintaining the moisture thereof in a substantially solid state.

[*531] In many applications such foaming can be considerably increased by concentrating the solution or suspension to a relatively high solids content prior to incorporation of air or other gas such as nitrogen therein by whipping. Although it is preferred that the foam be created in accordance with the present invention by whipping under atmospheric pressures and temperatures, the foam can also be created by other [**10] means such as inducing a superatmospheric pressure on the solution or suspension during agitation thereof (during which agitation extraneous gas such as nitrogen or carbon dioxide may be added) followed by sudden issuance of this solution or suspension from such a confined area of superatmospheric pressure to a reduced area of atmospheric or subatmospheric pressure such as occurs when the solution or suspension is caused to issue through an orifice or other suitable valve-operated aperture causing the food solids to foam under the influence of the pressure released. Other means for creating a foam involve the overt introduction to a solution or suspension of such means as dry ice, i.e., solid carbon dioxide in a suitable ground or particulate form, whereby carbon dioxide liberated upon subliming of the "dry ice" causes foaming of the solution or suspension to occur. Similarly, refrigerated air or nitrogen can be introduced to the solution or suspension to cause foaming thereof.

The foam preferably has a high overrun whereby the density of the solution or suspension is changed from 1.0 gm. per c.c. to between .1-.5 gms. per c.c.

Although Pfluger I was said to "not mention 'avoiding [**11] evaporation' in connection with the foaming and freezing steps," the board found that this concept was expressed in the Pfluger prosecution as early as Pfluger II. Furthermore, it held that the avoidance of evaporative cooling was inherent in the procedure disclosed in Pfluger I, i.e., the creation of a foam at at least atmospheric pressure and the proscription against allowing the frozen foam to melt while being dried. On this basis, the board held that "the substance of the relevant disclosure in Pfluger I was carried forward into the patent."

The secondary references were held to properly establish the obviousness of "the degree of concentration" claimed in the Pfluger patent as of the filing of Pfluger I. Excerpts from both Sivetz and Flosdorf were quoted to demonstrate that concentrating aqueous coffee extracts above a 30% solids content was well known in the art. However, no distinction was made between concentrating extracts for foamed and non-foamed freeze-drying processes.

Reading the board opinion as a whole, it clearly appears that the obviousness rejection under §§ 102(e)/103 was sustained on the basis of teachings which the board found in Pfluger I, read as though [**12] it were a proper prior art reference, taken with further suggestions gleaned from Sivetz and Flosdorf, the secondary references. The board said:

In conclusion, considering all the evidence, we hold that the Examiner properly relied on Sivetz and Flosdorf as establishing the obviousness of the degree of concentration required by the appealed claims in a process as taught by Pfluger.

Taken by itself, that statement does not show what teaching of Pfluger, out of all four applications, was meant, but the opinion makes clear it was talking about the 1961 Pfluger I application therein, previously referred to, which stated:

In many applications such foaming can be considerably increased by concentrating the solution or suspension to a relatively high solids content prior to incorporation of air or other gas such as nitrogen therein by whipping.

Opinion

At the outset, we wish to set forth and characterize the exact nature of the rejection and its statutory basis. While the board stated the rejection to be based upon 35 USC 103, we note that it is more properly viewed as a 35 USC 102(e)/ 35 USC 103 rejection. Because this distinction [*532] is the focal point of our decision [**13] to reverse, a short discussion of the nature of this rejection follows.

I. §§ 102(e)/103 Rejections

Section 102(e), a codification of the rule of Alexander Milburn Co; v. Davis-Bournonville Co., 270 U.S. 390 (1926), reads as follows:

A person shall be entitled to patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent * * *.

In Milburn, a patent infringement suit, the court held that material disclosed but not claimed in a United States patent may be used as a reference to anticipate a later invention as of the date the reference application was filed, rather than the date the patent finally issued.

The plaintiff in that case sued for infringement of Whitford's patent, which had issued on June 4, 1912, after being applied for on March 4, 1911. One Clifford had filed an application for a patent on January 31, 1911, which "gave a complete and adequate description of the thing patented to Whitford but * * * did not claim it." A patent issued to Clifford on February 6, 1912. Whitford could not prove a date of invention prior to his [**14] application date and, thus, his date of invention was after the Clifford application date but before the date Clifford's patent issued.

Although Clifford's application was not a matter previously "known or used," nor a patent or a printed publication, the Supreme Court reasoned that "the delays of the Patent Office ought not to cut down the effect of what has been done." The Clifford application was thus held to be prior art against the Whitford patent as of the former's filing date.

The Supreme Court in Hazeltine Research Inc. v. Brenner, Com'r; 382 U.S. 252, 147 USPQ 429 (1965), subsequently held that Milburn and § 102(e) may be applied to determine what is "prior art" under the § 103 requirement. Section 103 states in relevant part that

A patent not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. [Emphasis ours.]

While nowhere in Title 35 are the words "prior art" defined, the Senate and House Reports accompanying the 1952 [**15] Patent Act state:

[Section 103] refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in Section

102. S.Rep. No. 1979, 82d Cong., 2d Sess., U.S. Code Cong. & Admin. News at 2399.

Additionally, one draftsman of and the commentator on the 1952 Act, P.J. Federico, commented that:

The antecedent of the words "the prior art" * * * lies in the phrase "disclosed or described as set forth in Section 102" and hence these words refer to the material specified in Section 102 as the basis for comparison. Federico, Commentary On The New Patent Act, 35 USCA p. 1 at 20 (1954).

Commensurate with the Senate Report and Mr. Federico's commentary, we have held that the term "prior art" refers "to at least the statutory prior art material named in § 102." *In re Yale*, 52 CCPA 1668, 347 F.2d 995, 146 USPQ 400 (1965). See *In re Harry*, 51 CCPA 1541, 333 F.2d 920, 142 USPQ 164 (1964).

In *Hazeltine*, the court stated that earlier-filed applications for patents of another describing, although not necessarily claiming, the invention claimed in a later filed application, are prior art under § 102(e) and are available [*16] for consideration in support of a § 103 obviousness rejection of the later-filed application. See *In re Bowers*, 53 [*533] CCPA 1590, 359 F.2d 886, 149 USPQ 570 (1966). And, for purposes of both § 102 and § 103 analysis, they are prior art as of their filing dates.

In *Hazeltine*, Regis filed an application for patent on December 23, 1957. The examiner rejected the claims as obvious under § 103 in view of the disclosures of two patents, Carlson and Wallace. Carlson was issued eight years earlier and was clearly a valid reference, Wallace, however, was pending at the time of Regis' application, and had been filed almost four years earlier, prompting Regis to argue that it was not "prior art" because its disclosures were secret and not known to the public. In dismissing this argument, the Supreme Court stated (p. 255, 147 USPQ at 431):

Petitioners suggest * * * that the question in this case is not answered by mere reference to § 102(e), because in *Milburn*, which gave rise to that section, the co-pending applications described the same identical invention. But here the Regis invention is not precisely the same as that contained in the Wallace patent, but is only made [*17] obvious by the Wallace patent in light of the Carlson patent. We agree with the Commissioner that this distinction is without significance here. While we think petitioner's argument with regard to § 102(e) is interesting, it provides no reason to depart from the plain holding and reasoning in the *Milburn* case. The basic reasoning upon which the Court decided the *Milburn* case applies equally well here. When Wallace filed his application, he had done what he could to add his disclosures to the prior art. The rest was up to the Patent Of-

fice. Had the Patent Office acted faster, had it issued Wallace's patent two months earlier, there would have been no question here. As Justice Holmes said in *Milburn*, "The delays of the patent office ought not to cut down the effect of what has been done." P. 401.

The §§ 102(e)/103 rejection, thus, is one utilized where § 102(e) alone may fail because not every material limitation of the claimed invention is disclosed in the reference. That reference, referred to as "prior art" in § 103, may be combined with another to support an obviousness rejection. See *In re Caveney*, 55 CCPA 721, 386 F.2d 917, 155 USPQ 681 (1967).

A different situation [*18] arises where, unlike *Milburn* or *Hazeltine*, the reference patent issues not after only one application, but after a series of applications. In other words, after permitting the use of a patent reference in both § 102(e) and §§ 102(e)/103 rejections as of the reference filing date, the next question confronting the courts was what filing date was to be accorded a reference patent which issues after a series of applications. How far back can one extend the effective date of a reference patent as "prior art" in such a case?

II. 102(e) and Continuation Applications

In *In re Lund*, 54 CCPA 1361, 376 F.2d 982, 153 USPQ 625 (1967), this court was called upon to decide whether a certain compound disclosed in Example 2 of an application filed by Margerison on September 29, 1958, was available as prior art as of that filing date to reject Lund's claims, which were presented in an application filed almost a year later. Although Margerison abandoned the application, he had filed a continuation-in-part application, without Example 2, which resulted in issuance of the reference patent. The court stated it to be.

* * * well settled that where a patent purports on its face to be a [*19] "continuation-in-part" of a prior application, the continuation-in-part application is entitled to the filing date of the parent application as to all subject matter *carried over* into it from the parent application, whether for purposes of obtaining a patent or subsequently utilizing the *patent* disclosure as evidence to defeat another's right to a patent. [Emphasis in original.]

In deciding what had been "carried over," the court held that merely designating an application as a continuation-in-part was not sufficient to incorporate by reference the disclosure of the abandoned application into the patent disclosure, "as if fully set out therein." The court concluded that:

[*534] It seems to us that the sine qua non of § 102(e) and the *Milburn* case is that, consistent with the gain to the public which the patent laws mean to secure, a *patent must issue* which contains, explicitly or implicitly, the description of an invention which is to be relied

on to defeat a later inventor's patent rights. It does not appear that the patentee here has done "all that he could do to make his description public," Milburn, *supra*, for the language Margerison employs is not sufficient [**20] to incorporate the description of his earlier application into the patent and the description which the Patent Office relies upon appears only in the earlier application.

In *In re Klesper*, 55 CCPA 1264, 397 F.2d 882, 158 USPQ 256 (1968), the PTO rejected Klesper's claims as fully anticipated by a Frost patent under § 102(e) because Klesper could not antedate the effective date of the reference. The issue before this court was what that effective date was. Frost and Klesper had filed applications for patent on October 20, 1955, and September 18, 1956, respectively. Frost then filed a continuation-in-part application on April 1, 1959, which application culminated in the issuance of a patent on January 8, 1963, containing the 1959 disclosure. On January 6, 1964, Klesper filed a continuation-in-part application. The PTO gave the Frost patent the benefit of its parent filing date, October 20, 1955.

The court stated that § 102(e) was a codification of the historical treatment of a U.S. patent disclosure "as prior art as of the filing date of the earliest U.S. application to which the patent is entitled, provided the disclosure was contained in substance in the said earliest [**21] application." Thus, the determinative question became whether or not the subject matter of the appealed claims was disclosed both in the abandoned application and in the patent. The court agreed with the PTO conclusion that:

* * * Frost's abandoned application discloses the subject matter of the appealed claims and it is admitted that that subject matter is contained in the reference patent. It follows that it was carried forward and that the effective date of the patent as a prior art reference against the appealed claims under section 102(e) is October 20, 1955, which antedates appellant.

The Klesper case thus dealt with the dating back of a patent reference to gain the benefit of an earlier filing date. Lund was not so concerned, however, and considered only whether a disclosure appearing *only* in an abandoned application was to be regarded as prior art under § 102(e). Both cases involved rejections based upon § 102(e) alone.

We now come to the situation in the instant case, one which we believe has not heretofore been before us.² What patent disclosure, or portion thereof, which has been "carried over" through a chain of applications, may be traced back to an [**22] earlier application and given its effective date, and then combined with a secondary reference to reject later filed claims under §§ 102(e)/103?

2 A similar fact situation may have been before this court in *In re Switzer*, 35 CCPA 1013, 1019, 166 F.2d 827, 831, 77 USPQ 156, 159 (1948). However, because the reasoning of the court is unclear, the opinion lends no aid to resolution of the dispute at hand.

III. Continuing Applications and Rejections Under §§ 102(e)/103

We begin by noting the factual differences between this case and *Hazeltine*. In *Hazeltine* the Court utilized *all* of the reference patent disclosure as prior art. But because that disclosure was insufficient to support a rejection under § 102(e) alone, the Court approved combining it with a second reference for purposes of determining obviousness. In this case, utilization of all the reference patent disclosure would, of course, suffice to support a rejection, *if* its date is early enough, because Wertheim copied the Pfluger patent [**23] claims for interference. That disclosure, however, cannot be given an effective filing date early enough to antedate the Wertheim Swiss filing date. See Wertheim I. The PTO, [**535] therefore, has abstracted a *part* of the entire patent disclosure set forth in a Pfluger application dated prior to the Wertheim Swiss filing date, found it "carried over" into the patent, and, on the supposed authority of Lund and *Hazeltine*, used it in combination with a second reference to reject the Wertheim claims as obvious. For reasons which follow, we hold that was erroneous.

A. The Rejection

In the instant case, the examiner relied on Pfluger patent 3,482,990 and the Sivetz et al. publication and rejected the claims "under 35 USC 102(e) and/or 103 as unpatentable over Pfluger * * * in view of Sivertz et al.," saying that "Pfluger is entitled to the benefit of" Pfluger's 1961 filing date. The examiner also said, "Note 35 USC 120," but made no specific application thereof. Without addressing the relevance of this statute, the board said:

We will *not* affirm the rejection based solely on 35 U.S.C. 102(e), although we recognize that the Pfluger disclosure is available [**24] as a reference under the provisions of 35 U.S.C. 102(e).

Here one of the contested issues is whether the *principal reference* discloses concentrating the extract to the specific "higher solids level of between 35% and 60% soluble solids." Secondary references may well establish the *obviousness* of the quoted figures, but in that case *the rejection is under 35 U.S.C. 103* rather than *rejection is under 35 U.S.C. 103* rather than 35 U.S.C. 102.

The board was there distinguishing *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978), wherein this court said, "every material element of the claims was disclosed in the principal reference." It thus appears that the board was pointing out, backhandedly, that every material element of the Wertheim-Pfluger claims was *not* disclosed in the "principal reference."

It is of further interest to consider what the board meant in the above quotation by "principal reference" in referring to the instant case. The examiner's "principal reference" was the Pfluger patent; but there is no question that it discloses every element of the claims on appeal, which claims were copied by Wertheim from that patent. Therefore, the board could [**25] not have been referring to the Pfluger *patent* as the "principal reference" and the only possible deduction is that it was referring to the Pfluger I application. Therein lies its first error, for an abandoned application by itself can never be a reference. In any event, on the basis of the failure of disclosure in Pfluger I noted above, the board refused to sustain the rejection on § 102(e) alone, and affirmed only the rejection of the claimed invention as obvious under § 103.

B. Section 103

In every case, "the invention" referred to in § 103 is nothing more nor less than the subject matter being claimed by the applicant, which is the starting point of all inquiry about obviousness. Claim 44, the independent claim at bar, reads:

An improved process for minimising [sic] loss of volatiles during freeze-drying of coffee extract which comprises obtaining coffee extract, concentrating said extract to a higher solids level of *between 35% and 60% soluble solids*, foaming said concentrated extract to a substantial overrun by injection of a gas into said extract at at least atmospheric pressure *to thereby avoid evaporative cooling due to evaporation of water* in [**26] said extract during said foaming, freezing said foam to below its eutectic point at at least atmospheric pressure *while avoiding evaporative cooling*, and freeze-drying said extract at below the eutectic temperature of said extract.

Claim 37 merely adds the limitation that the overrun density be between 0.4 to 0.8 gm/cc, and claim 38 adds a different limitation, freeze drying at a pressure of about 150 to 175 microns.

Looking now to the basis of the § 103 rejection, regardless of what may have been in the minds of the board members, the principal reference to support this rejection [*536] is Pfluger patent No. 3,482,990. Does it show that all or part of the claimed invention was in the "prior art"? Of course, it shows *all* of the claimed invention. The claims were copied from it by Wertheim

and if it did not contain a complete description of the claimed invention it would not have been issued by the PTO. It issued, however, on December 9, 1969, and Wertheim has already been held entitled to an invention date at least as early as April 2, 1965, so what evidence does the patent contain that the patent disclosure was "prior art" with respect to Wertheim? As a patent [**27] or as a publication, the answer, of course, is none. How, then, does it function as a § 103 "reference"? It is this point that the PTO invokes § 102(e) on the authority of *Hazeltine* and makes the argument next to be described.

C. Sections 102(e) and 120

We are asked by the PTO to apply the "carried over" principle set forth in *Klesper* to the present §§ 102(e)/103 rejection. Specifically, the solicitor argues that since this court said in *Wertheim I* that Pfluger II was "carried forward" into the Pfluger patent, and Pfluger I discloses essentially the same invention as Pfluger II, the Pfluger reference patent must be awarded the benefit of the Pfluger I filing date.³

3 In *Wertheim I*, this court apparently relied upon *Lund* and, with regard to "non-interference" claims not now in issue, stated that, "we will apply as prior art under § 102(e) * * * those portions of the Pfluger patent disclosure that were carried forward from [Pfluger II]." 541 F.2d at 266, 191 USPQ at 99.

In this case, unlike *Wertheim I*, the board and the examiner rely upon the Pfluger I filing date, not the Pfluger II filing date. Therefore, we need not, and do not, reach any conclusions as to whether the latter date is effective against either the present "interference" claims or the "non-interference" claims of *Wertheim I*. We note, however, that the court in *Wertheim I* evidently did not utilize the principles of law we herein announce, which include a modification of the *Lund* dictum. See note 4 and accompanying text *infra*.

[**28] In responding to this argument, we first note that the Pfluger patent issued after a series of applications, the initial one (I), two continuation-in-part applications (II and III), and a continuation application (IV). Let us assume that Pfluger I disclosed subject matter A. Because two continuation-in-part applications followed, II may be said to contain subject matter AB, B representing new matter, and III may be said to contain ABC, C representing the additional new matter in that application. Continuation application IV, of course, also contains subject matter ABC.

Instead of determining what filing date the Pfluger *patent* was entitled to as a § 102(e) reference for purposes of the §§ 102(e)/103 rejection, however, the board

relied upon the language in Lund, that a disclosure which is "carried over" into the patent from previous applications may be used to defeat the patent rights of another inventor. In other words, rather than examining the Pfluger patent in the light of §§ 120 and 112, it reached back to Pfluger I and retrieved A, found it "carried over" into the patent and combined it with a secondary reference to find the Wertheim invention obvious.

Although [**29] this court apparently embraced this procedure in Wertheim I, such an approach in a situation where there are continuation-in-part applications ignores the rationale behind the Supreme Court decisions in Milburn and Hazeltine that "but for" the delays in the Patent Office, the patent would have earlier issued and would have been prior art known to the public. The patent disclosure in Milburn was treated as prior art as of its filing date because at the time the application was filed in the Patent Office the inventor was presumed to have disclosed an invention which, but for the delays inherent in prosecution, would have been disclosed to the public on the filing date. A continuation-in-part application, by definition, adds new matter to the parent application previously filed. Thus, the type of new matter added must be inquired into, for if it is critical to the patentability of the claimed invention, a patent could not have issued on the earlier filed application and the theory of Patent Office delay has no [*537] application.

Additionally, it is at this point in the analysis that § 120 enters the picture, for the phrase in § 102(e), "on an application for patent," necessarily [**30] invokes § 120 rights of priority for prior co-pending applications. If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent. For if a patent *could not* theoretically have issued the day the application was filed, it is not entitled to be used against another as "secret prior art," the rationale of Milburn being inapplicable, as noted above. In other words, we will extend the "secret prior art" doctrine of Milburn and Hazeltine only as far as we are required to do so by the logic of those cases.

Initially then, the question becomes the familiar one of which filing date the Pfluger patent is entitled to for various purposes, including its effectiveness as a § 102(e) reference under § 103 evidencing "prior art." *Lund, supra*. It is clear that it cannot be used as a reference under § 102(e) *alone* against the Wertheim invention as of the date of a Pfluger application which does not describe the Wertheim invention, [**31] as claimed. See *In re Smith*, 59 CCPA 1025, 458 F.2d 1389, 173 USPQ 679 (1972).

The conditions under which a filing date earlier than that of the last in a series of applications on which a patent issues may be accorded to a patent *with respect to any given claimed subject matter* are clearly set forth in § 120:

An application for patent *for an invention* disclosed in the manner provided by the first paragraph of *section 112* of this title in an application previously filed in the United States by the same inventor shall have the same effect, *as to such invention*, as though filed on the date of the prior application * * *.

We omit the balance of the section because there is no question here about compliance with its terms. The first paragraph of § 112 reads:

The specification shall contain a written description *of the invention*, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out *his invention*.

[**32] We emphasize that the above noted statutes, §§ 102(e), 120, and 112, speak with reference to some specific claimed subject matter by use of the terms emphasized. It is axiomatic in patent law that questions of description, disclosure, enablement, anticipation, and obviousness can only be discussed with reference to a specific claim which identifies "the invention" referred to in the statutes.

Thus, the determinative question here is whether the invention claimed in the Pfluger patent finds a *supporting disclosure in compliance with § 112*, as required by § 120, in the 1961 Pfluger I application so as to entitle that invention in the Pfluger patent, as "prior art," to the filing date of Pfluger I. Without such support, the invention, and its accompanying disclosure, cannot be regarded as prior art as of that filing date.

As previously noted, new matter can add material limitations which transform an unpatentable invention, when viewed as a whole against the prior art, into a patentable one. A continuation-in-part application, unlike a continuation application, does not necessarily insure that all critical aspects of the later disclosure were present in the parent. Thus, [**33] in situation such as this, only an application disclosing the patentable invention before the addition of new matter, which disclosure is carried over into the patent, can be relied upon to give a reference disclosure the benefit of its filing date for the purpose of supporting a §§ 102(e)/103 rejection.

[*538] D. *The Pfluger I disclosure*

Although the board and the examiner have tacitly, if not expressly, admitted that Pfluger I does not disclose the claimed invention -- indeed, that fact can be implied from the § 103 rejection for obviousness as well as from the board's reversal of the rejection based on § 102(e) alone -- we here devote some necessary discussion to this factual issue.

In the course of answering appellants' argument that they had been put into a situation where they could not contest priority with Pfluger or take advantage of 37 CFR 1.131, the board said:

This situation arises because, under 35 U.S.C. 102(e), the Pfluger patent has an effective date, with respect to the relevant subject matter, of March 24, 1961. Appellants have offered no evidence to antedate said date.

The only date the Pfluger patent has *under § 102(e)* is February [**34] 10, 1969, the filing date of Pfluger IV, the application on which the patent issued. Any earlier U.S. filing date for the patent necessarily depends on further compliance with §§ 120 and 112. The board appears to have assumed the existence of the very point at issue here -- whether the patent reference *is* entitled to a March 24, 1961, filing date.

We take note of two claim limitations missing from Pfluger I but present in the Pfluger patent which answer the question of whether to award the 1961 filing date to the § 102(e) reference patent disclosure. Pfluger I did not expressly disclose either concentrating the coffee extract to a 35% to 60% solids content, or avoiding evaporative cooling during the foaming and freezing steps. If either limitation, later added as new matter, resulted in the disclosure of a patentable invention for the first time, it is relevant to our determination of whether the Pfluger patent receives the benefit of the Pfluger I filing date.

The board did not "attach any significance" to the absence of express language disclosing the avoidance of evaporative cooling. Since the Pfluger I application disclosed gas injection into the extract "at at [**35] least atmospheric pressure," the board held that the above concept was inherently disclosed in the Pfluger I method.

Moreover, the board gave little weight to the addition of a solids content range in Pfluger III. Even though the examples in Pfluger I did not illustrate concentrating coffee extracts above 30%, the general statement in Pfluger I about concentrating extracts was said not to be limited in scope to the specific examples. Thus, the board apparently did not find either of the above claim limitations to be new matter, much less relevant new matter.

A closer examination of the Pfluger file history reveals that the above limitations were relevant, indeed, critical new matter. From Pfluger II on, the patentee ar-

gued with the examiner over that feature of his process which he believed made the invention patentable -- the avoidance of evaporative cooling. However, it was not until after the filing of Pfluger III that the first allowance of claims occurred. There are patentee successfully distinguished the prior art by expressly stating the conditions under which such cooling is avoided. Both at least a 35% solids content and foaming under "conditions which avoid the [**36] evaporation of water" were allegedly necessary for allowance. It was the combination of these steps, and others, which was held to be a patentable invention and deemed allowable by the examiner in Pfluger III. In fact, during the prosecution of Pfluger IV, the examiner required that Pfluger specify the minimum level of concentration for the coffee extract -- at least 35%.

The board erred in ruling that since "the substance of the relevant disclosure in Pfluger I was carried forward into the patent," that same disclosure in the reference patent was entitled to the Pfluger I filing date, *even though the entire patent was not*. While some of the reference patent disclosure can be traced to Pfluger I, such portions of the original disclosure cannot be found "carried over" for the purpose of awarding filing dates, unless that disclosure constituted a full, clear, concise and exact description in accordance with § 112, first [**539] paragraph, of the invention claimed in the reference patent, else the application could not have matured into a patent, within the Milburn § 102(e) rationale, to be "prior art" under § 103.

The two claim limitations of the reference patent [**37] missing from Pfluger I were a necessary part of the only patentable invention ever set forth in the Pfluger file history. These limitations, however, were neither expressly nor inherently part of the original Pfluger disclosure. Absent these steps, the Pfluger I filing date cannot be accorded to the Pfluger patent reference. Without that date, the reference does not antedate Wertheim's alleged actual reduction to practice and cannot be combined with another reference to support a § 103 rejection.

To look at it another way, without the benefit of the Pfluger I filing date, that part of the reference patent disclosure relied upon cannot be said to have been incipient public knowledge as of that date "but for" the delays of the Patent and Trademark Office, under the Milburn rationale. Here, it cannot be said to have been "carried over" into the reference patent for purposes of defeating another's application for patent under §§ 102(e)/103.

The dictum in *Lund*, *supra*, that * * * the continuation-in-part application is entitled to the filing date of the parent application as to all subject matter *carried over* into it from the parent application * * * for purposes of * [**38] * utilizing the *patent* disclosure as evidence to

646 F.2d 527, *; 1981 CCPA LEXIS 227, **;
209 U.S.P.Q. (BNA) 554

defeat another's right to a patent * * * [emphasis in original]

4 It was dictum because the only relevant holding in Lund was that matter *not* carried over could not be used as evidence of prior art. The quoted passage in the text was not necessary to the decision.

is hereby modified to further include the requirement that the application, the filing date of which is needed to make a rejection, must disclose, pursuant to §§ 120/112, the invention claimed in the reference patent. Where continuation-in-part applications are involved, the

logic of the Milburn holding as to secret prior art would otherwise be inapplicable. Without the presence of a patentable invention, no patent could issue "but for the delays of" the PTO.

Conclusion

Since the patent disclosure used in the present rejection is not effective as a reference as of the Pfluger I filing date, the decision of the board affirming the §§ 102(e)/103 rejection of claims 37, 38, and 44 [**39] is *reversed*.

Reversed.



LEXSEE 270 US 390

ALEXANDER MILBURN COMPANY v. DAVIS-BOURNONVILLE COMPANY

No. 107

SUPREME COURT OF THE UNITED STATES

270 U.S. 390; 46 S. Ct. 324; 70 L. Ed. 651; 1926 U.S. LEXIS 419

January 11, 12, 1926, Argued
March 8, 1926, Decided

PRIOR HISTORY: CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

CERTIORARI to a decree of the Circuit Court of Appeals which affirmed a decree of the *District Court* (297 Fed. 846) enjoining an alleged infringement of plaintiff's patent.

DISPOSITION: 1 Fed. 2d 227, reversed.

LAWYERS' EDITION HEADNOTES:

Patents -- description of invention in application as disclosure. --

Headnote:

A description in an application for a patent of a thing claimed in a subsequent application by another, filed before the patent is issued, is a disclosure which, in the absence of evidence carrying the invention of the second claimant further back, prevents issuance of patent to the second claimant, although it was not claimed in the first application.

SYLLABUS

1. Where a patent application fully and adequately disclosed, but did not claim, the thing patented to a later applicant alleging a later date of invention, the later applicant was not the "first inventor" within Rev. Stats. § 4920. P. 399.

2. As regards "reduction to practice," a description that would bar a patent if printed in a periodical or in an issued patent is equally effective in an application. P. 401.

COUNSEL: Mr. James A. Watson, for petitioner.

The court below erred in assuming that under the defense of R. S. 4920 it was necessary to show that Clifford was the "first inventor," whereas the statute simply requires proof that Whitford "was not the original and first inventor." No inter partes question of priority of invention is involved in this defense. It also erred in overlooking the presumption of law that what Clifford disclosed and did not claim was old and known when he filed his application. *Millett & Reed v. Duell*, 18 App. D. C. 186; *Mahn v. Harwood*, 112 U.S. 354. It erred further in overlooking the inequity of the grant to Whitford of a monopoly which would deprive Clifford of the right to use important features of his own device and deprive the public of the right to use what was disclosed in Clifford's prior application and which was either known to Clifford to be old, or, if invented by Clifford, deliberately dedicated to the public. There are many cases in which this Court and the lower courts have held that the first inventor, having reduced his invention to practice, may abandon or dedicate his invention to the public, by failure to claim, or for other reasons, but we have found no case in which such abandonment or dedication has been held to entitle a later inventor to a patent for the invention. *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274; *Miller v. Brass Co.*, 104 U.S. 350; *Eames v. Andrews*, 122 U.S. 40; *Deering v. Winona Harvester Works*, 155 U.S. 286; *McClain v. Ortmyer*, 141 U.S. 419. Assuming that Clifford was the inventor of the thing he failed to claim, he made it public property as soon as the patent issued and every day that passed thereafter added to the strength of the public right. *Mahn v. Harwood*, 112 U.S. 354.

The right of the public to use the invention was tentative during the period of two years from the date of the Clifford patent, as during this period Clifford might have filed an application for a reissue, or a divisional application, claiming the invention, and the application would have related back to the date of filing the original application. *Chapman v. Wintroath*, 252 U.S. 126; *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249; *Millett &*

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Reed v. Duell, 18 App. D. C. 186; Ex parte Grosslin, 97 O. G. 2977. The issuance of such a patent to Clifford, after interference with Whitford, would have invalidated the Whitford claims, as, obviously, there cannot be two monopolies of the same thing. The Whitford patent was allowed through oversight of the Patent Office and contrary to established practice as pointed out in the Patent Office Rules. Clifford perfected his invention when he filed his application.

The application was a constructive reduction to practice - of what it disclosed -- before Whitford conceived. *Chapman v. Wintroath*, supra; *Smith & Griggs Mfg. Co. v. Sprague*, supra; *Von Recklinghausen v. Dempster*, 34 App. D. C. 474.

Clifford had an inchoate right to claim the invention or to re-claim it up to the instant the public came into full possession. *Roberts v. Ryer*, 91 U.S. 150; *Pope Mfg. Co. v. Gommully Mfg. Co.*, 144 U.S. 224; *Naceskid Service Chain Co. v. Perdue*, 1 Fed. 2d 924; *Diamond Drill Mch. Co. v. Kelly Bros.*, 120 Fed. 295; *Westinghouse v. Charters Val. Gas Co.*, 43 Fed. 582; *Barnes Automatic Sprinkler Co. v. Walworth Mfg. Co.*, 51 Fed. 88, 60 Fed. 605; *Farmers' Handy Wagon Co. v. Beaver Silo & Box Mfg. Co.*, 236 Fed. 731; *Hamilton Beach Mfg. Co. v. Geirer Co.*, 230 Fed. 430; *Camp Bros. & Co. v. Portable Wagon Dump & E. Co.*, 251 Fed. 603; *Willard v. Union Tool Co.*, 253 Fed. 48.

The decisions of the Court of Appeals of the District of Columbia are of great importance as they control the interpretation of the law in the Patent Office. See *Millett & Reed v. Duell*, 18 App. D. C. 186.

The doctrine announced by the court below is in conflict with the uniform practice in the Patent Office during the last 50 years. *United States v. Hill*, 120 U.S. 169; *Baltzell v. Mitchell*, 3 Fed. 2d 428; Ex parte Wright, 1870 C. D. 60; *Bell v. Gray*, 15 O. G. 776; Ex parte Bland, 16 O. G. 47. It appears that, shortly after the Bland decision, the practice of declaring an interference between a pending application claiming and a patent disclosing but not claiming an invention was discontinued. The practice of rejecting an application claiming upon a patent disclosing but not claiming an invention was continued and has been the uniform practice of the Patent Office to the present time. Instead of declaring an interference and determining the question of priority inter partes, present Patent Office Rule 75 permits the applicant to overcome such a patent by making "oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued." This rule is at present in force and

no change has been made in it during the past twenty-seven years.

Under the practice of the Patent Office, for at least fifty years, the application for the Whitford patent should have been rejected upon the Clifford patent which was issued while the Whitford application was pending and which admittedly disclosed, without claiming, the invention claimed by Whitford. The allowance of the Whitford patent was an oversight.

Mr. D. S. Edmonds, with whom Messrs. R. Morton Adams, J. F. Brandenburg, and William H. Davis were on the brief, for respondent.

There are two ways in which an earlier filed patent can be used to invalidate a later one, by establishing prior knowledge, or by establishing prior invention. Our patent system, in defining the conditions under which an inventor is entitled to a patent, adopts the fundamental view that the invention must not have been known before, and adds that it will be deemed known if it has been printed in a publication or patented in this or a foreign country, but not if it has only been used in a foreign country (§ 4923, R. S.). The conditions giving rise to the right to a patent are defined by § 4886, R. S., and the procedural requirements which must be complied with in procuring the grant after the right has arisen are defined in §§ 4888 to 4893, R. S., inclusive. Broadly stated, any failure to comply with the conditions of § 4886 prevents the right to a patent from arising, and is a defense to a suit on the patent; and any failure to comply with the procedural requirements of §§ 4888 to 4893, inclusive, invalidates the grant because of a defect in the procedure.

The date of conception by an inventor becomes important only when someone else asserts a right to a patent for the same invention and it is necessary to determine which was first. There may be two persons who are original inventors within the meaning of § 4886, but they cannot both be first inventors. If each asserts his right to a patent, a contest of priority arises. The statute provides for such a contest in the Patent Office under § 4904, R. S., and in the courts under § 4918, R. S.

The application is not a printed publication. Nor is it a patent. It indicates nothing as to the completeness of the disclosure of the patent in suit or as to whether the invention in suit was in public use or on sale or abandoned. It therefore has no bearing on the matters set out in the first, third, and fifth clauses of § 4920. It can have a bearing only on the defenses of the second and fourth clauses. The second clause, in its literal wording, is directed to a situation where the patentee secured a patent for an invention which had been conceived at an earlier

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date by another who was using diligence in perfecting it, and it has been held to recognize the right of an inventor, in a contest of priority, to go back to his date of conception. *Reed v. Cutter* [1841], 1 Story, 590. It is this defense which is pleaded in the case at bar; and Clifford is set up as the prior inventor. But, since the issue on the conflict of law involves more than this, it is necessary to consider the fourth clause, which holds that, if the prior knowledge be shown by the fact of prior invention by another, it must be a completed invention actually reduced to practice and available to the public. The mere fact of prior invention is not enough, as it is well settled that a concealed, forgotten, or abandoned invention is not a bar to a patent to a subsequent inventor. *Gayler v. Wilder*, 10 How. 477; *Mason v. Hepburn*, 13 App. D. C. 86.

A patent application does not establish prior invention or priority of right unless the subject matter disclosed is claimed. It is true that the fact of prior invention may be used to invalidate if the prior invention was in fact reduced to practice so that it was actually available to the public. But in such case it becomes a part of the public knowledge, and may be proved as such, and the assertion of a right to a patent has no bearing.

Briefly stated, the history, substance, and application of the doctrine of constructive reduction to practice are as follows:

1. From the point of view of the patent system, an invention is not complete until the inventor has taken it out of the realm of speculation into that of fact; until he has actually built the machine which he is supposed to have invented so that it has a real existence and is available to the public.
2. The patent statutes (§ 4886) do not require this actual reduction to practice if a complete allowable application for a patent on the invention is filed. This act has been called a "constructive reduction to practice."
3. It is essential that the patentee claim his invention.
4. The doctrine has no application to unclaimed subject-matter, and has been evolved solely for the benefit of one asserting a right to a patent. When relied upon by the defendant in a suit for infringement, it may be used only insofar as the subject-matter is claimed.

Reduction to practice consists of making and using the invention so that it has a physical existence. This does not mean the mere making of sketches or description. There must be more than this. The invention must be taken out of the realm of speculation into that of reality.

Reed v. Cutter, 1 Story 590; *Agawam v. Jordan*, 7 Wall. 583; *Seymour v. Osborne*, 11 Wall. 516; *Draper v. Potomska Mills Corp.*, 3 Ban. & A. 214; *Automatic v. Pneumatic*, 166 Fed. 288; *Warren Bros. Co. v. Owosso*, 166 Fed. 309; *Sydeman v. Thoma*, 32 App. D. C. 362.

Conception may be evidenced by sketches or description showing a complete idea of means. But not so with reduction to practice. *Lyman Co. v. Lator*, 12 Blatch. 303; *Howes v. McNeal*, 15 Blatch. 103; *Porter v. Loudon*, 7 App. D. C. 64; *Mason v. Hepburn*, 13 App. D. C. 86, and cases cited; *Sydeman v. Thoma*, 32 App. D. C. 362. In the early years of our patent system reduction to practice could be proved only by a showing that there was an actual successful practice of the invention. And it was held that such a reduction to practice was necessary before any right to a patent arose. *Reed v. Cutter*, 1 Story 590; *Washburn v. Gould*, 3 Story 122; *Cahoon v. Ring*, 1 Cliff. 592; *Whiteley v. Swayne*, 7 Wall. 685; *Agawam v. Jordan*, 7 Wall. 583; *Seymour v. Osborne*, 11 Wall. 516; *Lyman v. Lator*, 12 Blatch. 303; *Herring v. Nelson*, 14 Blatch. 293; *Howes v. McNeal*, 15 Blatch. 103. Later cases held, however, that, where one is asserting his right to a patent, the statutes do not require an actual reduction to practice if the patent is allowed. *Wheeler v. Clipper*, 10 Blatch. 181; *Telephone Cases*, 126 U.S. 1; *Automatic v. Pneumatic*, 166 Fed. 288. It is essential that the application be not only allowable, but be allowed. Abandoned or rejected applications are not considered evidence of prior invention. *Corn Planter Patent*, 23 Wall. 181; *Lyman v. Lator*, 12 Blatch. 303; *Fire Extinguisher Co. v. Philadelphia*, 1 Ban. & A. 177; *Herring v. Nelson*, 14 Blatch. 293; *Webster v. Sanford*, 1888 C. D. 92.

Section 4888, R. S., requires the applicant to "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery." Section 4892 requires him to "make oath that he does verily believe himself to be the original and first inventor or discoverer of the . . . improvement for which he solicits a patent." The time at which the claim is made does not affect this, as it may be made by amendment, in a divisional application, or by reissue. *Smith & Griggs Co. v. Sprague*, 123 U.S. 249; *Austin v. Johnson*, 18 App. D. C. 83; *Ex parte Waterman*, C. D. 235; *Hopfelt v. Read*, C. D. 319; *Duryea & White v. Rice*, 28 App. D. C. 423; *Von Recklinghausen v. Dempster*, 34 App. D. C. 474; *Chapman v. Wintroath*, 252 U.S. 126. The original disclosure cannot be materially changed. The statement of invention and the claims may be changed; but when an applicant presents a claim for matter originally shown or described, but not substantially embraced in the statement of invention or claim originally presented, he is required to file a supplemental oath to the effect that the subject-matter of the proposed amendment was part of

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his invention and was invented before he filed his original application. The purpose of the disclosure is to make the invention so clear that no further invention is necessary to put it into practice, so that, upon issuance of the patent, the public will be as fully aware of the invention as if it actually saw and used it. It is essential that this requirement be complied with before allowance, and patents are held invalid for noncompliance. *Wood v. Underhill*, 5 How. 1; *Tannage Co. v. Zahn*, 66 Fed. 986; *Natl. Chemical Co. v. Swift & Co.*, 100 Fed. 451; *Featheredge Rubber Co. v. Miller Rubber Co.*, 259 Fed. 565. To determine this, the Patent Office examines the part claimed to determine its operability. There is no occasion to consider any part which is not claimed or which is not essential to the part claimed. Patents which are inoperative in unclaimed and nonessential features are not held invalid for that reason. *Keystone Foundry Co. v. Fastpress Co.*, 263 Fed. 99; *Pickering v. McCullough*, 194 U.S. 319; *Dalton Adding Mch. Co. v. Rockford Mch. Co.*, 253 Fed. 187, aff. 267 Fed. 422; *Manhattan Book Co. v. Fuller Co.*, 204 Fed. 286.

The doctrine of "constructive reduction to practice" was evolved, therefore, only to assist one asserting in a formal way a right to a patent, and it had nothing to do with proving prior invention as a defense. The fact that the applicant is actively engaged in securing a patent on an invention and at the same time is disclosing matter which he does not claim, seems to us to be evidence that the unclaimed matter was not his invention. *Electric Co. v. Westinghouse Co.*, 171 Fed. 83.

The unclaimed disclosure in a patent application does not constitute prior knowledge within the meaning of § 4886 as of the date of filing of the application. Section 4886 provides that if a device is in use publicly it is within the knowledge of the art, or if it is described in a printed publication or in a patent it will be deemed to be within the knowledge of the art. But it has always been held that sketches, drawings or description, regardless of how complete they may be, and regardless of the fact that they are known to several people, do not constitute knowledge within the meaning of § 4886 unless they are published. *Searls v. Bouton*, 12 Fed. 140; *Stitt v. Eastern R. Co.*, 22 Fed. 649; *Judson v. Bradford*, 3 Ban. & A. 539; *Westinghouse v. General Elec. Co.*, 199 Fed. 907, aff. 207 Fed. 75; *De Kando v. Armstrong*, 37 App. D. C. 314; *Robinson*, Vol. I, page 310. To regard the subject-matter disclosed but not claimed in an application as part of the prior art as of the date of filing of that application is, we think, so far in conflict with the practical purpose of the patent law and so inconsistent with all the other rules and procedures that have grown up in the practical carrying out of that purpose that it must be rejected.

JUDGES: Taft, Holmes, Van Devanter, McReynolds, Brandeis, Sutherland, Butler, Sanford, Stone

OPINION BY: HOLMES

OPINION

[*399] [**324] [***652] MR. JUSTICE HOLMES delivered the opinion of the Court.

This is a suit for the infringement of the plaintiff's patent for an improvement in welding and cutting apparatus alleged to have been the invention of one Whitford. The suit embraced other matters but this is the only one material here. The defense is that Whitford was not the first inventor of the thing patented, and the answer gives notice that to prove the [***653] invalidity of the patent evidence will be offered that one Clifford invented the thing, his patent being referred to and identified. The application for the plaintiff's patent was filed on March 4, 1911, and the patent was issued June 4, 1912. There was no evidence carrying Whitford's invention further back. Clifford's application was filed on January 31, 1911, before Whitford's, and his patent was issued on February 6, 1912. It is not disputed that this application gave a complete and adequate description of the thing patented to Whitford, but it did not claim it. The District Court gave the plaintiff a decree, holding that, while Clifford might have added this claim to his application, yet as he did not, he was not a prior inventor, 297 Fed. Rep. 846. The decree was affirmed by the Circuit Court of Appeals. 1 Fed. 2d 227. There is a conflict between this decision and those of other Circuit Courts of Appeals, especially the sixth. *Lemley v. Dobson-Evans Co.*, 243 Fed. 391. *Naceskid Service Chain Co. v. Perdue*, 1 Fed. 2d 924. Therefore a writ of certiorari was granted by this Court. 266 U.S. 596.

The patent law authorizes a person who has invented an improvement like the present, 'not known or used by others in this country, before his invention,' &c., to obtain a patent for it. Rev. Sts. § 4886, amended, March 3, 1897, c. 391, § 1, 29 Stat. 692. Among the defences to a suit for infringement the fourth specified by the statute is that the patentee 'was not the original and first inventor [*400] or discoverer of any material and substantial part of the thing patented.' Rev. Sts. § 4920, amended, March 3, 1897, c. 391, § 2, 29 Stat. 692. Taking these words in their natural sense as they would be read by the common man, obviously one is not the first inventor if, as was the case here, somebody else has made a complete and adequate description of the thing claimed before the earliest moment to which the alleged inventor can carry his invention back. But the words cannot be taken quite so simply. In view of the gain to the public that the patent laws mean to secure we assume for purposes of decision that it would have been no bar to Whitford's patent if

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Clifford had written out his prior description and kept it in his portfolio uncommunicated to anyone. More than that, since the decision in the case of *The Cornplanter Patent*, 23 Wall. 181, it is said, at all events for many years, the Patent Office has made no search among abandoned patent applications, and by the words of the statute a previous foreign invention does not invalidate a patent granted here if it has not been patented or described in a [**325] printed publication. Rev. Sts. § 4923. See *Westinghouse Machine Co. v. General Electric Co.*, 207 Fed. 75. These analogies prevailed in the minds of the Courts below.

On the other hand, publication in a periodical is a bar. This as it seems to us is more than an arbitrary enactment, and illustrates, as does the rule concerning previous public use, the principle that, subject to the exceptions mentioned, one really must be the first inventor in order to be entitled to a patent. *Coffin v. Ogden*, 18 Wall. 120. We understand the Circuit Court of Appeals to admit that if Whitford had not applied for his patent until after the issue to Clifford, the disclosure by the latter would have had the same effect as the publication of the same words in a periodical, although not made the basis of a claim. 1 Fed. 2d 233. The invention is made public property [*401] as much in the one case as in the other. But if this be true, as we think that it is, it seems to us that a sound distinction cannot be taken between that case and a patent applied for before but not granted until after a second patent is sought. The delays of the patent office ought not to cut down the effect of what has been done. The description shows that Whitford was not the first inventor. Clifford had done all that he could do to make his description public. He had taken steps that would make it public as soon as the Patent Office did its work, although, of course, amendments might be required of him before the end could be reached. We see no reason in the words or policy of the law for allowing Whitford to profit by the delay and make himself out to be the first inventor when he was not so in fact, when Clifford had shown knowledge inconsistent with the allowance of Whitford's claim, [*Webster*] *Loom Co. v. Higgins*, 105 U.S. 580, and when otherwise the publication of his patent would abandon the thing described to the public [***654] unless it already was old. *McClain*

v. Ortmyer, 141 U.S. 419, 424. *Underwood v. Gerber*, 149 U.S. 224, 230.

The question is not whether Clifford showed himself by the description to be the first inventor. By putting it in that form it is comparatively easy to take the next step and say that he is not an inventor in the sense of the statute unless he makes a claim. The question is whether Clifford's disclosure made it impossible for Whitford to claim the invention at a later date. The disclosure would have had the same effect as at present if Clifford had added to his description a statement that he did not claim the thing described because he abandoned it or because he believed it to be old. It is not necessary to show who did invent the thing in order to show that Whitford did not.

It is said that without a claim the thing described is not reduced to practice. But this seems to us to rest on [*402] a false theory helped out by the fiction that by a claim it is reduced to practice. A new application and a claim may be based on the original description within two years, and the original priority established notwithstanding intervening claims. *Chapman v. Wintroath*, 252 U.S. 126, 137. A description that would bar a patent if printed in a periodical or in an issued patent is equally effective in an application so far as reduction to practice goes.

As to the analogies relied upon below, the disregard of abandoned patent applications, however explained, cannot be taken to establish a principle beyond the rule as actually applied. As an empirical rule it no doubt is convenient if not necessary to the Patent Office, and we are not disposed to disturb it, although we infer that originally the practice of the Office was different. The policy of the statute as to foreign inventions obviously stands on its own footing and cannot be applied to domestic affairs. The fundamental rule we repeat is that the patentee must be the first inventor. The qualifications in aid of a wish to encourage improvements or to avoid laborious investigations do not prevent the rule from applying here.

Decree reversed.



LEXSEE 60 FR 20195

FEDERAL REGISTER

Vol. 60, No. 79

Rules and Regulations

DEPARTMENT OF COMMERCE (DOC)

Patent and Trademark Office (PTO)

37 CFR Parts 1 and 3

[Docket No. 950404087-5087-01]

RIN 0651-AA76

Changes To Implement 20-Year Patent Term and Provisional Applications

60 FR 20195

DATE: Tuesday, April 25, 1995

ACTION: Final rule.

To view the next page, type .np* TRANSMIT.
To view a specific page, transmit p* and the page number, e.g. p*1

[*20195]

SUMMARY: The Patent and Trademark Office (PTO) is amending the rules of practice in patent cases to establish procedures for: filing and processing provisional application papers; calculating the length of any patent term extension to which an applicant is entitled where the issuance of a patent on an application filed on or after June 8, 1995 (the implementation date of the 20-year patent term provisions of the Uruguay Round Agreements Act), other [*20196] than for designs, was delayed due to interference proceedings, the imposition of a secrecy order and/or appellate review; and implementing certain transitional provisions contained in the Uruguay Round Agreements Act.

EFFECTIVE DATE: June 8, 1995.

FOR FURTHER INFORMATION CONTACT: Magdalen Y. Greenlief or John F. Gonzales, Senior Legal Advisors, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, by telephone at (703) 305-9285, by fax at (703) 308-6916 or by mail marked to their attention and addressed to the Commissioner of Patents and Trademarks, Box DAC, Washington, D.C. 20231.

SUPPLEMENTARY INFORMATION: The Uruguay Round Agreements Act (Public Law 103-465) was enacted on December 8, 1994. Public Law 103-465 amends 35 U.S.C. 154 to provide that the term of patent protection begins on the date of grant and ends 20 years from the filing date of the application. The amendment applies to all utility and plant patents issued on applications having an actual United States application filing date on or after June 8, 1995. Specifically, 35 U.S.C. 154(a)(2), as contained in Public Law 103-465, provides that the patent term will begin on the date on which the patent issues and will end twenty years from the date on which the application was filed in the United

States. If the application contains a specific reference to an earlier application under 35 U.S.C. 120, 121 or 365(c), the patent term will end twenty years from the date on which the earliest application referred to was filed. As amended by Public Law 103-465, 35 U.S.C. 154 does not take into account for determination of the patent term any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).

Under 35 U.S.C. 154(b)(1), as contained in Public Law 103-465, if the issuance of an original patent is delayed due to interference proceedings under 35 U.S.C. 135(a) or because the application is placed under a secrecy order under 35 U.S.C. 181, the term of the patent shall be extended for the period of delay, but in no case more than five (5) years.

Under 35 U.S.C. 154(b)(2), as contained in Public Law 103-465, if the issuance of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than five (5) years. However, a patent shall not be eligible for extension under 35 U.S.C. 154(b)(2) if the patent is subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

Under 35 U.S.C. 154(b)(3)(B) and 154(b)(3)(C), as contained in Public Law 103-465, the period of extension under 35 U.S.C. 154(b)(2) shall be reduced by any time attributable to appellate review before the expiration of three (3) years from the filing date of the application and for any period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

Under 35 U.S.C. 154(b)(4), as contained in Public Law 103-465, the total duration of all extensions of a patent under 35 U.S.C. 154(b) shall not exceed five (5) years.

The provisions for patent term extension under 35 U.S.C. 154(b) are separate from and in addition to the patent term extension provisions of 35 U.S.C. 156. The patent term extension provisions of 35 U.S.C. 154(b) are designed to compensate the patent owner for delays in issuing a patent, whereas the patent term extension provisions of 35 U.S.C. 156 are designed to restore term lost to premarket regulatory review after the grant of a patent. In order to prevent a term extension under 35 U.S.C. 154(b) from precluding a term extension under 35 U.S.C. 156, Public Law 103-465 amends 35 U.S.C. 156(a)(2) to specify that the term has never been extended under 35 U.S.C. 156(e)(1).

The 20-year patent term provision is contained in 35 U.S.C. 154, as amended by Public Law 103-465. *Section 154 of title 35, United States Code*, applies to utility and plant patents, but not to design patents. The term of a design patent is defined in 35 U.S.C. 173 as fourteen (14) years from the date of grant. Therefore, the patent term and patent term extension provisions set forth in 35 U.S.C. 154, as amended by Public Law 103-465, do not apply to patents for designs.

In addition, Public Law 103-465 establishes a domestic priority system. In accordance with the provisions of the Paris Convention for the Protection of Industrial Property, the term of a patent cannot include the Paris Convention priority period. Public Law 103-465 provides a mechanism to enable applicants to quickly and inexpensively file provisional applications. Applicants will be entitled to claim the benefit of priority in a given application based upon a previously filed provisional application in the United States. The domestic priority period will not count in the measurement of the term.

Section 111 of title 35, United States Code, was amended by Public Law 103-465 to provide for the filing of a provisional application on or after June 8, 1995. *Section 41(a)(1) of title 35, United States Code*, was amended by Public Law 103-465 to provide a \$ 150.00 filing fee for each provisional application, subject to a fifty (50) percent reduction for a small entity. The requirements for obtaining a filing date for a provisional application are the same as those which previously existed for an application filed under 35 U.S.C. 111, except that no claim or claims as set forth in 35 U.S.C. 112, second paragraph, is required. Moreover, no oath/declaration as set forth in 35 U.S.C. 115 is required. The provisional application is also not subject to the provisions of 35 U.S.C. 131, 135 and 157, i.e., a provisional application will not be examined for patentability, placed in interference or made the subject of a statutory invention registration. Further, the provisional application will automatically be abandoned no later than twelve (12) months after its filing date and will not be subject to revival to restore it to pending status beyond a date which is after twelve (12) months from its filing date. A provisional application will not be entitled to claim priority benefits based on any other application under 35 U.S.C. 119, 120, 121 or 365.

Also, Public Law 103-465 amended 35 U.S.C. 119 to allow an applicant to claim the benefit of the filing date of one or more copending provisional applications in a later filed application for patent under 35 U.S.C. 111(a) or 363. The later filed application for patent under 35 U.S.C. 111(a) or 363 must be filed by an inventor or inventors named in the copending provisional application not later than 12 months after the date on which the provisional application was filed

and must contain or be amended to contain a specific reference to the provisional application. The provisional application must disclose an invention which is claimed in the application for patent under 35 U.S.C. 111(a) or 363 in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the provisional application must be pending on the filing date of the application for patent under 35 U.S.C. 111(a) or 363 and the filing fee set forth in subparagraph (A) or (C) of 35 U.S.C. 41(a)(1) must be paid.

Since 35 U.S.C. 154(a)(3), as contained in Public Law 103-465, excludes from the determination of the patent term any application on which priority is claimed under 35 U.S.C. 119, [*20197] 365(a) or 365(b), the filing date of a provisional application is not considered in determining the term of any patent.

Section 119(e)(1) of title 35, United States Code, provides that if all of the conditions of 35 U.S.C. 119 (e)(1) and (e)(2) are met, an application for patent filed under 35 U.S.C. 111(a) or 363 shall have the same effect as though filed on the date of the provisional application. Thus, the effective United States filing date of an application for patent filed under 35 U.S.C. 111(a), and entitled to benefits under 35 U.S.C. 119(e), is the filing date of the provisional application. Any patent granted on such an application, is prior art under 35 U.S.C. 102(e) as of the filing date of the provisional application.

Likewise, the effective United States filing date of a patent issued on an international application filed under 35 U.S.C. 363, and entitled to benefits under 35 U.S.C. 119(e), is the filing date of the provisional application, except for the purpose of applying that patent as prior art under 35 U.S.C. 102(e). For that purpose only, 35 U.S.C. 102(e) defines the filing date of the international application as the date the requirements of 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) were fulfilled.

Public Law 103-465 further includes transitional provisions for limited reexamination in certain applications pending for two (2) years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). The transitional provisions also permit examination of more than one independent and distinct invention in certain applications pending for three (3) years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). These transitional provisions are not applicable to any application which is filed after June 8, 1995, regardless of whether the application is a continuing application.

The amendments to title 35 relating to 20-year patent term, patent term extension, provisional applications and the transitional provisions are effective on the date which is six (6) months after the date of enactment, i.e., on June 8, 1995.

A Notice of Proposed Rulemaking was published in the **Federal Register** at 59 FR 63951 (December 12, 1994) and in the *Patent and Trademark Office Gazette* at 1170 Off. Gaz. Pat. Office 377-390 (January 3, 1995).

Forty-nine written comments were received in response to the Notice of Proposed Rulemaking. A public hearing was held at 9:30 a.m. on February 16, 1995. Fourteen individuals offered oral comments at the hearing. The forty-nine written comments and a transcript of the hearing are available for public inspection in the Special Program Law Office, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, Room 520, Crystal Park I, 2011 Crystal Drive, Arlington, Virginia, and are available on the Internet through anonymous file transfer protocol (ftp), address: [ftp.uspto.gov](ftp://uspto.gov).

The following includes a discussion of the rules being added or amended, the reasons for those additions and amendments and an analysis of the comments received in response to the Notice of Proposed Rulemaking.

Changes in text: The final rules contain numerous changes to the text of the rules as proposed for comment. Those changes are discussed below. Familiarity with the Notice of Proposed Rulemaking is assumed.

Section 1.9(a)(1) is being changed for clarity to define a national application as a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371. Also, a new paragraph (a)(3) is being added to define the term "nonprovisional application" as a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

The proposed deletion of § 1.60 is being withdrawn. Therefore, § 1.17(i) is being changed to retain the reference to § 1.60.

Section 1.17(q) is being changed to delete the fifty (50) percent reduction for small entities in the \$ 50.00 fee established for filing a petition under § 1.48 in a provisional application and a petition to accord a provisional application a filing date or to convert an application filed under § 1.53(b)(1) to a provisional application.

Sections 1.17(r) and (s) are being changed to include a fifty (50) percent reduction for small entities in the fees established for entry of a submission after final rejection under § 1.129(a) and for each additional invention requested to be examined under § 1.129(b). In the final rule, the fee required by §§ 1.17(r) and 1.17(s) from a small entity is \$ 365.00. The fee required from other than a small entity is \$ 730.00.

The elimination of the small entity reduction in § 1.17(q) and the addition of the small entity reduction in §§ 1.17(r) and (s) are the result of additional review, which resulted in the conclusion that the fees established for the transitional procedures in §§ 1.129 (a) and (b) may be reduced by fifty (50) percent for small entities. However, the petition fees required by § 1.17(q) are not subject to the fifty (50) percent reduction for small entities.

The proposed deletion of the retention fee practice set forth in former § 1.53(d), now redesignated § 1.53(d)(1), is being withdrawn. Therefore, § 1.21(1) is being retained and amended to refer to § 1.53(d)(1). Also, the proposed change in the text to § 1.17(n) is being withdrawn, since § 1.60 is being retained.

Section 1.28(a) is being changed to clarify the procedure for establishing status as a small entity in a nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application. In such cases, applicants may file a new verified statement or they may rely on a verified statement filed in the prior application, if status as a small entity is still proper and desired. If applicants intend to rely on a verified statement filed in the prior application, applicants must include in the nonprovisional application either a reference to the verified statement filed in the prior application or a copy of the verified statement filed in the prior application. A verified statement in compliance with existing § 1.27 is required to be filed in each provisional application in which it is desired to pay reduced fees.

Section 1.45(c), first sentence, is being changed for clarity to refer to a "nonprovisional" application.

Section 1.48 is being changed to include a new paragraph (e) setting forth the procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application. The procedure requires an amendment deleting the name of the person who was erroneously named accompanied by: a petition including a statement of facts verified by the person whose name is being deleted establishing that the error occurred without deceptive intention; the fee set forth in § 1.17(q); and the written consent of any assignee. The first sentences of §§ 1.48 (a)-(c) are also being changed for clarity to refer to a "nonprovisional" application.

Section 1.51(a)(2)(i) is being changed to require that the provisional application cover sheet include the residence of each named inventor and, if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government, the name of the U.S. Government agency and Government contract number. The residence of each named inventor is information which is [*20198] necessary to identify those provisional applications which must be reviewed by the PTO for foreign filing licenses. If the invention disclosed in the provisional application was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government, the security review for that application should already have been done by that agency of the U.S. Government. Therefore, identification of those particular provisional applications on the cover sheet will reduce the number of applications which the PTO must forward to other agencies of the U.S. Government for security review.

Section 1.53(b)(1) is being changed to retain the reference to § 1.60.

Section 1.53(b)(2)(ii) is being changed to require that any petition and petition fee to convert a § 1.53(b)(1) application to a provisional application be filed in the § 1.53(b)(1) application prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of twelve (12) months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. Where the § 1.53(b)(1) application was abandoned before the expiration of twelve (12) months after the filing date of the application, a petition to convert the application to a provisional application may be filed in the § 1.53(b)(1) application if the petition to convert is filed prior to the expiration of twelve (12) months after the filing date of the § 1.53(b)(1) application and is accompanied by an appropriate petition to revive an abandoned application under § 1.137.

Section 1.53(b)(2)(iii) is being changed to indicate that the requirements of §§ 1.821-1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

Section 1.53(d)(1) is being changed to retain the retention fee practice. The proposal to delete the retention fee practice set forth in § 1.53(d) is being withdrawn.

The first sentences of §§ 1.55 (a) and (b) are being changed for clarity to refer to a "nonprovisional" application.

Also, §§ 1.55 (a) and (b) are being changed to clarify that the nonprovisional application may claim the benefit of one or more prior foreign applications or one or more applications for inventor's certificate.

Section 1.59 is being changed to retain the reference to the retention fee set forth in § 1.21(l) and to clarify that the retention fee practice applies only to applications filed under § 1.53(b)(1).

The proposal to delete § 1.60 is being withdrawn. Therefore, § 1.60 is being retained and amended to clarify in the title of the section and in paragraph (b)(1) that the procedure set forth in the section is only available for filing a continuation or divisional application if the prior application was a nonprovisional application and complete as set forth in § 1.51(a)(1). Also, paragraph (b)(4) is being amended to delete the requirement that the statement which must accompany the copy of the prior application include the language that "no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein." The requirement is unnecessary because any amendment filed to complete the prior application would be considered a part of the original disclosure of the prior application and, by definition, could not contain new matter. Also, paragraph (b)(4) is being amended to refer to § 1.17(i).

Section 1.62(a) is being changed to refer to a prior complete "nonprovisional" application and to clarify that a continuing application may be filed under § 1.62 after payment of the issue fee if a petition under § 1.313(b)(5) is granted in the prior application. Section 1.62(a) is also being changed to clarify the existing practice that the request for a § 1.62 application must include identification of the inventors named in the prior application.

Section 1.63(a) is being changed for clarity to refer to an oath or declaration filed as a part of a "nonprovisional" application.

Section 1.67(b) is being changed for clarity to refer to a "nonprovisional" application.

Section 1.78 (a)(1) and (a)(2) are being changed to refer to a "nonprovisional" application and to clarify that the nonprovisional application may claim the benefit of one or more prior copending nonprovisional applications or international applications designating the United States of America. Section 1.78(a)(1)(ii) is being changed to retain the reference to § 1.60. Section 1.78(a)(1)(iii) is being retained and amended to refer to §§ 1.53(b)(1) and 1.53(d)(1).

Sections 1.78 (a)(3) and (a)(4) are being changed to refer to a "nonprovisional" application and to clarify that the nonprovisional application may claim the benefit of one or more prior copending provisional applications.

Section 1.78(a)(3) is also being changed to remind applicants and practitioners that when the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional application must be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. *Section 111(b)(5) of title 35, United States Code*, states that a provisional application is abandoned twelve months after its filing date. Sections 119 (e)(1) and (e)(2) of title 35, United States Code, require that a nonprovisional application claiming benefit of a prior provisional application be filed not later than twelve months after the date on which the provisional application was filed and that the provisional application be pending on the filing date of the nonprovisional application. Under §§ 1.6 and 1.10, no filing dates are accorded to applications on a Saturday, Sunday, or Federal holiday within the District of Columbia. Thus, if a provisional application is abandoned by operation of *35 U.S.C. 111(b)(5)* on a Saturday, Sunday, or Federal holiday within the District of Columbia, a nonprovisional application claiming benefit of the provisional application under *35 U.S.C. 119(e)* must be filed no later than the preceding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 1.78(a)(4) is also being changed to delete the requirement that the reference in the nonprovisional application to the provisional application indicate the relationship of the applications. As a result of the change, § 1.78(a)(4) provides that a nonprovisional application claiming benefit of one or more provisional applications must contain a reference to each provisional application, identifying it as a provisional application and including the provisional application number (consisting of series code and serial number). However, the section does not require the nonprovisional application to identify the nonprovisional application as a continuation, divisional or continuation-in-part application of the provisional application.

Section 1.83(a) is being changed to delete the proposed redesignation of paragraph (a) and to delete proposed paragraph (a)(2). Also, §§ 1.83 (a) and (c) are being changed for clarity to refer to a "nonprovisional" application. Further, § 1.83(c) is being changed to remove the reference to paragraph (a)(1).

Section 1.101 is being changed for clarity to refer to a "nonprovisional" application. [*20199]

Sections 1.129 (a) and (b) are being changed to identify the effective date of 35 U.S.C. 154(a)(2) as June 8, 1995.

Further, § 1.129(a) is being changed to provide that the first and second submissions and fees set forth in § 1.17(r) must be filed prior to the filing of an Appeal Brief, rather than prior to the filing of the Notice of Appeal, and prior to abandonment of the application. The requirement that the fee set forth in § 1.17(r) be filed within one month of the notice refusing entry is being deleted. Section 1.129(a) is also being changed to provide that the finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). The language indicating that the submission would be entered and considered after timely payment of the fee set forth in § 1.17(r) "to the extent that it would have been entered and considered if made prior to final rejection" is being deleted. In view of the magnitude of the fee set forth in § 1.17(r), the next PTO action following timely payment of the fee set forth in § 1.17(r) will be equivalent to a first action in a continuing application. Under existing PTO practice, it would not be proper to make final a first Office action in a continuing application where the continuing application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The identical procedure will apply to examination of a submission considered as a result of the procedure under § 1.129(a). Thus, under § 1.129(a), if the first submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Likewise, if the second submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. In view of 35 U.S.C. 132, no amendment considered as a result of the payment of the fee set forth in § 1.17(r) may introduce new matter into the disclosure of the application.

Section 1.129(b)(1) is being changed to identify the date which is two months prior to the effective date of 35 U.S.C. 154(a)(2) as April 8, 1995. Section 1.129(b)(1) is also being changed to clarify in subsection (ii) that the examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant.

Section 1.129(b)(2) is being changed to delete the identification of the period provided for applicants to respond to a notification under § 1.129(b) as one month. The time period for response will be identified in any written notification under § 1.129(b) and will usually be one month, but in no case will it be less than thirty days. The period may be extended under § 1.136(a). The language is also being changed to provide that applicant may respond to the notification by (i) electing the invention or inventions to be searched and examined, if no election has been made prior to the notice, and paying the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects, (ii) confirming an election made prior to the notice and paying the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or (iii) filing a petition under § 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required. The section is also being changed to provide that if the petition under § 1.129(b)(2) is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

Section 1.129(c) is being changed to clarify that the provisions of §§ 1.129 (a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995 would be subject to a 20-year patent term.

Section 1.137 is being amended by revising paragraph (c) to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.137(a) not filed within six (6) months of the date of the abandonment of the application. The language "filed before June 8, 1995" and "filed on or after June 8, 1995" as used in the amended rule, refer to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121, or 365. No change to § 1.137 was proposed in the Notice of Proposed Rulemaking. However, in all applications filed on or after June 8, 1995, except design applications, any delay in filing a petition under § 1.137(a) will automatically result in the loss of patent term. The loss of patent term will be the incentive for applicants to promptly file any petition to revive. Therefore, no need is seen for requiring a terminal disclaimer in such applications. It would amount to a penalty if a terminal disclaimer was required.

Section 1.136 is being amended by revising paragraph (d) to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.316(b) not filed within six (6) months of the date of the abandonment of the application. Acceptance of a late payment of an issue fee in a design application is specifically provided for in § 1.155. Therefore, § 1.316 does not apply to design applications. The language "filed before June 8, 1995" as used in the amended rule, refers to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121, or 365. No change to § 1.316 was proposed in the Notice of Proposed Rulemaking. However, in all applications filed on or after June 8, 1995, except design applications, any delay in filing a petition under § 1.316(b) will automatically result in the loss of patent term. The loss of patent term will be the incentive for applicants to promptly file any petition under § 1.316(b). Therefore, no need is seen for requiring a terminal disclaimer in such applications. It would amount to a penalty if a terminal disclaimer was required.

Section 1.317 is being amended by removing and reserving paragraph (d) to eliminate the requirement that a terminal disclaimer accompany any petition under § 1.317(b) not filed within six (6) months of the date of lapse of the patent. No change to § 1.317 was proposed in the Notice of Proposed Rulemaking. However, the delay in filing a petition under § 1.317(b) does not result in any gain of patent term. Therefore, no reason is seen for requiring a terminal disclaimer in such cases.

Section 1.701(a) is being changed to identify the implementation date as June 8, 1995, and to clarify that a proceeding under 35 U.S.C. 135(a) is an interference proceeding. [*20200]

Section 1.701(b) is being changed to provide that the term of a patent entitled to an extension under § 1.701 shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of § 1.701 and the extension will run from the expiration date of the patent. The reference to a terminal disclaimer is being deleted to be consistent with § 1.701(a)(3) and to avoid any confusion.

Section 1.701(c)(1)(i) is being changed for clarity by deleting the phrase "if any" after the first occurrence of "interference" and by inserting the same phrase after the phrase "the number of days."

Section 1.701(c)(1)(ii) is being changed to clarify that the period referred to ends on the "date of the termination of the suspension" rather than on the date of the next PTO communication reopening prosecution.

Section 1.701(d)(1) is being amended to clarify that the "time" referred to is time "during the period of appellate review".

Section 1.701(d)(2) is being amended to clarify that the Commissioner, under the broad discretion granted by 35 U.S.C. 154(b)(3)(C), has decided to limit consideration of applicant's due diligence only to acts occurring during the period of appellate review. The supplementary information published in the Notice of Proposed Rulemaking contained examples of what might be considered a lack of due diligence for purposes of § 1.701(d)(2) as proposed. Specifically, the supplementary information identified requests for extensions of time to respond to Office communications, submission of a response which is not fully responsive to an Office communication, and filing of informal applications as examples. In view of the comments received and the language adopted in the final rules, those examples are withdrawn. Acts which the Commissioner considers to constitute *prima facie* evidence of lack of due diligence under § 1.701(d)(2) are suspensions at applicant's request under § 1.103(a) during the period of appellate review and abandonments during the period of appellate review.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Parts 1 and 3, are being amended as indicated below:

Section 1.1 is being amended to add a paragraph (i) to provide a special "Box Provisional Patent Application" address to assist the Mail Room in separating and processing provisional applications and mail relating thereto.

Section 1.9 is being amended to redesignate paragraph (a) as paragraph (a)(1) and to define a national application as a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371. A new paragraph (a)(2) is being added to define the term "provisional application" as a U.S. national application filed under 35 U.S.C. 111(b). Also, a new paragraph (a)(3) is being added to define the term "nonprovisional application" as a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

Sections 1.12 and 1.14 are being amended to replace the references to § 1.17(i)(1) with references to § 1.17(i).

Sections 1.16(a)-(e) and (g) are being amended to clarify that those sections do not apply to provisional applications. A complete provisional application does not require claims. However, provisional applications may be filed with one or more claims as part of the application. Nevertheless, no additional claim fee or multiple dependent claim fee will be required in a provisional application. Section 1.16(f) is being amended to insert the words "basic fee". Section 1.16(e) refers to "the basic filing fee". Current Office practice allows a design application to be filed without the design filing fee or the oath/declaration as set forth in § 1.53(d)(1). The change to § 1.16(f) is merely for clarification. In addition, § 1.16(a) is being amended to replace the word "cases" with the word "applications", since the word "applications" is used elsewhere in the rule.

Section 1.16 is also being amended to add a new paragraph (k) which lists the basic filing fee for a provisional application as \$ 75.00 for a small entity (see §§ 1.9(c)-(f)) or \$ 150.00 for other than a small entity as contained in Public Law 103-465. Since the filing fee for a provisional application is established by Public Law 103-465 as a 35 U.S.C. 41(a) fee, the filing fee for a provisional application will be subject to the fifty (50) percent reduction provided for in 35 U.S.C. 41(h).

Further, § 1.16 is being amended to add a new paragraph (l) which establishes the surcharge required by new § 1.53(d)(2) for filing the basic filing fee or the cover sheet required by new § 1.51(a)(2) for a provisional application at a time later than the provisional application filing date as \$ 25.00 for a small entity or \$ 50.00 for other than a small entity.

Section 1.17(h) is being amended to clarify that the \$ 130.00 petition fee for filing a petition for correction of inventorship under § 1.48 applies to all patent applications, except provisional applications. Paragraph (i)(1) is being redesignated as paragraph (i) and paragraph (i)(2) is being removed. The fee for a petition under § 1.102 to make an application special has been placed in paragraph (i). The words "of this part", in § 1.17, paragraphs (h) and (i), are being deleted, since the paragraphs currently refer to sections in parts other than Part 1. Section 1.17(i) is also being amended to clarify that the fee set forth in paragraph (i) for filing a petition to accord a filing date under § 1.53 applies to all patent applications, except provisional applications.

A new § 1.17(q) is being added to establish a petition fee of \$ 50.00 for filing a petition for correction of inventorship under § 1.48 in a provisional application and for filing a petition to accord a provisional application a filing date or to convert an application filed under § 1.53(b)(1) to a provisional application. The petition fee set forth in § 1.17(q) is not reduced for a small entity.

New §§ 1.17 (r) and (s) are being added to establish the fees for entry of a submission after final rejection under § 1.129(a) and for each additional invention requested to be examined under § 1.129(b), respectively. These fees have been set at \$ 365.00 for a small entity and \$ 730.00 for other than a small entity.

Section 1.21(l) is being amended to refer to § 1.53(d)(1).

Section 1.28(a) is being amended to clarify the procedure for establishing status as a small entity in a nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application. In such cases, applicants may file a new verified statement or rely on a verified statement filed in the prior application, if status as a small entity is still proper and desired. If applicants intend to rely on a verified statement filed in the prior application, applicants must include in the nonprovisional application either a reference to the verified statement filed in the prior application or a copy of the verified statement filed in the prior application. Status as a small entity may be established in a provisional application by complying with existing § 1.27.

Section 1.45(c) is being amended to clarify that the first sentence applies to a "nonprovisional" application. Section 1.45 (c) is also being amended to add a second sentence relating to joint inventors named in a provisional [*20201] application. The second sentence states that each inventor named in a provisional application must have made a contribution to the subject matter disclosed in the provisional application. All that § 1.45(c), second sentence, requires is that if a person is named as an inventor in a provisional application, that person must have made a contribution to the subject matter disclosed in the provisional application.

Sections 1.48 (a)-(c) are being amended to specify that the procedures for correcting an error in inventorship set forth in those sections apply to nonprovisional applications. New paragraph (d) is being added to establish a procedure for adding the name of an inventor in a provisional application, where the name was originally omitted without deceptive intent. Paragraph (d) does not require the verified statement of facts by the original inventor or inventors, the oath

or declaration by each actual inventor in compliance with § 1.63 or the consent of any assignee as required in paragraph (a). Instead, the procedure requires the filing of a petition identifying the name or names of the inventors to be added and including a statement that the name or names of the inventors were omitted through error without deceptive intention on the part of the actual inventor(s). The statement would be required to be verified if made by a person not registered to practice before the PTO. The statement could be signed by a registered practitioner of record in the application or acting in a representative capacity under § 1.34(a). The \$ 50.00 petition fee set forth in § 1.17(q) would also be required. New paragraph (e) is also being added setting forth the procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application. The procedure requires an amendment deleting the name of the person who was erroneously named accompanied by: a petition including a statement of facts verified by the person whose name is being deleted establishing that the error occurred without deceptive intention; the fee set forth in § 1.17(q); and the written consent of any assignee.

Section 1.51 is being amended to redesignate § 1.51(a) as § 1.51(a)(1) and to include a new paragraph (a)(2) identifying the required parts of a complete provisional application. As set forth in § 1.51(a)(2), a complete provisional application includes a cover sheet, a specification as prescribed in 35 U.S.C. 112, first paragraph, any necessary drawings and the provisional application filing fee. A suggested cover sheet format for a provisional application is included as an Appendix A to this Notice of Final Rulemaking and is available from the PTO free of charge to the public. However, the rule does *not* require the applicant to use the PTO suggested cover sheet. Any paper containing the information required in § 1.51(a)(2)(i) will be acceptable. The cover sheet is required to identify the paper as a provisional application and to provide the information which is necessary for the PTO to prepare the provisional application filing receipt. Also, the residence of each named inventor and, if the invention disclosed in the provisional application was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government, the name of the U.S. Government agency and Government contract number must be identified on the cover sheet.

Section 1.51(b) is being amended to indicate that an information disclosure statement is not required and may not be filed in a provisional application. Any information disclosure statements filed in a provisional application will either be returned or disposed of at the convenience of the Office. An information disclosure statement filed in a § 1.53(b)(1) application which has been converted to a provisional application will be retained in the application after the conversion, if the information disclosure statement was filed before the petition required by § 1.53(b)(2)(ii) was filed.

The title of § 1.53 and paragraph (a) are being amended to refer to application number, rather than application serial number. The term "application number" is found in current § 1.53(a).

Section 1.53(b) is being redesignated as § 1.53(b)(1) and is being amended to refer to § 1.17(i) rather than § 1.17(i)(1) to conform to the change therein.

A new § 1.53(b)(2) is being added to set forth the requirements for obtaining a filing date for a provisional application. Section 1.53(b)(2) states that a filing date will be accorded to a provisional application as of the date the specification as prescribed by 35 U.S.C. 112, first paragraph, any necessary drawings, and the name of each inventor of the subject matter disclosed are filed in the PTO. The filing date requirements for a provisional application set forth in new paragraph (b)(2) parallel the existing requirements set forth in former paragraph (b), now redesignated paragraph (b)(1), except that no claim is required. In order to minimize the cost of processing provisional applications and to reduce the handling of provisional applications, amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

Section 1.53(b)(2)(i) is being added requiring all provisional applications to be filed with a cover sheet identifying the application as a provisional application. The section also indicates that the PTO will treat an application as having been filed under § 1.53(b)(1), unless the application is identified as a provisional application on filing. A provisional application, which is identified as such on filing, but which does not include all of the information required by § 1.51(a)(2)(i) would still be treated as a provisional application. However, the omitted information and a surcharge would be required to be submitted at a later date under new § 1.53(d)(2).

Section 1.53(b)(2)(ii) is being added to establish a procedure for converting an application filed under § 1.53(b)(1) to a provisional application. The section requires that a petition requesting the conversion and a petition fee be filed in the § 1.53(b)(1) application prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of twelve (12) months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. The grant of any such petition would not entitle applicant to a refund of the fees properly paid in the application filed under § 1.53(b)(1).

Section 1.53(b)(2)(iii) is being added to call attention to the provisions of Public Law 103-465 which prohibit any provisional application from claiming a right of priority under 35 U.S.C. 120, 121 or 365(c) of any other application. The section also calls attention to the provisions of Public Law 103-465 which provide that no claim for benefit of an earlier filing date may be made in a design application based on a provisional application and that no request for a statutory invention registration may be filed in a provisional application. Section 1.53(b)(2)(iii) further specifies that the requirements of §§ 1.821-1.825 are not mandatory for provisional applications. However, applicants are reminded that an invention being claimed in an application filed under 35 U.S.C. 111(a) or 365 which claims benefit under 35 U.S.C. 119(e) of a provisional application must be disclosed in the provisional application in the manner provided by the first paragraph of 35 U.S.C. 112. Voluntary compliance with the requirements of §§ 1.821-1.825 in [*20202] the provisional application is recommended, in order to ensure that support for the invention claimed in the 35 U.S.C. 111(a) application can be readily ascertained in the provisional application.

Section 1.53(c) is being amended to require that any request for review of a refusal to accord an application a filing date be made by way of a petition accompanied by the fee set forth in § 1.17(i), if the application was filed under § 1.53(b)(1), or by the fee set forth in § 1.17(q), if the application was filed under § 1.53(b)(2). This reflects the current practice set forth in the Manual of Patent Examining Procedure (MPEP), section 506.02 (Sixth Edition, Jan. 1995) with regard to any request for review of a refusal to accord a filing date for an application. The PTO will continue its current practice of refunding the petition fee, if the refusal to accord the requested filing date is found to have been a PTO error.

Section 1.53(d) is being redesignated as § 1.53(d)(1).

Section 1.53(d)(2) is being added to provide that a provisional application may be filed without the basic filing fee and without the complete cover sheet required by § 1.51(a)(2). In such a case, the applicant will be notified and given a period of time in which to file the missing fee, and/or cover sheet and to pay the surcharge set forth in § 1.16(l).

Section 1.53(e) is being redesignated as § 1.53(e)(1) and amended to refer to § 1.53(b)(1). Also, a new § 1.53(e)(2) is being added to indicate that a provisional application will not be given a substantive examination and will be abandoned no later than twelve (12) months after its filing date.

Sections 1.55(a) and (b) are being amended to clarify that the sections apply to nonprovisional applications and to clarify that a nonprovisional application may claim the benefit of one or more prior foreign applications or one or more applications for inventor's certificate. Also, § 1.55(a) is being amended to replace the reference to 35 U.S.C. 119 with a reference to 35 U.S.C. 119(a)-(d). In addition, the reference to § 1.17(i)(1) in § 1.55(a) is being replaced by a reference to § 1.17(i) to be consistent with the change to § 1.17. Section 1.55(b) is also being amended to refer to 35 U.S.C. 119(d) to conform to the paragraph designations contained in Public Law 103-465.

Section 1.59 is being amended to clarify that the retention fee practice set forth in § 1.53(d)(1) applies only to applications filed under § 1.53(b)(1).

Section 1.60 is being amended to clarify in the title of the section and in paragraph (b)(1) that the procedure set forth in the section is only available for filing a continuation or divisional application if the prior application was a nonprovisional application and complete as set forth in § 1.51(a)(1). Paragraph (b)(4) is being amended to delete the requirement that the statement which must accompany the copy of the prior application include the language that "no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein." The requirement is unnecessary because any amendment filed to complete the prior application would be considered a part of the original disclosure of the prior application and, by definition, could not contain new matter. Also, paragraph (b)(4) is being amended to refer to § 1.17(i).

Section 1.62(a) is being amended to clarify that the procedure set forth in the section is only available for filing a continuation, continuation-in-part, or divisional application of a prior nonprovisional application which is complete as defined in § 1.51(a)(1). Section 1.62(a) is also being amended to clarify that a continuing application may be filed under § 1.62 after payment of the issue fee if a petition under § 1.313(b)(5) is granted in the prior application and that the request for a § 1.62 application must include identification of the inventors named in the prior application. The phrase "Serial number, filing date" in § 1.62(a) is being changed to "application number."

Section 1.62(e) is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17. Also, the term "application serial number" in § 1.62(e) is being changed to "application number."

Section 1.63(a) is being amended to replace the reference to § 1.51(a)(2) with a reference to § 1.51(a)(1)(ii) in order to conform with the changes in § 1.51 and to refer to an oath or declaration filed as a part of a nonprovisional application.

Section 1.67(b) is being amended to replace the reference to § 1.53(d) with a reference to § 1.53(d)(1) in order to conform with the changes in § 1.53. Furthermore, the references to §§ 1.53(b) and 1.118 are being deleted to make clear that the new matter exclusion applies to all applications including those filed under §§ 1.60 and 1.62. Also, the section is being amended to refer to a nonprovisional application.

Sections 1.78 (a)(1) and (a)(2) are being amended to clarify that the sections apply to nonprovisional applications claiming the benefit of one or more copending nonprovisional applications or international applications designating the United States of America. Section 1.78(a)(1)(iii) is being amended to refer to §§ 1.53(b)(1) and 1.53(d)(1). Section 1.78(a)(2) is also being amended to eliminate the use of serial number and filing date as an identifier for a prior application. The section will require that the prior application be identified by application number (consisting of the series code and serial number) or international application number and international filing date.

Sections 1.78 (a)(3) and (a)(4) are being added to set forth the conditions under which a nonprovisional application may claim the benefit of one or more prior copending provisional applications. The later filed nonprovisional application must be an application other than for a design patent and must be copending with each provisional application. There must be a common inventor named in the prior provisional application and the later filed nonprovisional application. Each prior provisional application must be complete as set forth in § 1.51(a)(2), or entitled to a filing date as set forth in § 1.53(b)(2) and include the basic filing fee. Section 1.78(a)(3) also includes the warning that when the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional application must be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. A provisional application may be abandoned by operation of 35 U.S.C. 111(b)(5) on a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case, a nonprovisional application claiming benefit of the provisional application under 35 U.S.C. 119(e) must be filed no later than the preceding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 1.78(a)(4) is also being added to provide that a nonprovisional application claiming benefit of one or more provisional applications must contain a reference to each provisional application, identifying it as a provisional application and including the provisional application number (consisting of series code and serial number). The section does not require the nonprovisional application to identify the nonprovisional application as a continuation, divisional or continuation-in-part application of the provisional application. [*20203]

Sections 1.83 (a) and (c) are being amended to clarify that the sections apply to nonprovisional applications.

Section 1.97(d) is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.101(a) is being amended to indicate that the section applies to nonprovisional applications.

Section 1.102(d) is being amended to replace the reference to § 1.17(i)(2) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.103(a) is amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.129 is being added to set forth the procedure for implementing certain transitional provisions contained in Public Law 103-465. Section 1.129(a) provides for limited reexamination of applications pending for 2 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). An applicant will be entitled to have a first submission entered and considered on the merits after final rejection if the submission and the fee set forth in § 1.17(r) are filed prior to the filing of an Appeal Brief and prior to abandonment of the application. Section 1.129(a) also provides that the finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). After submission and payment of the fee set forth in § 1.17(r), the next PTO action on the merits may be made final only under the conditions currently followed by the PTO for making a first action in a continuing application final. If a subsequent final rejection is made in the application, applicant would be entitled to have a second submission entered and considered on the merits under the same conditions set forth for consideration of the first submission. Section 1.129(a) defines the term "submission" as including, but not limited to, an information disclosure statement, an amendment to the written description, claims or drawings,

and a new substantive argument or new evidence in support of patentability. For example, the submission may include an amendment, a new substantive argument and an information disclosure statement. In view of the fee set forth in § 1.17(r), any information disclosure statement previously refused consideration in the application because of applicant's failure to comply with § 1.97 (c) or (d) or which is filed as part of either the first or second submission will be treated as though it had been filed within one of the time periods set forth in § 1.97(b) and will be considered without the petition and petition fee required in § 1.97(d), if it complies with the requirements of § 1.98. In view of 35 U.S.C. 132, no amendment considered as a result of the payment of the fee set forth in § 1.17(r) may introduce new matter into the disclosure of the application.

Section 1.129(b)(1) is being added to provide for examination of more than one independent and distinct invention in certain applications pending for 3 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). Under § 1.129(b)(1), a requirement for restriction or for the filing of divisional applications would only be made or maintained in the application after June 8, 1995, if: (1) The requirement was made in the application or in an earlier application relied on under 35 U.S.C. 120, 121 or 365(c) prior to April 8, 1995; (2) the examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or (3) the required fee for examination of each additional invention was not paid. Under § 1.129(b)(2), if the application contains claims to more than one independent and distinct invention, and no requirement for restriction or for the filing of divisional applications can be made or maintained, applicant will be notified and given a time period to (i) elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects, (ii) in situations where an election was made in response to a requirement for restriction that cannot be maintained, confirm the election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or (iii) file a petition under § 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required. Section 1.129(b)(2) also provides that if the petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects. Under § 1.129(b)(3), each additional invention for which the required fee set forth in § 1.17(s) has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

Section 1.129(c) is being added to clarify that the provisions of §§ 1.129 (a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995, would be subject to a 20-year patent term.

Section 1.137 is being amended by revising paragraph (c) to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.137(a) not filed within six (6) months of the date of the abandonment of the application. The language "filed before June 8, 1995" and "filed on or after June 8, 1995" as used in the amended rule, refer to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121 or 365.

Section 1.139 is being added to set forth the procedure for reviving a provisional application where the delay was unavoidable or unintentional. Section 1.139(a) addresses the revival of a provisional application where the delay was unavoidable and § 1.139(b) addresses the revival of a provisional application where the delay was unintentional. Applicant may petition to have an abandoned provisional application revived as a pending provisional application for a period of no longer than twelve months from the filing date of the provisional application where the delay was unavoidable or unintentional. It would be permissible to file a petition for revival later than twelve months from the filing date of the provisional application but only to revive the application for the twelve-month period following the filing of the provisional application. Thus, even if the petition were granted to reestablish the pendency up to the end of the twelve-month period, the provisional application would not be considered pending after twelve months from its filing date. The requirements for reviving an abandoned provisional application set forth in § 1.139 parallel the existing requirements set forth in § 1.137. [*20204]

Sections 1.177, 1.312(b), 1.313(a), and 1.314 are being amended to replace the references to § 1.17(i)(1) with references to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.316(d) is being amended to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.316(b) not filed within six (6) months of the date of the abandonment of the application. Acceptance of a late payment of an issue fee in a design application is specifically provided for in § 1.155. Therefore, § 1.316 does not apply to design applications. The language "filed before June 8, 1955" as used in the amended rule, refers to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121 or 365.

Section 1.317(d) is being removed and reserved to eliminate the requirement that a terminal disclaimer accompany any petition under § 1.317(b) not filed within six (6) months of the date of lapse of the patent.

Section 1.666 is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.701 is being added to set forth the procedure the PTO will follow in calculating the length of any extension of patent term to which an applicant is entitled under 35 U.S.C. 154(b) where the issuance of a patent on an application, other than for designs, filed on or after June 8, 1995, was delayed due to certain causes of prosecution delay. Applicants need not file a request for the extension of patent term under § 1.701. The extension of patent term is automatic by operation of law. It is currently anticipated that applicant will be advised as to the length of any patent term extension at the time of receiving the Notice of Allowance and Issue Fee Due. Review of the length of a patent term extension calculated by the PTO under § 1.701 prior to the issuance of the patent would be by way of petition under § 1.181. If an error is noted after the patent issues, patentee and any third party may seek correction of the period of patent term granted by filing a request for Certificate of Correction pursuant to § 1.322. The PTO intends to identify the length of any patent term extension calculated under § 1.701 on the printed patent.

Section 1.701(a) is being added to identify those patents which are entitled to an extension of patent term under 35 U.S.C. 154(b).

Section 1.701(b) is being added to provide that the term of a patent entitled to extension under § 1.701(a) shall be extended for the sum of the periods of delay calculated under §§ 1.701 (c)(1), (c)(2), (c)(3) and (d), to the extent that those periods are not overlapping, up to a maximum of five years. The section also provides that the extension will run from the expiration date of the patent.

Section 1.701(c)(1) is being added to set forth the method for calculating the period of delay where the delay was a result of an interference proceeding under 35 U.S.C. 135(a). The period of delay with respect to each interference in which the application was involved is calculated under § 1.701(c)(1)(i) to include the number of days in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application. An interference is considered terminated as of the date the time for filing an appeal under 35 U.S.C. 141 or civil action under 35 U.S.C. 146 expired. If an appeal under 35 U.S.C. 141 is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the PTO. If a civil action is filed under 35 U.S.C. 146, and the decision of the district court is not appealed, the interference terminates on the date the time for filing an appeal from the court's decision expires. See section 2361 of the MPEP. The period of delay with respect to an application suspended by the PTO due to interference proceedings under 35 U.S.C. 135(a) not involving the application is calculated under § 1.701(c)(1)(ii) to include the number of days in the period beginning on the date prosecution in the application is suspended due to interference proceedings not involving the application and ending on the date of the termination of the suspension. The period of delay under § 1.701(a)(1) is the sum of the periods calculated under §§ 1.701 (c)(1)(i) and (c)(1)(ii), to the extent that the periods are not overlapping.

Section 1.701(c)(2) is being added to set forth the method for calculating the period of delay where the delay was a result of the application being placed under a secrecy order.

Section 1.701(c)(3) is being added to set forth the method for calculating the period of delay where the delay was a result of appellate review. The period of delay is calculated under § 1.701(c)(3) to include the number of days in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

Section 1.701(d) is being added to set forth the method for calculating any reduction in the period calculated under § 1.701(c)(3). As required by 35 U.S.C. 154(b)(3)(B), § 1.701(d)(1) provides that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review that occurred before three years from the

filing date of the first national application for patent presented for examination. The "filing date" for the purpose of § 1.701(d)(1) would be the earliest effective U.S. filing date, but not including the filing date of a provisional application or the international filing date of a PCT application. For PCT applications entering the national stage, the PTO will consider the "filing date" for the purpose of § 1.701(d)(1) to be the date on which applicant has complied with the requirements of § 1.494(b), or § 1.495(b), if applicable.

As contained in Public Law 103-465, 35 U.S.C. 154(b)(3)(C) states that the period of extension referred to in 35 U.S.C. 154(b)(2) "shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner." Section 1.701(d)(2) is being added to provide that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. Section 1.701(d)(2) also provide that in determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review. Acts which the Commissioner considers to constitute *prima facie* evidence of lack of due diligence under § 1.701(d)(2) are suspension at applicant's request under § 1.103(a) during the period of appellate review and abandonment during the period of appellate review.

Section 3.21 is being amended to provide that an assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, [*20205] e.g., 07/123,456) and to eliminate the use of serial number and filing date as an identifier for national patent applications in assignment documents. This change is intended to eliminate any confusion as to whether an application identified by its serial number and filing date in an assignment document is an application filed under § 1.53(b)(1), 1.60 or 1.62 or a design application or a provisional application since there is a different series code assigned to each of these types of applications.

Section 3.21 is also being amended to provide that if an assignment of a patent application filed under § 1.53(b)(1) or § 1.62 is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended.

Further, § 3.21 is being amended to provide that if an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

Section 3.81 is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Responses to and Analysis of Comments: Forty-nine written comments were received in response to the Notice of Proposed Rulemaking. These comments, along with those made at the public hearing, have been analyzed. Some suggestions made in the comments have been adopted and others have not been adopted. Responses to the comments follow.

General Comments

1. *Comment:* One comment questioned the use of the word "proposed" in the notice of proposed rulemaking in describing the statutory amendments contained in Public Law 103-465.

Response: The statutory changes contained in Public Law 103-465 were described as "proposed" changes in the Notice of Proposed Rulemaking because the President had not signed the legislation at the time the notice was prepared for publication. In fact, the legislation was signed by the President on December 8, 1994, which is the date of enactment.

2. *Comment:* Several comments urged the PTO to favorably consider the 17/20 patent term specified in H.R. 359 since this proposed legislation would overcome the existing impact of extended PTO prosecution and eliminate patent term extensions for prosecution delays. Furthermore, the proposed legislation is consistent with the Uruguay Round Agreements Act, Public Law 103-465.

Response: The administration and the PTO strongly believe that the 20-year patent term as enacted in Public Law 103-465 is the appropriate way to implement the 20-year patent term required by the GATT Uruguay Round Agreements Act. The PTO will take steps to ensure that processing and examination of applications are handled expeditiously.

3. *Comment:* One comment stated that the proposed rules are premature in view of the Rohrabacher bill, H.R. 359.

Response: The proposed rules are not premature. Public Law 103-465 was signed into law on December 8, 1994, with an effective date of June 8, 1995, for the implementation of the 20-year patent term and provisional applications. The Commissioner must promulgate regulations to implement the changes required by Public Law 103-465.

4. *Comment:* One comment stated that there is nothing in the TRIPs agreement that requires the term to be measured from filing, nor that provisional applications be provided for, nor that new fees of \$ 730 as set forth in §§ 1.17 (r) and (s) be established. It is suggested that 35 U.S.C. 154 be amended to provide that "every patent (other than a design patent) shall be granted a term of twenty years from the patent issue date, subject to the payment of maintenance fees." It was also suggested that the section regarding maintenance fees be amended to add a new fee payable at 16.5 years of \$ 5000 (for large entity)/\$ 2500 (for small entity) for maintenance of patent between 17 and 20 years.

Response: The suggestion has not been adopted. The administration and the PTO strongly believe that the 20-year patent term as enacted in Public Law 103-465 is the appropriate way to implement the 20-year patent term required by the GATT Uruguay Round Agreements Act. The establishment of a provisional application is not required by GATT. The provisional application has been adopted as a mechanism to provide easy and inexpensive entry into the patent system. The filing of provisional applications is optional. Provisional applications will place domestic applicants on an equal footing with foreign applicants as far as the measurement of term is concerned because the domestic priority period, like the foreign priority period, is not counted in determining the endpoint of the patent term. As to the §§ 1.17 (r) and (s) fees, the statute authorizes the Commissioner to establish appropriate fees for further limited reexamination of applications and for examination of more than one independent and distinct inventions in an application.

5. *Comment:* One comment suggested that the 20-year patent term of claims drawn to new matter in continuation-in-part (CIP) applications be measured from the filing date of the CIP application, irrespective of any reference to a parent application under 35 U.S.C. 120.

Response: The suggestion has not been adopted. The term of a patent is not based on a claim-by-claim approach. Under 35 U.S.C. 154(a)(2), if an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(a), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(a). For a CIP application, applicant should review whether any claim in the patent that will issue is supported in an earlier application. If not, applicant should consider canceling the reference to the earlier filed application.

6. *Comment:* One comment objected to the 20-year term provisions of Public Law 103-465 because it was believed that payment of maintenance fees would be required earlier under 20-year term than under 17-year term.

Response: The payment of maintenance fees are not due earlier under 20-year term than under 17-year term. Maintenance fees continue to be due at 3.5, 7.5 and 11.5 years from the issue date of the patent.

7. *Comment:* Several comments suggested that the expiration date be printed on the face of the patent.

Response: The suggestion has not been adopted. The expiration date will not be printed on the face of the patent. The PTO will publish any patent term extension that is granted as a result of administrative delay pursuant to § 1.701 on the face of the patent. The term of a patent will be readily discernible from the face of the patent. Furthermore, it is noted that the term of a patent is dependent on the timely payment of maintenance fees which is not printed on the face of the patent.

8. *Comment:* One comment suggested that in order to aid the bar in advising clients as to whether a provisional application has had its priority claimed in a patent, the PTO should somehow link the provisional application number [*20206] with the complete application number and/or the patent number.

Response: It is contemplated by the PTO that all provisional applications will be given application numbers, starting with a series code "60" followed by a six digit number, e.g., "60/123,456." If a subsequent 35 U.S.C. 111(a) application claims the benefit of the filing date of the provisional application pursuant to 35 U.S.C. 119(e) and the 35 U.S.C. 111(a) application results in a patent, the provisional application would be listed by its application number and filing

date on the face of the patent under the heading "Related U.S. Application Data." The public will be able to identify an application under the above-noted heading as a provisional application by checking to see if it has a series code of "60."

9. Comment: Several comments suggested that the PTO consider modifying the rules to permit the filing of all applications by assignees. This would promote harmonization with other patent laws throughout the world and would eliminate one of the difficulties which will occur for the PTO in considering claims for priority based on the filing of a provisional application.

Response: Assignee filing was recommended in the 1992 Advisory Commission Report on Patent Law Reform. The PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken under advisement in that project.

10. Comment: Several comments stated that a complete provisional application should not be forwarded to a central repository for storage.

Response: In view of the relatively small filing fee for a provisional application and the fact that the provisional application will not be examined, PTO handling must be kept to a minimum and these provisional applications, once complete, will be sent to the Files Repository for storage rather than being kept in the examination area of the PTO.

11. Comment: One comment suggested that the provisional application be maintained with the 35 U.S.C. 111(a) application because the examiner may need it to determine whether the 35 U.S.C. 111(a) application is entitled to the benefit of the prior provisional application and in the event of 18-month publication, there will be a demand for accessibility by the public to the provisional and 35 U.S.C. 111(a) applications upon publication.

Response: The suggestion has not been adopted. Benefit of the same provisional application may be claimed in a number of 35 U.S.C. 111(a) applications. If the PTO is to maintain the provisional application file with one of several 35 U.S.C. 111(a) applications claiming benefit of the provisional application and the 35 U.S.C. 111(a) application containing the provisional application file were to go abandoned while one of the other 35 U.S.C. 111(a) application issues, the public would be entitled to inspect the provisional application file but not the abandoned 35 U.S.C. 111(a) application file containing the provisional application file. This would create access problems.

12. Comment: One comment suggested that provisional applications be available in full to the public if the benefit of priority is being claimed.

Response: Section 1.14 relating to access applies to all applications including provisional applications. If the benefit of a provisional application is claimed in a later filed 35 U.S.C. 111(a) application which resulted in a patent, then access to the provisional application will be available to the public pursuant to § 1.14. The mere fact that a provisional application is claimed in a later filed 35 U.S.C. 111(a) application does not give the public access to the provisional application unless the 35 U.S.C. 111(a) application issues as a patent.

13. Comment: Several comments requested that the PTO clarify whether a 35 U.S.C. 111(a) application will be accorded an effective date as a reference under 35 U.S.C. 102(e) as of the filing date of the provisional application for which benefit under 35 U.S.C. 119(e) is claimed. If so, the comment questioned whether pending applications will be rejected under 35 U.S.C. 102(e) on the basis that an invention was described in a patent granted on a provisional application by another filed in the U.S. before the invention thereof by the applicant for patent.

Response: If a patent is granted on a 35 U.S.C. 111(a) application claiming the benefit of the filing date of a provisional application, the filing date of the provisional application will be the 35 U.S.C. 102(e) prior art date. A pending application will be rejected under 35 U.S.C. 102(e) on the basis that an invention was described in a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application by another filed in the U.S. before the invention thereof by the applicant for patent.

14. Comment: One comment suggested that the PTO issue a final rule stating that if a 35 U.S.C. 111(a) application claims the benefit of the filing date of a provisional application, the "inventive entity" for the purposes of 35 U.S.C. 102(e) will be the inventors listed on the issued patent, and the list of inventors in the provisional application shall have no effect on the identity of an "inventive entity" for the purposes of 35 U.S.C. 102(e).

Response: The suggestion has not been adopted. The "inventive entity" for the purpose of 35 U.S.C. 102(e) is determined by the patent and not by the inventors named in the provisional application. As long as the requirements of 35 U.S.C. 119(e) are satisfied, a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application has a 35 U.S.C. 102(e) prior art effect as of the filing date of the provisional application.

based on the inventive entity of the patent. It is clear from 35 U.S.C. 102(e) that the inventive entity is determined by the patent and a rule to this effect is not necessary.

15. Comment: One comment requested the PTO to express its position as to whether the filing of a provisional application with the subsequent filing of a 35 U.S.C. 111(a) application claiming benefit of the provisional application under 35 U.S.C. 119(e) creates a prior art date against other patent applicants under 35 U.S.C. 102(g).

Response: As to 35 U.S.C. 102(g), the filing of a provisional application with the subsequent filing of a 35 U.S.C. 111(a) application claiming benefit of the provisional application under 35 U.S.C. 119(e) creates a prior art date under 35 U.S.C. 102(g) as of the filing date of the provisional application.

16. Comment: One comment suggested that in view of the 20-year patent term measured from filing, § 1.103(a) should be deleted. The PTO should not have the right to suspend action on any application, thereby reducing applicant's term of protection.

Response: Section 1.103(a) refers to suspension of action as a result of a request by applicant. If applicant wishes to suspend prosecution and thereby reduce his/her term of protection, applicant should be permitted to do so.

17. Comment: One comment suggested that in order to avoid delays resulting from consideration of petitions to withdraw premature notices of abandonment, examiners should be required to contact an attorney of record prior to abandoning the application to find out if a response to an Office communication has been filed.

Response: The suggestion has not been adopted. However, in order to avoid loss of patent term, applicants are encouraged to check on the status in [*20207] cases where applicants have not received a return postcard from the PTO within two (2) weeks of the filing of any response to a PTO action.

18. Comment: One comment asked whether there is a "cut-off" date after which patentees may lose the opportunity to choose 17- vs. 20-year patent term.

Response: The "cut-off" date is June 8, 1995. A patent that is in force on June 8, 1995, or a patent that issues after June 8, 1995, on an application filed before June 8, 1995, is automatically entitled to the longer of the 20-year patent term measured from the earliest U.S. effective filing date or 17 years from grant. This is automatic by operation of law. Patentees need not make any election to be entitled to the longer term. A patent that issues on an application filed on or after June 8, 1995 is entitled to a 20-year patent term measured from the earliest U.S. effective filing date.

19. Comment: One comment stated that there is no clear guidance as to a patentee's "bonus rights" that may arise because of the difference in a 17-year term vs. a 20-year term. Will parties that were previously in a licensing arrangement have to renegotiate terms for the bonus patent term?

Response: Section 154(c) of title 35, United States Code, states that the remedies of sections 283 (injunction), 284 (damages) and 285 (attorney fees) shall not apply to acts which were commenced or for which substantial investment was made before June 8, 1995, and became infringing by reason of the 17/20 year term and that these acts may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under chapters 28 and 29 of Title 35. There is no guidance provided in the statute as to the meaning of "substantial investment" and "equitable remuneration." Licensing arrangements are between the parties to the agreement and are determined by the terms of the agreement and state law and are outside the jurisdiction of the PTO.

20. Comment: One comment questioned whether an international application designating the U.S. filed before June 8, 1995, with entry into the U.S. national stage on or after June 8, 1995, preserves the 17-year patent term measured from grant.

Response: An international application designating the U.S. that is filed before June 8, 1995, with entry into the U.S. national stage under 35 U.S.C. 371 on or after June 8, 1995, preserves the option for a 17-year patent term measured from date of grant.

21. Comment: One comment suggested that 35 U.S.C. 371(c) be amended because a declaration should not be required to obtain a filing date and a prior art date under 35 U.S.C. 102(e).

Response: The suggestion has not been adopted. This issue was not addressed in the Notice of Proposed Rulemaking. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to re-engineer the entire patent process.

22. *Comment:* One comment suggested that §§ 1.604, 1.605 and 1.607 be amended to state that provisional applications are not subject to interference.

Response: The suggestion has not been adopted because it is unnecessary. By statute, 35 U.S.C. 111(b)(8), provisional applications are not subject to 35 U.S.C. 135, i.e., a provisional application will not be placed in interference.

23. *Comment:* One comment suggested that §§ 1.821-1.825 be amended so that (1) only unbranched sequences of ten or more amino acids and twenty or more nucleotides which are claimed have to be included in Sequence Listings, (2) previously published sequences can be omitted, and (3) the sequences of primers and oligonucleotide probes should not be included in a Sequence Listing if encompassed by another disclosed sequence.

Response: The suggestion has not been adopted. There was no change proposed to §§ 1.821-1.825 in the Notice of Proposed Rulemaking. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process.

24. *Comment:* One comment suggested that §§ 5.11 to 5.15 be amended to provide for the grant of a foreign license for a provisional application.

Response: The suggestion has not been adopted. The present language of §§ 5.11 to 5.15 already provides for the grant of a foreign license for a provisional application.

25. *Comment:* One comment suggested that in order to assist defense agencies in reviewing application for secrecy orders, PTO should (1) automatically impose a secrecy order on any application filed under 35 U.S.C. 111(a) if a secrecy order was previously imposed on corresponding provisional application, and (2) require applications filed under 35 U.S.C. 111(a) based on a previous provisional application to indicate changes made to the provisional application in the 35 U.S.C. 111(a) application by means of underlining and bracketing.

Response: The suggestions have not been adopted. The PTO cannot automatically impose a secrecy order on any 35 U.S.C. 111(a) applications even if a secrecy order was previously imposed on a provisional application, for which benefit under 35 U.S.C. 119(e) is claimed, unless the agency which imposed the secrecy order on the provisional application specifically requests the PTO to do so since the 35 U.S.C. 111(a) application could disclose subject matter which is different from that which is disclosed in the provisional application.

As to item (2), the PTO will not require applicants to identify the differences in subject matter disclosed in the 35 U.S.C. 111(a) application and the provisional application.

26. *Comment:* One comment suggested that in order to relieve defense agencies from possible liability for secrecy orders imposed for more than 5 years, the PTO should seek legislation setting patent term at 20 years from the earliest filing date or 17 years from the issue date, whichever is longer, for any patent application placed under secrecy order.

Response: The suggestion has not been adopted. The PTO strongly believes that the 20-year patent term as enacted in Public Law 103-465 is the appropriate way to implement the 20-year patent term required by the GATT Uruguay Round Agreements Act. The 35-year limit for patent term extension set forth in § 1.701(b) is required by statute, 35 U.S.C. 154(b).

Comments Directed to Specific Rules

27. *Comment:* One comment suggested that in order to eliminate the need for the expression "other than a provisional application" in other parts of the regulations, § 1.9 should be amended to identify a 35 U.S.C. 111(a) application by some term that can be used in the rules to distinguish that type of application from a provisional application.

Response: The suggestion has been adopted. The rules are being amended to include a definition of the term "nonprovisional application" in § 1.9(a) to describe an application filed under 35 U.S.C. 111(a) or 371. Further, the term "nonprovisional application" is being used in the final rules where the rule applies only to applications filed under 35 U.S.C. 111(a) or 371 and not to provisional applications.

28. *Comment:* One comment suggested that the rules be simplified if [*20208] a "national application" could be defined in § 1.9 to exclude a provisional application.

Response: The suggestion has not been adopted. Section 1.9(a), prior to this rulemaking, defined a national application to include any application filed under 35 U.S.C. 111. A provisional application is an application filed under 35 U.S.C. 111. It is appropriate to define a provisional application as a special type of national application.

29. Comment: One comment requested an explanation of the showing required in a petition under §§ 1.12 and 1.14 for access to pending applications and to assignment records for pending applications.

Response: There was no substantive change proposed to either § 1.12 or 1.14 in the Notice of Proposed Rulemaking. Thus, the showing required in a petition under § 1.12 or 1.14 remains the same after this final rulemaking as before. A discussion of such a petition can be found in section 103 of the MPEP.

30. Comment: Several comments objected to the definition in § 1.45(c) of joint inventors in provisional applications as being those having made a contribution to "the subject matter disclosed" in the provisional application. Various language, such as, "the subject matter which constitutes the invention," "subject matter disclosed and regarded to be the invention," "disclosed invention," "the inventive subject matter disclosed" was suggested. Another comment requested guidance as to the determination of inventorship in a provisional application.

Response: The suggestion has not been adopted. The term "invention" is typically used to refer to subject matter which applicant is claiming in his/her application. Since claims are not required in a provisional application, it would not be appropriate to reference joint inventors as those who have made a contribution to the "invention" disclosed in the provisional application. If the "invention" has not been determined in the provisional application because no claims have been presented, then the name(s) of those person(s) who have made a contribution to the subject matter disclosed in the provisional application should be submitted. Section 1.45(c) states that "if multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application." All that § 1.45(c) requires is that if someone is named as an inventor, that person must have made a contribution to the subject matter disclosed in the provisional application. When applicant has determined what the invention is by the filing of the 35 U.S.C. 111(a) application, that is the time when the correct inventors must be named. The 35 U.S.C. 111(a) application must have an inventor in common with the provisional application in order for the 35 U.S.C. 111(a) application to be entitled to claim the benefit of the provisional application under 35 U.S.C. 119(e).

31. Comment: Several comments suggested that it might be desirable to correct inventorship in a provisional application where an individual was erroneously named as an inventor and that the procedure for doing so should be set forth in § 1.48.

Response: Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed application under 35 U.S.C. 111(a) may claim priority benefits based on a copending provisional application so long as the applications have at least one inventor in common. An error in naming a person as an inventor in a provisional application would not require correction by deleting the erroneously named inventor from the provisional application since this would have no effect upon the ability of the provisional application to serve as a basis for a priority claim under 35 U.S.C. 119(e). However, in response to the comments, § 1.48 is being amended to include a new paragraph (e) which sets forth the requirements for deleting the names of the inventors incorrectly named as joint inventors in a provisional application, namely, a petition including a verified statement by the inventor(s) whose name(s) are being deleted stating that the error arose without deceptive intent, the fee set forth in § 1.17(q) and the written consent of all assignees.

32. Comment: One comment suggested that in order to make the procedures for provisional applications as simple as possible, there is no need to provide any rules to add inventor(s) or change inventorship in a provisional application since the whole concept of inventorship is meaningless without a claim. Error in inventorship can be corrected by the filing of and 35 U.S.C. 111(a) application within 12 months after the filing of a provisional application.

Response: The suggestion has not been adopted. One of the requirements of 35 U.S.C. 119(e) is that a 35 U.S.C. 111(a) application must have at least one inventor in common with a provisional application in order for the 35 U.S.C. 111(a) application to be entitled to claim the benefit of the filing date of the provisional application. In situations where there is no inventor in common between the 35 U.S.C. 111(a) application and the provisional application due to error in naming the inventors in the provisional application, procedures must be established to permit applicant to correct the inventorship in the provisional application.

33. Comment: One comment suggested that an individual who is the inventor of subject matter disclosed in a provisional application, but who is not named as an inventor in the provisional application because that subject matter was not intended to be claimed in a later filed 35 U.S.C. 111(a) application, could be added as an inventor pursuant to § 1.48(d) in the provisional application if the subject matter was claimed in 35 U.S.C. 111(a) application.

Response: The individual could be added as an inventor pursuant to § 1.48(d) in the provisional application so long as the individual was originally omitted without deceptive intent.

34. Comment: One comment questioned whether it would be proper for a registered practitioner who did not file the provisional application to sign the statement required by § 1.48(d) that the error occurred without deceptive intention on the part of the inventors.

Response: It would be proper for a registered practitioner who did not file the provisional application to sign the statement required by § 1.48(d), if the registered practitioner has a reasonable basis to believe the truth of the statement being signed.

35. Comment: One comment suggested that there should be no diligence requirement to correct inventorship in a provisional application.

Response: Diligence is not a requirement to correct inventorship in a provisional application in either § 1.48(d) or 1.48(e).

36. Comment: One comment suggested that § 1.48(a) be amended by deleting the requirements for "a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred" and for the written consent of any assignee.

Response: The suggestion has not been adopted. There was no substantive change proposed to § 1.48(a) in the Notice of Proposed Rulemaking. Since the correction of inventorship affects ownership rights, the existing rules are designed to provide assurances that all parties including the original named inventors and all assignees agree to the change of inventorship. If the [*20209] requirements for verified statements of facts from the original named inventors and written consent of the assignees are to be deleted, the PTO would no longer have the assurances that all parties agree to the change.

37. Comment: One comment expressed concern that a provisional application filed without a claim will leave subsequent readers with little or no clue as to what the inventors in the provisional application considered to be their invention at the time the provisional application was filed and doubted that a provisional application filed without a claim defining the invention could ever provide a sufficient disclosure to support a claim for a foreign or U.S. priority date.

Response: Claims are not required by the statute to provide a specification in compliance with the requirements of 35 U.S.C. 112, first paragraph. However, if an applicant desires, one or more claims may be included in a provisional application. Any claim field with a provisional application will, of course, be considered part of the original provisional application disclosure.

38. Comment: One comment suggested that the PTO issue a specification format or guideline for a provisional application to enable an inventor to comply with 35 U.S.C. 112, first paragraph.

Response: The format of a provisional application is the same as for other applications and is set forth in existing § 1.77 which is applicable to provisional applications except no claims are required for provisional applications.

39. Comment: Several comments suggested that the PTO revise its rules to clarify that strict adherence to the enablement, description and best mode requirements of 35 U.S.C. 112, first paragraph, is not required in provisional applications.

Response: The suggestion has not been adopted. The substantive requirements of a specification necessary to comply with 35 U.S.C. 112, first paragraph, are established by court cases interpreting that section of the statute, not by rule. The case law applies to provisional applications as well as to applications filed under 35 U.S.C. 111(a).

40. Comment: Several comments suggested that the rules or comments published with the Final Rule indicate whether there is any requirement to update the best mode disclosed in the provisional application when filing the 35 U.S.C. 111(a) application.

Response: No rule was proposed to address the issue when going from a provisional application to a 35 U.S.C. 111(a) application because no current rule exists when going from one 35 U.S.C. 111(a) application to another 35 U.S.C. 111(a) application. The question of whether the best mode has to be updated is the same when going from one 35 U.S.C. 111(a) application to another 35 U.S.C. 111(a) application or from a provisional application to a 35 U.S.C. 111(a) application. Accordingly, the rationale of *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994), would appear to be applicable. Clearly, if the substantive content of the application does not change when filing the 35 U.S.C. 111(a) application, there is no requirement to update the best mode.

However, if subject matter is added to the 35 U.S.C. 111(a) application, there may be a requirement to update the best mode.

41. *Comment:* One comment suggested that § 1.51(c) be amended to permit a provisional application to be filed with an authorization to charge fees to a deposit account.

Response: Section 1.51(c) permits an application to be filed with an authorization to charge fees to a deposit account. Section 1.51(c) applies to provisional applications. Therefore, no change to § 1.51(c) is necessary.

42. *Comment:* One comment suggested that the PTO confirm that there will be no procedural examination of a provisional application other than to determine whether the provisional application complies with § 1.51(a)(2).

Response: The PTO intends to require compliance with the formal requirements of §§ 1.52(a)-(c) only to the extent necessary to permit the PTO to properly microfilm and store the application papers.

43. *Comment:* Several comments suggested that an English translation of a foreign language provisional application should not be required unless necessary in prosecution of the 35 U.S.C. 111(a) application to establish benefit. If an English translation is required, there is no useful purpose to require the translation at any time earlier than the filing of 35 U.S.C. 111(a) application claiming the benefit of the provisional application.

Response: Provisional applications may be filed in a language other than English as set forth in existing § 1.52(d). However, an English language translation is necessary for security screening purposes. Therefore, the PTO will require the English language translation and payment of the fee required in § 1.52(d) in the provisional application. Failure to timely submit the translation in response to a PTO requirement will result in the abandonment of the provisional application. If a 35 U.S.C. 111(a) application is filed without providing the English language translation in the provisional application, the English language translation will be required to be supplied in every 35 U.S.C. 111(a) application claiming priority of the non-English language provisional application.

44. *Comment:* One comment suggested that a new model oath or declaration form for use in claiming 35 U.S.C. 119(e) priority and a "cover sheet" for use in filing provisional applications be published as an addendum to the final rules.

Response: The suggestion has been adopted. See Appendix A for the sample cover sheet for filing a provisional application and Appendix B for the sample declaration for use in claiming 35 U.S.C. 119(e) priority.

45. *Comment:* One comment suggested that the statement in § 1.53(b)(2) that the provisional application will not be given a filing date if all the names of the actual inventor or inventor(s) are not supplied be deleted and § 1.41 be amended to make an exception for provisional applications. The comment suggested that 35 U.S.C. 111(b) is satisfied as long as the name of one person who made an inventive contribution to the subject matter of the application is given.

Response: The suggestion has not been adopted. Section 111(b) of title 35, United States Code, states that "a provisional application shall be made or authorized to be made by the inventor." This language parallels 35 U.S.C. 111(a). The naming of inventors for obtaining a filing date for a provisional application is the same as for other applications. A provisional application filed with the inventors identified as "Jones et al." will not be accorded a filing date earlier than the date upon which the name of each inventor is supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused. Administrative oversight is an acceptable reason. It should be noted that for a 35 U.S.C. 111(a) application to be entitled to claim the benefit of the filing date of a provisional application, the 35 U.S.C. 111(a) application must have at least one inventor in common with the provisional application.

46. *Comment:* One comment suggested that a drawing should not be required to obtain a filing date for a provisional application. Whatever is filed should be given a serial number and filing date in order to establish status as a provisional application, regardless of what is in the specification or drawing. If the provisional [*20210] application omitted drawings, has pages missing, or is otherwise incomplete, then applicant may not be able to rely on the filing date of the provisional application in a subsequently filed 35 U.S.C. 111(a) application. It should not be the job of the Application Branch to review compliance with § 1.81(a).

Response: Section 111(b) of title 35, United States Code, states that a provisional application must include a specification as prescribed by 35 U.S.C. 112, first paragraph and a drawing as prescribed by 35 U.S.C. 113. Drawings are required pursuant to 35 U.S.C. 113 if they are necessary to understand the subject matter sought to be patented. If a provisional application as filed omitted drawings and/or has pages missing, the provisional application is prima facie in-

complete and no filing date will be granted. Application Branch currently reviews all applications to make sure that no filing date will be granted to an application that is prima facie incomplete. Application Branch will perform the same type of review with provisional applications. If a filing date is not granted to a provisional application because it is prima facie incomplete, applicant may petition the PTO under § 1.182 to grant a filing date to the provisional application as of the date of deposit of the application papers if it can be shown that the omitted items are not necessary for the understanding of the subject matter.

47. Comment: One comment objected to the requirement in § 1.53(b)(2)(i) for a cover sheet identifying the application as a provisional application because it is unnecessarily rigid and contrary to Congress' desire to keep the filing of provisional application as simple as possible.

Response: The requirement that a provisional application be specifically identified on filing as a provisional application is not seen to be burdensome on the applicant and is necessary for the PTO to properly process the papers as a provisional application. All an applicant is required to do in order to comply with the requirement of § 1.53(b)(2)(i) is to include a transmittal sheet identifying the papers being filed as a PROVISIONAL application.

48. Comment: Several comments suggested that in § 1.53(b)(2)(ii), as proposed, the phrase "the expiration of 12 months after the filing date of the provisional application" should read "the expiration of 12 months after the filing date of the § 1.53(b)(1) application".

Response: The suggestion has been adopted.

49. Comment: One comment objected to the requirement in § 1.53(b)(2)(ii) for a petition to convert an application filed under § 1.53(b)(1) to a provisional application and suggested that any confusion concerning applicant's intention could be handled informally without a petition or petition fee.

Response: The requirement for a petition and fee is intended to ensure that the cost of any PTO reprocessing is borne specifically by the applicant requesting the action.

50. Comment: Several comments suggested that the filing fee required in an application filed under 35 U.S.C. 111(a) claiming benefit of the filing date of an earlier 35 U.S.C. 111(a) application which has been converted to a provisional application under proposed § 1.53(b)(2)(ii) be reduced, since the \$ 730/\$ 365 filing fee was paid in the earlier application.

Response: The suggestion has not been adopted. The filing fee required in an application filed under 35 U.S.C. 111(a) is set by statute. The statute does not provide for the suggested reduction in the filing fee.

51. Comment: One comment suggested that the proposed § 1.53(b)(2)(iii) should apply retroactively to permit applications filed between June 9, 1994, and June 8, 1995, to be converted to provisional applications.

Response: The suggestion has not been adopted. The statute does not permit a provisional application to have a filing date prior to June 8, 1995.

52. Comment: One comment suggested that § 1.53(b)(2)(ii) be revised to state that the petition requesting conversion must also be filed before (1) the application becomes involved in interference, or (2) notice by the PTO of intent to publish the application as a statutory invention registration. This suggestion conforms with 35 U.S.C. 11(b)(8).

Response: The suggestion has not been fully adopted. It is not necessary to include interference in § 1.53(b)(2)(ii) because if a 35 U.S.C. 111(a) application becomes involved in an interference proceeding and applicant files a petition requesting conversion of that 35 U.S.C. 111(a) application to a provisional application, the 35 U.S.C. 111(a) will be removed from the interference proceeding upon granting the petition to convert. When a subsequent 35 U.S.C. 111(a) application is filed based on the provisional application, the subsequent 35 U.S.C. 111(a) application could be placed in the interference proceeding if necessary. As to the reference to statutory invention registration, § 1.53(b)(2)(ii) is being amended to require the petition and the fee be filed prior to the earlier of the abandonment of the 35 U.S.C. 111(a) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 35 U.S.C. 111(a) application, or the filing of a request for a statutory invention registration under § 1.293.

53. Comment: One comment suggested that the procedures for converting a 35 U.S.C. 111(a) application to a provisional application be explained in greater detail in § 1.53(b)(2)(ii) or in the discussion. If a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, and a second 35 U.S.C. 111(a) application is concurrently filed, how should this be done and how should the first sentence in the second 35 U.S.C. 111(a)

application be worded. Furthermore, if a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, will it be necessary to file a second 35 U.S.C. 111(a) application on the same day, or else lose the priority claim.

Response: The suggestion has not been adopted. The language in § 1.53(b)(2)(ii) is clear relating to the requirements for converting a 35 U.S.C. 111(a) application to a provisional application. If applicant wishes to convert a 35 U.S.C. 111(a) application to a provisional application, applicant must file a petition requesting the conversion along with the petition fee set forth in § 1.17(q). The petition and the fee must be filed prior to the earlier of the abandonment of the 35 U.S.C. 111(a) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 35 U.S.C. 111(a) application, or the filing of a request for a statutory invention registration under § 1.293. In the example noted in the comment, if a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, a second 35 U.S.C. 111(a) application must be filed on that same day, otherwise, applicant will lose the priority pursuant to 35 U.S.C. 119(e). An example of how the first sentence of the second 35 U.S.C. 111(a) application would read is, "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, which was converted from Application No.---."

54. *Comment:* One comment suggested that the PTO consider a rule mandating that any prior U.S. application that would have been eligible for conversion to a provisional application that is abandoned in favor of a continuing application within one [*20211] year of the earlier priority date asserted be deemed constructively converted to a provisional application.

Response: The suggestion has not been adopted. Conversion of a 35 U.S.C. 111(a) application to a provisional will be permitted only by way of a petition and under the conditions set forth in § 1.53(b)(2)(ii). One reason for this is that the PTO plans to provide sufficient information on the printed patent to determine the end date of the 20-year patent term by identifying provisional applications using a unique series code, i.e., "60". Thus, a 35 U.S.C. 111(a) application converted to a provisional application will need to be reprocessed by the PTO with a new application number. The petition fee is intended to reimburse the PTO for the extra processing necessitated by the conversion.

55. *Comment:* One comment stated that § 1.53(b)(2)(ii) permits the conversion of a 35 U.S.C. 111(a) application to a provisional application. However, it is silent as to whether such a conversion would kill any benefit the 35 U.S.C. 111(a) application had of domestic and/or foreign priority.

Response: Section 111(b)(7) of title 35, United States Code, specifically states that a provisional application shall not be entitled to the right of priority of any other application under 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date in the United States under 35 U.S.C. 120, 121, or 365(c). If a 35 U.S.C. 111(a) application is converted to a provisional application, the granting of the conversion will automatically eliminate any claim of priority which could have been made in the 35 U.S.C. 111(a) application.

56. *Comment:* Several comments suggested that it was inconsistent with the purpose of the provisional application to require any compliance with the Sequence Disclosure Rules §§ 1.821-1.823 and 1.825, since the provisional applications are not examined and there is no comparison of the sequences with the prior art.

Response: The Office agrees with the comments that a provisional application need not comply with the requirements of §§ 1.821 through 1.825. Section 1.53(b)(2)(iii) is being amended to indicate that the requirements of §§ 1.821 through 1.825 regarding sequence listings are not mandatory for a provisional application. However, applicants are cautioned that in order for a 35 U.S.C. 111(a) application to obtain the benefit of the filing date of an earlier filed provisional application, the claimed subject matter of the 35 U.S.C. 111(a) application must have been disclosed in the provisional application in a manner provided by 35 U.S.C. 112, first paragraph. Applicants are encouraged to follow the sequence rules to ensure that support for the invention claimed in the 35 U.S.C. 111(a) application can be readily ascertained in the provisional application.

57. *Comment:* One comment suggested that the language in § 1.53(e)(2) that a provisional application will become abandoned no later than twelve months after its filing date was misleading and that the words "no later than" should be deleted because it was believed that a provisional application could not be abandoned prior to twelve months after its filing date.

Response: The statute does not state that a provisional application can never be abandoned prior to twelve months after its filing date. In fact, a provisional application may be abandoned as a result of applicant's failure to timely respond to a PTO requirement. For example, if a provisional application which has been accorded a filing date does not include the appropriate filing fee or the cover sheet required by § 1.51(a)(2), applicant will be so notified if a correspon-

dence address has been provided and given a period of time within which to file the fee, cover sheet and to pay the surcharge as set forth in § 1.16(l). Failure to timely respond will result in the abandonment of the application. This may occur prior to twelve months after its filing date. Furthermore, a provisional application may also be expressly abandoned prior to twelve months from its filing date.

58. Comment: One comment objected to the deletion of the "retention fee" practice in § 1.53(d) since it permits an applicant in a first application claiming benefits under 35 U.S.C. 119 (a)-(d) or 120 to correct inventorship by filing a second application without having to pay the full filing fee in the first application.

Response: Since the comment indicated that there is a benefit to retain the retention fee practice, the proposal to eliminate the practice is withdrawn.

59. Comment: One comment stated that the language of §§ 1.53 (d)(1) and (d)(2) indicates an intent by the PTO to mail the "Notice Of Missing Parts" to applicant's post office address and argues that the "Notice" should be mailed to the registered practitioner who filed the application on behalf of the applicant.

Response: The language in §§ 1.53 (d)(1) and (d)(2) states that the applicant will be notified of the missing part, if a correspondence address is provided. This means that the "Notice" to applicant will be mailed to the correspondence address provided in the application papers. Under current PTO practice, if no specific correspondence address is identified in the application, the address of the registered practitioner who filed the application on behalf of the applicant is used as the correspondence address. If no specific correspondence address or registered practitioner is identified in the application, the post office address of the first named inventor is used as the correspondence address. No change in current PTO practice in this regard is required as a result of § 1.53(d)(2) nor is any change planned.

60. Comment: Several comments objected to the proposed deletion of § 1.60. One comment suggested that the deletion of § 1.60 was a major rule change and should have been proposed separate from the proposed rules dealing with the changes in practice required by Public Law 103-465.

Response: In view of the comments received, the proposal to delete § 1.60 is withdrawn. However, the proposal will be considered as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process.

61. Comment: One comment suggested that in view of the deletion of § 1.60, language should be incorporated in § 1.53(a)(1) to state that a copy of the prior application along with a copy of the declaration may be filed to obtain a filing date. Furthermore, full details and guidelines of the procedure should accompany the rule.

Response: The suggestion has not been adopted. The proposal to delete § 1.60 is withdrawn in view of several comments received objecting to the deletion.

62. Comment: One comment suggested that the removal of the stale oath practice be codified.

Response: The suggestion has not been adopted. Neither the statute nor the rules require a recent date of execution to appear on the oath or declaration. The PTO practice of objecting to an oath or declaration where the time elapsed between the date of execution and the filing date of the application is more than three months is found in section 602.05 of the MPEP. Therefore, the removal of the stale oath practice will be accomplished by amending the MPEP.

63. Comment: One comment questioned whether a copy of an application faxed to an attorney could be filed in the PTO as the application papers.

Response: Yes. While a patent application may not be faxed directly to the PTO, an application faxed to an attorney may be forwarded to the PTO by mail or courier as the application papers provided the papers meet the formal requirements of § 1.52. Effective November 22, 1993, § 1.4 was amended to include a new paragraph (d) to specify that most correspondence filed in the PTO, which requires a person's signature, may be an original, a copy of an original or a copy of a copy. Only correspondence identified in §§ 1.4(e) and (f) require the original to be filed in the PTO. Thus, an oath or declaration required by § 1.63, 1.153, 1.162 or 1.175 may be an original, a copy of an original or a copy of a copy. See 1156 Off. Gaz. Pat. Office 61 (November 16, 1993).

64. Comment: One comment suggested that applicant be permitted to use § 1.62 procedure to file the 35 U.S.C. 111(a) application which claims the benefit of a provisional application, at least in those situations where the 35 U.S.C. 111(a) application has been converted to a provisional application which is followed by the filing of a second 35 U.S.C. 111(a) application.

Response: The suggestion has not been adopted. Section 1.62 will not be amended to permit the filing of a 35 U.S.C. 111(a) application based on a provisional application because the PTO sees this situation as a trap for applicants. The filing procedures would be made more complicated if an exception is provided to address situations where a 35 U.S.C. 111(a) application is converted to a provisional application and a second 35 U.S.C. 111(a) application is later filed. However, the suggestion will be taken under advisement when greater familiarity with provisional applications is developed.

65. *Comment:* One comment suggested that § 1.62 procedure be replaced with a simple petition procedure to re-open prosecution.

Response: The suggestion is not being adopted. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process.

66. *Comment:* One comment suggested that the language in § 1.62(a) that requires an identification of the "applicant's name of the prior complete application" is confusing and should be clarified.

Response: The suggestion has been adopted. Section 1.62 is being amended to require the identification of the "applicants named in the prior complete application."

67. *Comment:* One comment suggested that § 1.62 be amended to state that the refiling procedures set forth in § 1.62 may be used after the issue fee is paid when a petition under § 1.313(b)(5) is granted. This practice is permitted pursuant to the notice published in 1138 *Off. Gaz. Pat. Office* 40 (May 19, 1992).

Response: The suggestion has been adopted.

68. *Comment:* One comment suggested that § 1.62 be amended to clarify whether applicant needs to re-list, in the § 1.62 application, all the references cited by the examiner and applicant in the parent application in order to get those references printed on the eventual patent.

Response: The suggestion has not been adopted. Section 609 of the MPEP (Sixth Edition, Jan. 1995) has been amended to clarify that in a § 1.62 application, references submitted and cited in the parent application need not be resubmitted. These references will be printed on the patent. However, in any continuing application filed under § 1.53(b)(1) or 1.60, a list of the references must be resubmitted if applicant wishes to have the references printed in the eventual patent.

69. *Comment:* One comment suggested that § 1.67 should go into more detail on when supplemental oaths are required in § 1.53 filings of continuation and divisional applications.

Response: The suggestion has been adopted because it is seen to be unnecessary and no substantive change was proposed to § 1.67 in the Notice of Proposed Rulemaking.

70. *Comment:* One comment suggested that "not but" in § 1.67(b) should read "but not".

Response: The suggestion has been adopted.

71. *Comment:* Several comments suggested that a rule be provided to state that an application for patent is permitted to claim the benefit of the filing date of more than one prior provisional application so long as the applicant complies with all statutory provisions.

Response: The suggestion has been adopted. Section 1.78(a)(3) is being amended to indicate that applicants are permitted to separately claim the benefit of the filing date of more than one prior provisional application in a later filed 35 U.S.C. 111(a) application provided all statutory requirements of 35 U.S.C. 119(e) are complied with. It is noted that current practice permits an application to claim the benefits of the filing date of more than one prior foreign application under 35 U.S.C. 119(a)-(d) and of more than one prior copending U.S. application under 35 U.S.C. 120, without an explicit statement to that effect in the rules. Since the final rules are being amended to specifically permit applications filed under 35 U.S.C. 111(a) to claim the benefits of the filing date of more than one prior copending provisional application, corresponding changes are also being made to §§ 1.55 and 1.78(a)(1) relating to claims for the benefits available under 35 U.S.C. 119(a)-(d) and 120 to be consistent with § 1.78(a)(3).

72. *Comment:* Several comments requested that the PTO specify language to use in the first sentence of an application when priority is based on more than one provisional application.

Response: Section 1.78(a)(4) requires that "any application claiming the benefit of a prior filed copending provisional application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior provisional application, identifying it as a provisional application, and including the provisional application number." Where a 35 U.S.C. 111(a) application claims the benefit of more than one provisional application, a suitable reference would read, "This application claims the benefit of U.S. Provisional Application No. 60/--, filed -- and U.S. Provisional Application No. 60/--, filed --." In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. application No. 08/--, filed --, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/--, filed --."

73. *Comment:* One comment suggested that the rules address the effect on patent term where an applicant in a continuing application deletes the reference to the prior filed application before the patent issues.

Response: an applicant has full control over claims to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c). The 20-year patent term will be based upon the filing date of the earliest U.S. application that the applicant makes reference to under 35 U.S.C. 120, 121 and 365(c). Whether an applicant is entitled to the benefit of the filing date of an earlier application is something that an applicant should examine before the patent is issued. The PTO is not, unless it comes up as an issue in the examination process, going to determine whether any of the claims are entitled to the earlier filing date. Applicant however, should determine whether the claims are entitled to or require the benefit of the earlier filing [*20213] date. If not, the applicant should consider canceling the reference to the earlier filed application to avoid having the 20-year patent term measured from that earlier filing date. An amendment adding or deleting a reference to an earlier filed application presented prior to a final action will be entered, however, the claims may be subject to possible intervening prior art.

74. *Comment:* One comment stated that in view of the fact that a provisional application is not entitled to claim the benefit of a prior filed copending national or international application as stated in § 1.53(b)(2)(iii), the phrase "other than a provisional application" in § 1.78(a)(2) is unnecessary.

Response: Section 1.78(a)(2) is being amended to state that "any nonprovisional application claiming the benefit of a prior copending nonprovisional or international application must contain * * *." Section 1.78(a)(2) addresses a 35 U.S.C. 111(a) application which claims the benefit of a prior copending 35 U.S.C. 111(a) application or international application.

75. *Comment:* Several comments objected to the content requirements for drawings filed in a provisional application as originally set forth in proposed § 1.83(a)(2). One comment suggested that no rule was necessary to set forth the required content of drawings in a provisional application.

Response: In view of the comments received, the proposed amendment to § 1.83 is withdrawn. Under 35 U.S.C. 113, first sentence, applicant must furnish drawings in a provisional application "where necessary for the understanding of the subject matter sought to be patented." This requirement is also stated in existing § 1.81(a). Therefore, no further elaboration on the content of the drawings in a provisional application is believed necessary in the rules.

76. *Comment:* One comment suggested that the rules specify that formal drawings are not required in a provisional application.

Response: The suggestion has not been adopted. However, the PTO intends to examine provisional applications for requirements of form only to the extent that is necessary to permit normal storage and microfilming of the application papers. Formal drawings are usually not required for those purposes.

77. *Comment:* Several comments suggested that § 1.97(d) be amended to require the PTO to consider any information disclosure statement submitted after a final rejection or notice of allowance if an appropriate fee is paid.

Response: The suggestion has not been adopted because no substantive change to this rule was proposed in the Notice of Proposed Rulemaking. The existing rules are designed to encourage prompt submission of information to the PTO. To permit applicant to merely pay a fee to have any information disclosure statement submitted after a final rejection or Notice of Allowance would be contrary to the effort to encourage prompt submissions.

78. *Comment:* One comment suggested that § 1.97 be changed so that an office action which uses a newly cited reference as a ground for rejection under 35 U.S.C. 102 or 103 cannot be made final.

Response: The suggestion has not been adopted because no substantive change to this rule was proposed in the Notice of Proposed Rulemaking.

79. *Comment:* One comment suggested that the words "which are not examined" in § 1.101 as proposed are unnecessary and could create a negative implication that some provisional applications are examined.

Response: The suggestion has not been adopted. By statute, provisional applications are not subject to 35 U.S.C. 131, i.e., the Commissioner is not permitted to examine a provisional application for patentability.

80. *Comment:* Several comments stated that it is unfair to require small entities to pay the full \$ 730.00 fee set forth in proposed § 1.129. It is suggested that the fee be changed to \$ 365.00 or less.

Response: Pursuant to Public Law 103-465, the Commissioner has the authority to establish appropriate fees for the further limited reexamination of applications and for the examination of more than one independent and distinct invention in an application. As a result of additional review, it was concluded that these fees may be reduced by 50% for small entities. Sections 1.17 (r) and (s) are being amended to indicate that the fees are reduced by 50% for small entities, that is, \$ 365.00 for small entities.

81. *Comment:* Several comments suggested that the transitional procedure set forth in § 1.129(a) as proposed is equivalent to filing one application, i.e., it provides for an extra examination and reexamination after the original final rejection, and, therefore, the requirement for two \$ 730.00 fees, which is equivalent to two filing fees, is unwarranted. Another comment suggested that if the proposed \$ 730.00 fee is adopted, the examiner should be instructed to treat the after-final amendment as any other initial filing, i.e., a new application, not as an amendment submitted after a non-final office action.

Response: Under existing PTO practice, it would not be proper to make final a first Office action in a continuing or substitute application where the continuing or substitute application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The identical procedure will apply to examination of a submission consideration as a result of the procedure under § 1.129(a). Thus, under § 1.129(a), if the first submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Likewise, if the second submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Thus, the fee required by § 1.129(a) has been set at the amount required for filing an application because the procedure provided by the rule is equivalent to the filing of two applications. No new matter can be entered by payment of the fee set forth in § 1.17(r).

82. *Comment:* Several comments suggested that the fees required for filing a provisional application and those fees required by §§ 1.129(a) and (b) for the transitional procedures should not be greater than the average cost of processing such matters by the PTO. Two comments stated that the fee required by § 1.129(a) is excessive relative to PTO costs.

Response: The fee required for filing a provisional application is set by Public Law 103-465 and the PTO has no discretion with respect to the amount of that particular fee. As to the fee required by § 1.129(a), the procedures relating to the first submission provided by § 1.129(a) is equivalent to the filing of a file wrapper continuation application under § 1.62, and therefore, the fee required with the first submission is appropriately set at the same amount as a filing fee, which is \$ 730.00. The \$ 730.00 fee is subject to a 50% reduction for small entities. The second submission is equivalent to the filing of [*20214] a second file wrapper continuation application and the fee for the second submission is appropriately set at the same amount as a filing fee. As to the fee required by § 1.129(b), the procedures set forth in § 1.129(b) permit applicants to retain multiple inventions in a single application rather than having to file multiple divisional applications. The fee for each independent and distinct invention in excess of one is appropriately set at the same amount as the filing fee for a divisional application, which is \$ 730.00. The \$ 730.00 fee is subject to a 50% reduction for small entities.

83. *Comment:* One comment suggested that the time period for the payment of the \$ 730.00 fee for the transitional after-final practice be extended if applicant files a petition seeking reversal of the examiner's refusal to enter the amendment after final without fee, until one month after an unfavorable decision on the petition.

Response: If an earlier filed petition seeking reversal of the examiner's refusal to enter the amendment after final is granted by the Director finding that the final rejection was premature, but the petition had not been decided by the time

the § 1.129(a) fee was due, applicant must submit the § 1.129(a) fee so as to toll the time period for response to the final rejection. Otherwise, the application would be abandoned. Upon granting of such a petition by the Director, the § 1.129(a) fee paid will be refundable to applicant on request. Applications that fall under § 1.129(a) are under final rejection and there is a time period running against the applicant. Applicant must toll that time period by paying the transitional after-final fee set forth in § 1.129(a) and any necessary extension of time fees and Notice of Appeal fee. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) may be submitted before the filing of the Appeal Brief and prior to abandonment of the application.

84. Comment: One comment suggested that if it is decided that the transitional after-final practice is made permanent, the PTO should seek legislative authorization to provide reduced fees for small entities.

Response: If it is decided that the transitional after-final practice be made permanent, the PTO will propose legislation to accomplish this change.

85. Comment: Several comments suggested that §§ 1.129 (a) and (b) should apply to all applications regardless of whether they were filed before or after June 8, 1995.

Several comments suggested that the practices set forth in §§ 1.129 (a) and (b) should be made permanent.

Several comments suggested that an applicant should be permitted to have a submission entered and considered after any final rejection upon payment of a fee as set forth in § 1.17(r), not just the first and second final rejections.

Response: The suggestions have not been adopted at this time. However, the PTO is undertaking a project to reengineer the entire patent process. These suggestions will be taken under advisement in that project.

86. Comment: One comment suggested that the PTO make an effort to treat applications in which a submission under § 1.129(a) has been filed on an expedited basis.

Response: Once the submission is filed and the fee set forth in § 1.17(r) is paid the finality of the last PTO action is withdrawn. The filing of the submission and the fee under § 1.129(a) is equivalent to the filing of a continuing application and will be treated in the same fashion and under the same turnaround time frame as a continuing application.

87. Comment: One comment suggested that PTO practice be changed so that a first Office action in a continuing application cannot be made final.

One comment suggested that PTO practice regarding second action final be relaxed.

Response: The suggestions have not been adopted at this time. However, the PTO is undertaking a project to reengineer the entire patent process. These suggestions will be taken under advisement in that project.

88. Comment: One comment stated that in proposed § 1.129, there is no express provision for the finality of the previous rejection to be withdrawn if applicant complies with the proposed rule. It is suggested that the proposed rule state that the finality of the previous action will be withdrawn if applicant complied with the rule when making a first or second submission after a final action.

Response: The suggestion has been adopted.

89. Comment: One comment requested that the PTO clarify whether § 1.129(a) required the first final rejection to be specifically withdrawn and a different final (i.e., one containing a new ground of rejection) rejection made before applicant is entitled to make a second submission.

Response: The final rule provides that the finality of the previous final office action is automatically withdrawn upon the timely filing of the first § 1.129(a) submission and the fee set forth in § 1.17(r). If the first PTO action following the payment of the § 1.17(r) fee is a non-final office action, a further response from applicant will be entered and considered as a matter of right without payment of the fee set forth in § 1.17(r). If the next office action or any subsequent action is made final, the finality of that office action will be automatically withdrawn upon the timely filing of a second § 1.129(a) submission and the fee set forth in § 1.17(r).

90. Comment: One comment suggested that the PTO not permit the first PTO action following the payment of the § 1.17(r) fee to be made final under any circumstances.

Response: The suggestion has not been adopted. The first PTO action following the payment of the § 1.17(r) fee may be made final under the same conditions that a first office action may be made final in a continuing application (see

section 706.07(b) of the MPEP). However, it would not be proper to make final a first Office action in a continuing or substitute application where the continuing or substitute application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The procedure set forth in section 706.07(b) of the MPEP will apply to examination of a submission considered as a result of the procedure under § 1.129(a).

91. Comment: Several comments suggested that the filing of the first submission under § 1.129(a) within the statutory period for response set in final rejection should toll the running of the six-month statutory period.

Response: The filing of a submission, e.g., an information disclosure statement or an amendment, after a final rejection without payment of the fee set forth in § 1.17(r) will not toll the period for response set in the final rejection. However, § 1.129(a) is being amended to provide in the rule that the finality of the previous Office action is automatically withdrawn upon the filing of the submission and the payment of the fee set forth in § 1.17(r). Thus, the filing of a submission and the payment of the fee set forth in § 1.17(r) and any extension of time fees and Notice of Appeal fee, if they are necessary to avoid abandonment of the application, will automatically toll the period for response set in the final rejection. It must be kept in mind that the provisions of § 1.129 apply only to an application, other than for reissue or [*20215] a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c).

92. Comment: One comment asked (1) whether it would be necessary to file a Notice of Appeal and appeal fee with or after the first submission and fee if the examiner acts on the first submission and before the end of the six months from the date of the final rejection issues (a) a notice of allowance, (b) a non-final action, or (c) a second final rejection; (2) would the Notice of Appeal and fee be due only at the end of the six months from the date of the final rejection regardless of whether the examiner has acted on the submission by then; and (3) if the Notice of Appeal and fee have once been paid following a first final rejection, would a second notice and fee need to be paid if a second final rejection were issued and applicant desired to file a second submission under § 1.129(a).

Another comment suggested that the appeal fee set forth in § 1.17(e) should not be required where the Notice of Appeal is filed with a § 1.129(a) submission and the fee set forth in § 1.17(r).

Response: As to questions (1) and (2) and the second comment, if the first submission and the proper fee set forth in § 1.17(r) are timely filed in response to the final rejection, the finality of the previous rejection will be automatically withdrawn and applicant need not file the Notice of Appeal or the appeal fee. For example, if the first submission and the proper fee set forth in § 1.17(r) were filed on the last day of the six-month period for response to the final rejection, applicant must also file a petition for three months extension of time with the appropriate fee in order to avoid abandonment of the application. In such case, applicant need not file the Notice of Appeal or the appeal fee if the proper fee set forth in § 1.17(r) was timely paid. However, under the same fact situation, if applicant failed to submit the proper fee set forth in § 1.17(r), the finality of the previous rejection would not be withdrawn and the time period for response would still be running against applicant. In such case, a Notice of Appeal and appeal fee must also accompany the papers filed at the six-month period in order to avoid abandonment of the application. The proper fee set forth in § 1.17(r) must be filed prior to the filing of the Appeal Brief and prior to the abandonment of the application.

As to question (3), if the Notice of Appeal and fee have once been paid following a first final rejection and applicant timely files a first submission and the proper fee set forth in § 1.17(r), the finality of the previous final rejection will be withdrawn and the appeal fee paid could be applied against any subsequent appeal. If the examiner issues a non-final rejection in response to applicant's first submission, a further response from applicant will be entered and considered as a matter of right. If any subsequent Office action is made final, applicant may file a second submission along with the proper fee pursuant to § 1.129(a). If the second submission and the proper fee set forth in § 1.17(r) are timely filed in response to the subsequent final rejection, the finality of the previous final rejection will be withdrawn. Any submission filed after a final rejection made in the application subsequent to the fee under § 1.129(a) having been paid twice will be treated as set forth in § 1.116. Applicant may, upon payment of the appeal fee, appeal a final rejection within the time allowed for response pursuant to § 1.191.

93. Comment: One comment questioned whether the "first submission" under § 1.129(a) has to be the first response filed after a final rejection or could it include subsequent responses to the same final rejection.

Response: The "first submission" under § 1.129(a) would include all responses filed prior to and with the payment of the fee required by § 1.129(a) provided the submission and fee are filed prior to the filing of the Appeal Brief and prior to abandonment of the application.

94. Comment: One comment suggested that § 1.129(a) be changed to permit the procedure to be available up until the filing of an Appeal Brief since it is not uncommon to file an amendment after a Notice of Appeal is filed but before the filing of an Appeal Brief.

Response: The suggestion has been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the application.

95. Comment: One comment suggested that the transitional after-final practice be available at any time after final, including after the resolution of an appeal unfavorable to applicant in whole or in part.

Response: The suggestion has not been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the application. The suggestion to extend the period to after the resolution of an appeal unfavorable to applicant in whole or in part has not been adopted because the suggestion would further unduly extend prosecution of the application.

96. Comment: One comment stated that if an examiner must withdraw the finality of the rejection as a result of the transitional provision, the examiner should be credited with two counts in order to be compensated for the additional work.

Response: The examiner credit system is not part of this rulemaking package. However, as part of the Public Law 103-465 implementation plan, some accommodation will be made for the extra work performed.

97. Comment: One comment stated that regarding the transitional after-final practice, the fee should not be required if the only reason is to have the PTO consider recently obtained art.

Response: Under current practice, if applicant submits prior art after final rejection but before the payment of issue fee, the art will be considered if applicant makes the required certification and submits a petition with the required petition fee of \$ 130.00 (see section 609 of the MPEP). If applicant can make the certification, applicant would not have to rely on the transitional after-final procedure to have the prior art considered. In the event that applicant cannot make the certification, then the procedure under § 1.129(a) is available if applicant wishes the PTO to consider the prior art without refiling the application.

98. Comment: One comment suggested that the PTO modify existing restriction practice to make it more difficult for examiners to require restriction, for example, by requiring every restriction requirement to show two-way distinctness and separate status in the art established by means other than reference to the PTO's classification system.

Response: The suggestion has not been adopted. However, the PTO is undertaking a project to reengineer the entire patent process. This suggestion will be taken under advisement in that project.

99. Comment: One comment suggested that the pendency periods required by §§ 1.129(a) and (b) should be 18 months rather than 2-year and 3-year, respectively.

Response: The pendency periods set forth in the rule which establish eligibility for the transitional procedures are set forth in Public Law 103-465.

100. Comment: One comment suggested that § 1.129(a) be amended to [*20216] permit prosecution to be reopened after a Notice of Allowance or final rejection upon the filing of a form requesting that prosecution be reopened and payment of the necessary fee.

Response: The procedures set forth in § 1.129(a) are not applicable to amendments filed after a Notice of Allowance. Amendments filed after the mailing of a Notice of Allowance are governed by § 1.312. The procedures set forth in § 1.129(a) are applicable to amendments filed after a final rejection. If applicant submits an amendment after final and the examiner notifies the applicant in writing that the amendment is not entered, § 1.129(a) permits applicant to submit a letter prior to abandonment of the application and prior to the filing of the Appeal Brief, requesting entry of the prior filed amendment along with the payment of the appropriate fee set forth in § 1.17(r). The letter requesting entry of the prior filed amendment would be equivalent to "a form" as suggested in the comment.

101. Comment: One comment suggested that the PTO liberalize its current practice under § 1.116 to make it easier for amendments or evidence to be entered and considered after a final rejection.

Response: The suggestion has not been adopted since no change was proposed to § 1.116 in the Notice of Proposed Rulemaking. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process. It should be noted that any change to liberalize the current practice under § 1.116 would necessitate increasing fees.

102. Comment: Several comments suggested that the transitional restriction provision be modified to state that no restriction requirement shall be made or maintained in any application pending for three years on the effective date of the legislation. The comment stated that if restriction requirements made prior to April 8, 1995, are permitted to be maintained then applicants will be forced to file divisional applications resulting in the automatic loss of term after June 8, 1995. A heavy penalty will be placed on the chemical, pharmaceutical and biotechnology industries, who have less than 4 months to search through the ancestors of all pending applications and to identify all restriction requirements and to file divisional applications before June 8, 1995. The comment further suggested that the current restriction practice be changed in view of the implementation of the 20-year term.

Response: The suggestion has not been adopted. The two-month date set forth in § 1.129(b)(1)(i) is from the Statement of Administrative Action, which is part of Public Law 103-465. Under section 102 of Public Law 103-465, "the statement of administrative action approved by the Congress shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application." The Commissioner does not have any authority to establish rules which are inconsistent with the Act. It is noted that in cases where a restriction requirement was made prior to April 8, 1995, applicant will have sufficient time to file divisional applications prior to June 8, 1995, so as to retain the benefit of the 17-year patent term for those divisional applications.

103. Comment: Several comments suggested that proposed exceptions (1) and (2) in § 1.129(b) ignore the mandatory language of section 532(2)(B) of Public Law 103-465 and should be deleted.

Response: The suggestion has not been adopted. The exceptions referred to are contained in the Statement of Administrative Action, which is part of Public Law 103-465. Under section 102 of Public Law 103-465, "the statement of administrative action approved by the Congress shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application."

104. Comment: One comment asked whether "restriction" under § 1.129(b) apply to election of species under § 1.146.

Response: "Restriction" under § 1.129(b) applies to both requirements under § 1.142 and elections under § 1.146.

105. Comment: Several comments requested that clarification be made as to what constitutes "actions by the applicant" in § 1.129(b)(1) and specifically, whether a request for extension of time under § 1.136(a) constitutes such "actions" by the applicant.

Response: Examples of what constitute "actions by the applicant" in § 1.129(b)(1) are: (1) applicant abandons the application and continues to refile the application such that no Office action can be issued in the application, and (2) applicant requests suspension of prosecution under § 1.103(a) such that no Office action can be issued in the application. Extension of time under § 1.136(a) would not constitute such "actions by the applicant" under § 1.129(b)(1).

106. Comment: One comment suggested that the one-month period set forth in § 1.129(b) is insufficient to give an applicant time to file a petition under § 1.144 from a restriction requirement. Several comments suggested that § 1.129(b) be amended to permit applicant to challenge the restriction requirement by way of a petition before being required to pay the fees set forth in § 1.17(s).

Response: Section 1.129(b)(2) is being amended in the final rule package to indicate that applicant will be given "a time period" to (1) make an election, if no election has been previously made, and pay the fee set forth in § 1.17(s), (2) confirm an earlier election and pay the fee set forth in § 1.17(s), or (3) file a petition under § 1.129(b)(2) traversing the restriction requirement. If applicant chooses not to pay the fee set forth in § 1.17(s), applicant may file a petition under § 1.129(b)(2) requesting immediate review by the Group Director of the restriction requirement. No petition fee is re-

quired. A petition under § 1.129(b)(2) rather than under § 1.144 would be more appropriate under the circumstances since a petition under § 1.144 requires the examiner to make the restriction final before the petition can be considered.

107. Comment: One comment suggested that if applicant elects not to pay the fee set forth in § 1.17(s), applicant should be allowed to elect the invention to be examined.

Response: The suggestion has been adopted. Section 1.129(b) is being amended to indicate that if applicant chooses not to pay the fees for the additional inventions, applicant must elect the invention to be examined and the claims directed to the non-elected inventions for which no fee has been paid will be withdrawn from consideration.

108. Comment: One comment suggested that the PTO amend the rules to permit all, or at least several, inventions to be examined in a single application upon payment of an appropriate fee.

Response: The suggestion has not been adopted at this time. However, the [*20217] PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken in advisement in this project.

109. Comment: One comment suggested that PTO follow the wording of 35 U.S.C. 121 and only require restriction where an application claims two or more independent and distinct inventions rather than two or more independent or distinct inventions.

Response: In making restriction requirements, the PTO has always followed the wording of 35 U.S.C. 121 to require restriction if two or more independent and distinct inventions are claimed in an application rather than independent or distinct as suggested by the comment. The term "independent" includes species and related inventions such as combination/subcombination and process and product. Restriction is proper if these independent inventions are patentably distinct (see section 802.01 of the MPEP).

110. Comment: One comment suggested that the standard for determining whether an application contains independent and distinct inventions should only be the "unity of invention" standard used for PCT applications.

Response: The suggestion has not been adopted. The current restriction practice for 35 U.S.C. 111(a) applications is governed by 35 U.S.C. 121 and §§ 1.141, 1.142 and 1.146. The PCT "unity of invention" standard only applies to PCT applications and applications filed under 35 U.S.C. 371. The PTO is currently reviewing the restriction practice in view of the implementation of the 20-year patent term. It is noted that a change in restriction practice without changes to other fees would have a negative impact on funding needed to operate the PTO.

111. Comment: One comment suggested that the PTO apply the PCT unity of invention standard as interpreted by the EPO and that § 1.475(b) be amended to permit a broad range of claims in a single application.

Response: The PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken under advisement in this project.

112. Comment: One comment suggested that the PTO examiner should not be permitted to issue a restriction requirement or an election of species requirement if the ISA and the IPEA have found that an application complies with the unity of invention requirement.

Another comment suggested that the PTO consider allowing applicants to retain all claims in a single application when the claims are related, e.g., method and apparatus claims.

Another comment suggested that all species be searched before the first Office action regardless of whether one species is found to be unpatentable.

Another comment suggested that election of species requirements be prohibited.

Response: The suggestions have not been adopted. These issues were not addressed in the Notice of Proposed Rulemaking. However, the PTO is currently undertaking a project to reengineer the entire patent process. The suggestions will be taken under advisement in that project.

113. Comment: One comment suggested that decisions on whether to issue a restriction requirement be made within two-three months of the application filing date, and, if the requirement is traversed, the examiner should determine within four-five months of the filing date whether to maintain the requirement. Decisions on petitions to withdraw a restriction requirement should be decided within one month.

Response: The suggestion has not been adopted. Current practice dictates that restriction requirements be made at the earliest appropriate time in the pendency of a given application, e.g., in the first Office action. It would be difficult to issue a restriction requirement within two-three months of the application filing date as suggested since a large number of applications are filed with missing parts and applicants are given a time period to submit the missing parts. Furthermore, applications must be processed by the Application Branch and must be screened by Licensing and Review for national security. Petitions to withdraw a restriction requirement should be acted on by the Group Director expeditiously.

114. Comment: One comment argued that the phrases, "so as to be pending for a period of no longer than 12 months" and "under no circumstances will the provisional application be pending after 12 months", in § 1.139 were repetitious and suggested that one or both of the phrases be deleted.

Response: The suggestion has not been adopted. The statements are included for emphasis.

115. Comment: One comment suggested that § 1.139 clearly state that if the revival petition is filed later than 12 months after filing of the provisional application, then the revival is for the sole purpose of providing copendency for a 35 U.S.C. 111(a) application filed during that 12-month period.

Response: The suggestion has not been adopted. The proposed language is not necessary.

116. Comment: One comment stated that 35 U.S.C. 154(b) as contained in Public Law 103-465 does not give the Commissioner any authority to decide the period of extension. Therefore, proposed § 1.701 is without statutory basis.

Response: 35 U.S.C. 6(a) gives the Commissioner authority to establish regulations not inconsistent with law. Section 1.701 is consistent with 35 U.S.C. 154(b) and furthermore, the Commissioner has the authority under 35 U.S.C. 154(b)(3)(C) to establish regulations to address the standards for determining due diligence.

117. Comment: One comment questioned whether patent term extension under 35 U.S.C. 154(b) is available for patents issuing: (1) Before June 8, 1995, with a 17-year patent term or a 17/20 year patent term; (2) on or after June 8, 1995, on applications filed before June 8, 1995, with a 17-year patent term or a 17/20 year patent term.

Response: None of the patents set forth in the examples are eligible for patent term extension. Under the terms of the statute, patent term extension is only available for patents issued on applications filed on or after June 8, 1995.

118. Comment: Several comments questioned whether a patent issued on a continuing application is entitled to a patent term extension under 35 U.S.C. 154(b) due to interference, secrecy order, or appellate review delays occurring in the examination of the parent application.

Response: If the delay in the parent application contributed to a delay in the issuance of a patent in the continuing application, the patent granted on the continuing application may be eligible for an extension under 35 U.S.C. 154(b).

119. Comment: One comment suggested that the patent term be extended for a period of time equal to the time necessary to revive an application improperly abandoned due to PTO error. Another comment suggested that patent time extension be available for other PTO delays.

Response: The suggestions have not been adopted. Section 154(b) of title 35, United States Code, only permits patent term extension for delays due to interferences, secrecy orders, and/or successful appeals.

120. Comment: One comment suggested that the period of an extension granted under § 1.701 be printed on the face of the patent.

Response: The PTO will publish on the face of the patent any patent term [*20218] extension that is granted pursuant to § 1.701.

121. Comment: One comment suggested that the word "interference" be inserted before the word "proceedings" in § 1.701(a)(1).

Response: The suggestion has been adopted.

122. Comment: One comment stated that the last sentence of § 1.701(b) is confusing because it suggests that patent term extension will be available in cases of terminal disclaimer and that the extension begins on the terminal disclaimer date rather than the original expiration date. This statement is contrary to 35 U.S.C. 154(b)(2) which does not permit any patent term extension for appellate delay if the patent is subject to a terminal disclaimer.

Response: In order to reduce confusion, the last sentence of § 1.701(b) is being amended to state that the extension will run from the expiration date of the patent. The reference to "terminal disclaimer" is being deleted.

123. Comment: Two comments stated that if an application involved in an interference proceeding contains uninvolved claims, those uninvolved claims should not be entitled to extension of patent term under proposed § 1.701 because applicant could cancel those uninvolved claims from the application and refile those claims in a continuation application. It is suggested that if an applicant leaves conclusively uninvolved claims (where no § 1.633(c)(4) motion is filed) in the application in interference, applicant does not get the benefit of the extension for any claim.

Response: The suggestion has not been adopted. The statute, 35 U.S.C. 154(b), grants patent term extension to a patent if the issuance of the patent was delayed due to interference proceeding under 35 U.S.C. 135(a). The statute does not exclude applications containing uninvolved claims. The Commissioner does not have the authority to establish regulations which are inconsistent with the law. Therefore, an application involved in an interference which contains uninvolved claims will be entitled to patent term extension if the issuance of the patent was delayed due to interference proceeding under 35 U.S.C. 135(a).

124. Comment: One comment asked whether applicant is entitled to patent term extension regardless of whether an interference involving applicant's application is ultimately declared.

One comment asked if the PTO ends the suspension without declaring an interference, and continued prosecution results in filing of a continuation or divisional application, are such subsequent cases entitled to the extension.

Response: An application will not be suspended unless it is decided that an interference can be declared involving that application. If prosecution of applicant's application is suspended due to an interference not involving applicant's application and an interference involving applicant's application is later declared, applicant will be entitled to patent term extension under § 1.701(c)(1)(ii) for the suspension period and under § 1.701(c)(1)(ii) for the interference period. However, if prosecution of applicant's application is suspended due to an interference not involving applicant's application and if the PTO ends the suspension of the application without declaring an interference involving applicant's application, that application will be entitled to patent term extension under § 1.701(c)(1)(ii). If prosecution results in filing of a continuing application and if the delay in the parent application contributed to a delay in the issuance of a patent on the continuing application, the patent granted on the continuing application may be eligible for an extension under 35 U.S.C. 154(b).

125. Comment: One comment stated that delays in the issuance of a patent can exceed the five-year limit provided for in proposed § 1.701(b). Where the delay was not the fault of the applicant, why should there be this maximum?

Another comment stated that in a biotechnology application, if suspension of the application results in a declared interference, the period of delay calculated under § 1.701(c)(1)(i) will likely consume most of the five-year maximum extension. This renders the value of any time period measured under § 1.701(c)(1)(ii) negligible, thus diminishing the rights of applicant due to the unregulated suspension powers of the PTO.

Response: The five-year limit for patent term extension set forth in § 1.701(b) is required by statute, 35 U.S.C. 154(b).

126. Comment: One comment suggested that § 1.701(c)(1)(i) be amended to state that an application added after an interference is declared is entitled to an extension measured only from the date of redeclaration.

Response: The suggestion has not been adopted. The language in § 1.701(c)(1)(i) is clear that for an application that is added to an interference, that application is entitled to an extension measured from the date of redeclaration of the interference.

127. Comment: One comment stated that § 1.701(c)(1)(ii) does not address the case where a suspended application is added to the interference without the suspension being lifted.

Response: Section 1.701(c)(1)(ii) is being amended to reference the endpoint for the suspension period to the date of termination of the suspension. Where prosecution of an application is suspended due to interference proceedings not involving the application, the suspension is made pursuant to § 1.103(b). When that application is added to an interference, the suspension pursuant to § 1.103(b) will be automatically lifted. The application is entitled to patent term extension for the period of suspension pursuant to § 1.701(c)(1)(ii) and for the period of interference pursuant to § 1.701(c)(1)(i). Under § 1.701(c)(1)(ii), the period of suspension begins on the date the application is suspended and ends

on the date the suspension under § 1.103(b) is terminated, which in this case would be the same date as the date of redeclaration of the interference.

128. Comment: One comment suggested that the phrase ", if any," in § 1.701(c)(1)(i) and (ii) is unnecessary.

Response: The suggestion has not been adopted. However, § 1.701(c)(1)(i) is being amended for clarity by deleting the phrase "if any" after the first occurrence of "interference" and by inserting the same phrase after the phrase "the number of days."

129. Comment: Several comments suggested that the phrase "was declared or redeclared" in § 1.701(c)(1)(i) be changed to-was first declared-.

Response: The suggestion has not been adopted. The language of the rule reads "with respect to each interference in which the application was involved, the number of days in the period beginning on the date the interference was declared or redeclared to involve the application in the interference." * * * "An interference may be declared as A vs. B and later redeclared as A vs. B vs. C. Under the rule, the period of extension would be counted, with respect to applications A and B, from the date the interference was declared to involve the applications A and B. With respect to application C, the period of extension would be counted from the date the interference was redeclared to involve the application C. No ambiguity is seen in the language as originally proposed.

130. Comment: One comment suggested that the use of the phrase "appellate review" in reference to an action under 35 U.S.C. 145 or 146 is incorrect, since an action under 35 U.S.C. 145 or 146 is not considered as an "appellate review" and suggests that § 1.701(a)(3) be amended so that the [*20219] introductory phrase reads "Appellate review by the Board of Patent Appeals and Interferences or review by a Federal court under 35 U.S.C. 141 or 145,* * *."

Response: The suggestion has not been adopted. The use of the phrase "appellate review" in reference to an action under 35 U.S.C. 145 or 146 is technically incorrect. However, Public Law 103-465 provides for extension of patent term for "delay due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court". The introductory phrase referred to in the comment uses the exact language found in the statute.

131. Comment: One comment suggested that § 1.701(a) be amended to specify whether extensions for appellate delays are available for reissue applications.

Response: The suggestion has not been adopted. Under 35 U.S.C. 251, the term of a reissue patent is "for the unexpired part of the term of the original patent." Therefore, patent term extension for appellate delays is not available for reissue applications.

132. Comment: One comment suggested that § 1.701(d) be deleted.

Response: The suggestion has not been adopted. Section 1.701(d) sets forth the language found in the statute, 35 U.S.C. 154(b)(3) and further provides a standard for determining due diligence.

133. Comment: Several comments suggested that the lack of due diligence set forth in § 1.701(d)(2) be limited to the acts which occurred during the appellate period (after the filing of a Notice of Appeal) and not during prosecution.

Response: The suggestion has been adopted. Section 1.701(d) is being amended accordingly.

134. Comment: One comment suggested that the rules be made clear that a suspension under § 1.103 does not constitute a lack of due diligence under § 1.701(d)(2).

Response: The suggestion has not been adopted. A request for suspension pursuant to § 1.103(a) during the appellate review period will be considered to be *prima facie* evidence of lack of due diligence.

135. Comment: Several comments stated that the rules permit extensions of time and the filing of informal applications. These acts should not constitute lack of due diligence since the proposed rule defined the standard for determining due diligence is whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person. One comment suggested that the Office adopt a gross negligence standard.

Response: The examples of acts that may constitute lack of due diligence set forth in the Notice of Proposed Rule-making (extensions of time, filing of nonresponsive submissions, and filing of informal applications) are being withdrawn. The suggestion regarding the adoptions of a gross negligence standard has not been adopted. As set forth in § 1.701(d)(2), the standard for determining due diligence is whether applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during the appellate review period.

136. Comment: One comment stated that the PTO list in the rule all circumstances in which an applicant will be considered not to have acted with due diligence.

Another comment suggested that objective criteria for "diligence" be set forth in § 1.701(d)(2).

Response: The suggestion has not been adopted. Whether an action by the applicant constitutes lack of due diligence will be determined by the facts and circumstances of each case. Since lack of due diligence is determined on a case-by-case basis, it would not be possible to list all circumstances in the rule. Examples of acts which will constitute prima facie evidence of lack of due diligence are: (1) abandonment of the application during appellate review; and (2) suspension of action under § 1.103(a) during appellate review.

137. Comment: One comment suggested that guidance be provided in the comments to the Notice of Final Rules identifying in what circumstances is a patent issued "pursuant to an appellate decision reversing an adverse determination of patentability."

Several comments questioned whether the reversal of all rejections on one of several appealed claims would entitle applicant to an extension under § 1.701(a)(3). Two comments suggested that the rule be redrafted to allow appropriate extension of term where the Board or a court reverses at least "in part."

Response: Extension of patent term under § 1.701(a)(3) is applicable if all the rejections of any one claim are ultimately reversed. The rule is clear and no clarification is needed.

138. Comment: One comment stated that § 1.701 does not address the situation where applicant appeals with both allowed and rejected claims. In such case, patent term extension should be available for any claims that were allowed prior to appellate review, if the allowed claims were in the same application, whether or not the decision of the examiner on the rejected claims is ultimately reversed. Applicant should not have to refile the allowed claims and rejected claims in separate cases in order to take advantage of the patent term extension.

Response: If applicant chooses to keep the allowed claims with the rejected claims in the application on appeal, patent term extension pursuant to 35 U.S.C. 154(b)(2) is only available if a patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review. If the appellate review is not successful, applicant will not be entitled to patent term extension.

139. Comment: One comment questioned whether the phrase "if the patent is not subject to a terminal disclaimer" in § 1.701(a)(3) is intended to be limited to those applications in which a terminal disclaimer has actually been filed or encompass those applications in which a double patenting rejection has been made and a terminal disclaimer suggested by an examiner.

Response: The calculation of any applicable extension under § 1.701 will be made prior to the mailing of the Notice of Allowance and Issue Fee Due. At that time, any double patenting rejection would have been resolved and a terminal disclaimer would have been filed if one was required.

140. Comment: One comment stated that § 1.701(d)(1) is inconsistent with 35 U.S.C. 154(b)(2) and (b)(3), because the period of extension for appellate review would be calculated under § 1.701(d)(1) by first subtracting the period of appellate review occurring within three years of the filing date before the five-year limit is imposed. It is suggested that § 1.701 be modified to be consistent with 35 U.S.C. 154(b)(2) which requires the five-year limit to be imposed before the subtraction for appellate review occurring within three years of the filing date.

Response: The suggestion has not been adopted. Section 1.701 is not inconsistent with 35 U.S.C. 154(b)(2) and (b)(3). The period of extension referred to in 35 U.S.C. 154(b)(2) is defined in 35 U.S.C. 154(b)(3). Therefore, one must determine the period of extension in 35 U.S.C. 154(b)(3)(A), then reduce that period by the time determined in 35 U.S.C. 154(b)(3)(B) and (b)(3)(C). Then, according to 35 U.S.C. 154(b)(2), the [*20220] resulting time period may not be more than five years.

141. Comment: One comment suggested that the Commissioner identify a senior person who is charged with approving all reductions in extension of patent term rather than leaving the decision to the examiner or the SPE.

One comment questioned who will make the calculation of the period of patent term extension under § 1.701 and whether that calculation can be challenged and by whom.

Response: It is contemplated that the period of patent term extension calculated and any reduction in the extension of patent term will not be made by an examiner. It is noted that the period of patent term extension will be identified in the Notice of Allowance and Issue Fee Due and if applicant disagrees with the period, applicant may request further review by way of a petition under § 1.181. If an error is noted after the patent issues, patentee or any third party may seek correction of the period of patent term extension granted by filing a request for a Certificate of Correction pursuant to § 1.322.

142. Comment: One comment questioned whether a challenge to the period of patent term extension calculated by the PTO under § 1.701 would be required to be made within a fixed period.

Response: No. However, the longer applicant delays filing a petition under § 1.181 challenging the period of extension calculated by the PTO, the less likely any error will be corrected before the patent is issued with the error printed on the patent. If the patent issues with an incorrect period of extension, applicant should file a request for a Certificate of Correction pursuant to § 1.322 instead of a petition under § 1.181.

143. Comment: One comment suggested that § 1.701(d)(2) be amended to require PTO to notify applicant in writing of any intent to reduce the term extension for lack of due diligence, stating the specific basis, and provide applicant with a reasonable opportunity to respond.

Response: The suggestion has not been adopted. The period of patent term extension will be identified in the Notice of Allowance and Issue Fee Due and if applicant disagrees with the period, applicant may request further review by way of a petition under § 1.181.

144. Comment: One comment suggested that a cover sheet for use in recording assignments be included in the final rules package as an addendum.

Response: The suggestion has not been adopted. A sample cover sheet for use in recording assignments was published as Appendix B in the **Federal Register** on July 6, 1992, at 57 FR 29634 and in the *Official Gazette* on July 28, 1992, at 1140 *Off. Gaz. Pat. Office* 63 and may be obtained from Assignment Branch.

Other Considerations

This final rule change is in conformity with the requirements of the Regulatory Flexibility Act, 5 U.S.C. 601 et seq., Executive Order 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 et seq. This final rule has been determined not to be significant for the purposes of E.O. 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that these final rule changes will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal impact of these changes is to provide a procedure for domestic applicants to quickly and inexpensively file a provisional application. The filing date of the provisional application will not be used to measure the term of a patent granted on an application which claims the earlier filing date of the provisional application.

The Patent and Trademark Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in E.O. 12612.

These final rules contain collections of information subject to the requirements of the Paperwork Reduction Act (Act). The provisional application has been approved by the Office of Management and Budget under control numbers 0651-0031 and 0651-0032. The cover sheet is approved under OMB control number 0651-0037. The cover sheet is necessary to expedite the processing of a provisional application and improve quality. Public reporting burden for the collection of information on the cover sheet is estimated to average 12 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing the burden to the Office of Assistance Quality and Enhancement Division, Patent and Trademark Office, Washington, D.C. 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, D.C. 20503 (ATTN: Paperwork Reduction Act Projects 0651-0031, 0651-0032, and 0651-0037).

List of Subjects**37 CFR Part 1**

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small businesses.

37 CFR Part 3

Administrative practice and procedure, Inventions and patents, Reporting and record keeping requirements.

For the reasons set forth in the preamble, 37 CFR Parts 1 and 3 are amended as follows:

PART 1--RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: *35 U.S.C. 6* unless otherwise noted.

2. Section 1.1 is amended by adding new paragraph (i) to read as follows:

§ 1.1 -- All communications to be addressed to Commissioner of Patents and Trademarks.

* * * * *

(i) The filing of all provisional applications and any communications relating thereto should be additionally marked "Box Provisional Patent Application."

* * * * *

3. Section 1.9 is amended by revising paragraph (a) to read as follows:

§ 1.9 -- Definitions.

(a)(1) A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under *35 U.S.C. 111*, or which entered the national stage from an international application after compliance with *35 U.S.C. 371*.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under *35 U.S.C. 111(b)*.

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under *35 U.S.C. 111(a)*, or which entered the national stage from an international [*20221] application after compliance with *35 U.S.C. 371*.

* * * * *

4. Section 1.12 is amended by revising paragraph (c) to read as follows:

§ 1.12 -- Assignment records open to public inspection.

* * * * *

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in secrecy under § 1.14, or any information with respect thereto, must

(1) Be in the form of a petition accompanied by the petition fee set forth in § 1.17(i), or

(2) Include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee or attorney or agent of record.

* * * * *

5. Section 1.14 is amended by revising paragraph (e) to read as follows:

§ 1.14 -- Patent applications preserved in secrecy.

* * * * *

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in secrecy pursuant to paragraphs (a) and (b) of this section, or any papers relating thereto, must

(1) Be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i), or

(2) Include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

* * * * *

6. Section 1.16 is amended by revising paragraphs (a) through (g) and by adding new paragraphs (k) and (l) to read as follows:

§ 1.16 -- National application filing fees.

(a) Basic fee for filing each application for an original patent, except provisional, design or plant applications:

By a small entity (§ 1.9(f)) L\$ 365.00

By other than a small entity L730.00

(b) In addition to the basic filing fee in an original application, except provisional applications, for filing or later presentation of each independent claim in excess of 3:

By a small entity (§ 1.9(f)) L38.00

By other than a small entity L76.00

(c) In addition to the basic filing fee in an original application, except provisional applications, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

By a small entity (§ 1.9(f)) L11.00

By other than a small entity L22.00

(d) In addition to the basic filing fee in an original application, except provisional applications, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§ 1.9(f)) L120.00

By other than a small entity L240.00

(If the additional fees required by paragraphs (b), (c), and (d) of this section are not paid on filing or on later presentation of the claims for which the additional fees are due, they must be paid or the claims canceled by amendment, prior to the expiration of the time period set for response by the Office in any notice of fee deficiency.)

(e) Surcharge for filing the basic filing fee or oath or declaration on a date later than the filing date of the application, except provisional applications:

By a small entity (§ 1.9(f)) L65.00

By other than a small entity L130.00

(f) Basic fee for filing each design application:

By a small entity (§ 1.9(f)) L150.00

60 FR 20195, *

By other than a small entity L300.00

(g) Basic fee for filing each plant application, except provisional applications:

By a small entity (§ 1.9(f)) L245.00

By other than a small entity L490.00

* * * * *

(k) Basic fee for filing each provisional application:

By a small entity (§ 1.9(f)) L75.00

By other than a small entity L150.00

(l) Surcharge for filing the basic filing fee or cover sheet (§ 1.51(a)(2)(i)) on a date later than the filing date of the provisional application:

By a small entity (§ 1.9(f)) L25.00

By other than a small entity L50.00

* * * * *

7. Section 1.17 is amended by revising paragraphs (h) and (i), and by adding new paragraphs (q), (r) and (s) to read as follows:

§ 1.17 -- Patent application processing fees.

* * * * *

(h) For filing a petition to the Commissioner under a section listed below which refers to this paragraph L130.00

§ 1.47--for filing by other than all the inventors or a person not the inventor

§ 1.48--for correction of inventorship, except in provisional applications

§ 1.84--for accepting color drawings or photographs

§ 1.182--for decision on questions not specifically provided for

§ 1.183--to suspend the rules

§ 1.295--for review of refusal to publish a statutory invention registration

§ 1.377--for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent

§ 1.378(e)--for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in expired patent

§ 1.644(e)--for petition in an interference

§ 1.644(f)--for request for reconsideration of a decision on petition in an interference

§ 1.666(c)--for late filing of interference settlement agreement

§§ 5.12, 5.13 and 5.14--for expedited handling of a foreign filing license

§ 5.15--for changing the scope of a license

§ 5.25--for retroactive license

(i) For filing a petition to the Commissioner under a section listed below which refers to this paragraph L130.00

§ 1.12--for access to an assignment record

§ 1.14--for access to an application

§ 1.53--to accord a filing date, except in provisional applications

§ 1.55--for entry of late priority papers

§ 1.60--to accord a filing date

§ 1.62--to accord a filing date

§ 1.97(d)--to consider an information disclosure statement

§ 1.102--to make application special

§ 1.103--to suspend action in application

§ 1.177--for divisional reissues to issue separately

§ 1.312--for amendment after payment of issue fee

§ 1.313--to withdraw an application from issue

§ 1.314--to defer issuance of a patent

§ 1.666(b)--for access to interference settlement agreement

§ 3.81--for patent to issue to assignee, assignment submitted after payment of the issue fee

* * * * *

(q) For filing a petition to the Commissioner under a section listed below which refers to this paragraph L50.00

§ 1.48--for correction of inventorship in a provisional application

*§ 1.53--to accord a provisional application a filing date or to convert an application filed under [*20222] § 1.53(b)(1) to a provisional application*

(r) For entry of a submission after final rejection under § 1.129(a):

By a small entity (§ 1.9(f)) L365.00

By other than a small entity L730.00

(s) For each additional invention requested to be examined under § 1.129(b):

By a small entity (§ 1.9(f)) L365.00

By other than a small entity L730.00

8. Section 1.21 is amended by revising paragraph (l) to read as follows:

§ 1.21 -- Miscellaneous fees and charges.

* * * * *

(l) For processing and retaining any application abandoned pursuant to § 1.53(d)(1) unless the required basic filing fee has been paid L\$ 130.00

* * * * *

9. Section 1.28 is amended by revising paragraph (a) to read as follows:

§ 1.28 -- Effect on fees of failure to establish status, or change status, as a small entity.

(a) The failure to establish status as a small entity (§§ 1.9(f) and 1.27 of this part) in any application or patent prior to paying, or at the time of paying, any fee precludes payment of the fee in the amount established for small entities. A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if a verified statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within two months of the date of payment of, the fee. Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application may rely on a verified statement filed in the prior application if the nonprovisional application includes a reference to the verified statement in the prior application or includes a copy of the verified statement in the prior application and status as a small entity is still proper and desired. Once status as a small entity has been established in an application or patent, the status remains in the application or patent without the filing of a further verified statement pursuant to § 1.27 of this part unless the Office is notified of a change in status.

* * * * *

10. Section 1.45 paragraph (c) is revised to read as follows:

§ 1.45 -- Joint inventors.

* * * * *

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

11. Section 1.48 is revised to read as follows:

§ 1.48 -- Correction of inventorship.

(a) If the correct inventor or inventors are not named in a nonprovisional application through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by:

(1) A petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred;

(2) An oath or declaration by each actual inventor or inventors as required by § 1.63;

(3) The fee set forth in § 1.17(h); and

(4) The written consent of any assignee. When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

(b) If the correct inventors are named in the nonprovisional application when filed and the prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are not inventors of the invention being claimed. The amendment must be diligently made and shall be accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and

(2) The fee set forth in § 1.17(h).

(c) If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended pursuant to paragraph (a) of this section to add claims to the subject matter and name the correct inventors for the application.

(d) If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the actual inventor or inventors, the provisional application may be amended to add the name or names of the actual inventor or inventors. Such amendment must be accompanied by:

(1) A petition including a statement that the error occurred without deceptive intention on the part of the actual inventor or inventors, which statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office; and

(2) The fee set forth in § 1.17(q).

(e) If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Such amendment must be accompanied by:

(1) A petition including a statement of facts verified by the person or persons whose name or names are being deleted establishing that the error occurred without deceptive intention;

(2) The fee set forth in § 1.17(q); and

(3) The written consent of any assignee.

12. Section 1.51 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.51 -- General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks.

(1) A complete application filed under § 1.53(b)(1) comprises:

(i) A specification, including a claim or claims, see §§ 1.71 to 1.77;

(ii) An oath or declaration, see §§ 1.63 and 1.68;

(iii) Drawings, when necessary, see §§ 1.81 to 1.85; and [*20223]

(iv) The prescribed filing fee, see § 1.16.

(2) A complete provisional application filed under § 1.53(b)(2) comprises:

(i) A cover sheet identifying:

(A) The application as a provisional application,

(B) The name or names of the inventor or inventors, (see § 1.41),

(C) The residence of each named inventor,

(D) The title of the invention,

(E) The name and registration number of the attorney or agent (if applicable),

(F) The docket number used by the person filing the application to identify the application (if applicable),

(G) The correspondence address, and

(H) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(ii) A specification as prescribed by 35 U.S.C. 112, first paragraph, see § 1.71;

(iii) Drawings, when necessary, see §§ 1.81 to 1.85; and

(iv) The prescribed filing fee, see § 1.16.

(b) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See §§ 1.97 and 1.98. No information disclosure statement may be filed in a provisional application.

* * * * *

13. Section 1.53 heading and paragraphs (a) through (e) are revised to read as follows:

§ 1.53 -- Application number, filing date, and completion of application.

(a) Any application for a patent received in the Patent and Trademark Office will be assigned an application number for identification purposes.

(b)(1) The filing date of an application for patent filed under this section, except for a provisional application, is the date on which: a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§ 1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed under this section, § 1.60 or § 1.62. A continuation-in-part application may be filed under this section or § 1.62.

(2) The filing date of a provisional application is the date on which: a specification as prescribed by 35 U.S.C. 112, first paragraph; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No amendment, other than to make the provisional application comply with all applicable regulations, may be made to the provisional application after the filing date of the provisional application. If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the provisional application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(q) is filed which sets forth the reasons the delay in supplying the names should be excused.

(i) A provisional application must also include a cover sheet identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under § 1.53(b)(1).

(ii) An application for patent filed under § 1.53(b)(1) may be treated as a provisional application and be accorded the original filing date provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of 12 months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. The grant of any such petition will not entitle applicant to a refund of the fees which were properly paid in the application filed under § 1.53(b)(1).

(iii) A provisional application shall not be entitled to the right of priority under § 1.55 or 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date under § 1.78 or 35 U.S.C. 120, 121 or 365(c) of any other application. No claim for priority under § 1.78(a)(3) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821

through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(c) If any application is filed without the specification, drawing or name, or names, of the actual inventor or inventors required by paragraph (b)(1) or (b)(2) of this section, applicant will be so notified and given a time period within which to submit the omitted specification, drawing, name, or names, of the actual inventor, or inventors, in order to obtain a filing date as of the date of filing of such submission. A copy of the "Notice of Incomplete Application" form notifying the applicant should accompany any response thereto submitted to the Office. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n). Any request for review of a refusal to accord an application a filing date must be by way of a petition accompanied by the fee set forth in § 1.17(i), if the application was filed under § 1.53(b)(1), or by the fee set forth in § 1.17(q), if the application was filed under § 1.53(b)(2).

(d)(1) If an application which has been accorded a filing date pursuant to paragraph (b)(1) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified, if a correspondence address has been provided and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one [*20224] year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (b)(2) of this section does not include the appropriate filing fee or the cover sheet required by § 1.51(a)(2), applicant will be so notified if a correspondence address has been provided and given a period of time within which to file the fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which the required basic filing fee has not been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application.

(e)(1) An application for a patent filed under paragraph (b)(1) of this section will not be placed upon the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(2) A provisional application for a patent filed under paragraph (b)(2) of this section will not be placed upon the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

* * * * *

14. Section 1.55 is revised to read as follows:

§ 1.55 -- Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a)-(d) and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by § 1.63. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (§ 1.630), when necessary to overcome the date of a reference relied

upon by the examiner, when specifically required by the examiner, and in all other cases, before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a petition requesting entry and by the fee set forth in § 1.17(i). If the certified copy filed is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

15. Section 1.59 is revised to read as follows:

§ 1.59 -- Papers of application with filing date not to be returned.

Papers in an application which has received a filing date pursuant to § 1.53 will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost of any application in which either the required basic filing fee (§ 1.16) or, if the application was filed under § 1.53(b)(1), the processing and retention fee (§ 1.21(1)) has been paid. See § 1.618 for return of unauthorized and improper papers in interferences.

16. Section 1.60 is amended by revising the heading and paragraph (b) to read as follows:

§ 1.60 -- Continuation or divisional application for invention disclosed in a prior nonprovisional application.

* * * * *

(b) An applicant may omit signing of the oath or declaration in a continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) if:

(1) The prior application was a nonprovisional application and a complete application as set forth in § 1.51(a)(1);

(2) Applicant indicates that the application is being filed pursuant to this section and files a true copy of the prior complete application as filed including the specification (with claims), drawings, oath or declaration showing the signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application;

(3) The inventors named in the continuation or divisional application are the same or less than all the inventors named in the prior application; and

(4) The application is filed before the patenting, or abandonment of, or termination of proceedings on the prior application. The copy of the prior application must be accompanied by a statement that the application papers filed are a true copy of the prior complete application. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting the filing date. If the continuation or divisional application is filed by less than all the inventors named in the prior application, a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application. Except as provided in paragraph (d) of this section, if a true copy of the prior application as filed is not filed with the application or if the statement that the application papers are a true copy is omitted, the application will not be given a filing date earlier than the date upon which the copy and statement are [*20225] filed, unless a petition with the fee set forth in § 1.17(i) is filed which satisfactorily explains the delay in filing these items.

* * * * *

17. Section 1.62 is amended by revising paragraphs (a) and (e) to read as follows:

§ 1.62 -- File wrapper continuing procedure.

(a) A continuation, continuation-in-part, or divisional application, which uses the specification, drawings and oath or declaration from a prior nonprovisional application which is complete as defined by § 1.51(a)(1), and which is to be abandoned, may be filed under this section before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application, or after payment of the issue fee if a petition under § 1.313(b)(5) is granted in the prior application. The filing date of an application filed under this section is the date on which a request is filed for an application under this section including identification of the application number and the names of the inventors named in the prior complete application. If the continuation, continuation-in-part, or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation, continuation-in-part, or divisional application.

* * * * *

(e) An application filed under this section will utilize the file wrapper and contents of the prior application to constitute the new continuation, continuation-in-part, or divisional application but will be assigned a new application number. Changes to the prior application must be made in the form of an amendment to the prior application as it exists at the time of filing the application under this section. No copy of the prior application or new specification is required. The filing of such a copy or specification will be considered improper, and a filing date as of the date of deposit of the request for an application under this section will not be granted to the application unless a petition with the fee set forth in § 1.17(i) is filed with instructions to cancel the copy or specification.

* * * * *

18. Section 1.63 is amended by revising paragraph (a) to read as follows:

§ 1.63 -- Oath or declaration.

(a) An oath or declaration filed under § 1.51(a)(1)(ii) as a part of a nonprovisional application must:

- (1) Be executed in accordance with either § 1.66 or § 1.68;
- (2) Identify the specification to which it is directed;
- (3) Identify each inventor and the residence and country of citizenship of each inventor; and
- (4) State whether the inventor is a sole or joint inventor of the invention claimed.

* * * * *

19. Section 1.67 is amended by revising paragraph (b) to read as follows:

§ 1.67 -- Supplemental oath or declaration.

* * * * *

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(d)(1) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper cases, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

* * * * *

20. Section 1.78 is amended by revising paragraphs (a)(1) and (a)(2) and by adding new paragraphs (a)(3) and (a)(4) to read as follows:

§ 1.78 -- Claiming benefit of earlier filing date and cross-references to other applications.

(a)(1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior application must be:

- (i) Complete as set forth in § 1.51(a)(1); or
- (ii) Entitled to a filing date as set forth in § 1.53(b)(1), § 1.60 or § 1.62 and include the basic filing fee set forth in § 1.16; or
- (iii) Entitled to a filing date as set forth in § 1.53(b)(1) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(d)(1).

(2) Any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross-references to other related applications may be made when appropriate. (See § 1.14(b)).

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed copending provisional applications. Since a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed prior to the Saturday, Sunday, or Federal holiday. In order for a nonprovisional application to claim the benefit of one or more prior filed copending provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be:

- (i) Complete as set forth in § 1.51(a)(2); or
- (ii) Entitled to a filing date as set forth in § 1.53(b)(2) and include the basic filing fee set forth in § 1.16(k).

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the [*20226] provisional application number (consisting of series code and serial number).

* * * * *

21. Section 1.83 is amended by revising paragraphs (a) and (c) to read as follows:

§ 1.83 -- Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

* * * * *

(c) Where the drawings in a nonprovisional application do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

22. Section 1.97 is amended by revising paragraph (d) to read as follows:

§ 1.97 -- Filing of information disclosure statement.

* * * * *

(d) An information disclosure statement shall be considered by the Office if filed after the mailing date of either a final action under § 1.113 or a notice of allowance under § 1.311, whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by:

- (1) A certification as specified in paragraph (e) of this section;
- (2) A petition requesting consideration of the information disclosure statement; and
- (3) The petition fee set forth in § 1.17(i).

* * * * *

23. Section 1.101 is amended by revising paragraph (a) to read as follows:

§ 1.101 -- Order of examination.

(a) Nonprovisional applications filed in the Patent and Trademark Office and accepted as complete applications are assigned for examination to the respective examining groups having the classes of inventions to which the applications relate. Nonprovisional applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which examination has been advanced pursuant to § 1.102. See § 1.496 for order of examination of international applications in the national stage.

* * * * *

24. Section 1.102 is amended by revising paragraph (d) to read as follows:

§ 1.102 -- Advancement of examination.

* * * * *

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the petition fee set forth in § 1.17(i).

25. Section 1.103 is amended by revising paragraph (a) to read as follows:

§ 1.103 -- Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in § 1.17(i). Action will not be suspended when a response by the applicant to an Office action is required.

* * * * *

26. A new, undesignated center heading and new section 1.129 are added to Subpart B-National Processing Provisions to read as follows:

Transitional Provisions

§ 1.129 -- Transitional procedures for limited examination after final rejection and restriction practice.

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second

submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995; taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121, and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for [*20227] electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

27. Section 1.137 is amended by revising paragraph (c) to read as follows:

§ 1.137 -- Revival of abandoned application.

* * * * *

(c) In all applications filed before June 8, 1995, and in all design applications filed on or after June 8, 1995, any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment of the application, must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought.

* * * * *

28. Section 1.139 is added to read as follows:

§ 1.139 – Revival of provisional application.

(a) A provisional application which has been accorded a filing date and abandoned for failure to timely respond to an Office requirement may be revived so as to be pending for a period of no longer than twelve months from its filing date if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. Under no circumstances will the provisional application be pending after twelve months from its filing date. A petition to revive an abandoned provisional application must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by:

(1) The required response unless it has been previously filed;

(2) The petition fee as set forth in § 1.17(l); and

(3) A showing that the delay was unavoidable. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(b) A provisional application which has been accorded a filing date and abandoned for failure to timely respond to an Office requirement may be revived so as to be pending for a period of no longer than twelve months from its filing date if the delay was unintentional. Under no circumstances will the provisional application be pending after twelve months from its filing date. A petition to revive an abandoned provisional application must be:

(1) Accompanied by the required response unless it has been previously filed;

(2) Accompanied by the petition fee as set forth in § 1.17(m);

(3) Accompanied by a statement that the delay was unintentional. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Filed either:

(i) Within one year of the date on which the provisional application became abandoned; or

(ii) Within three months of the date of the first decision on a petition to revive under paragraph (a) of this section which was filed within one year of the date on which the provisional application became abandoned.

(c) Any request for reconsideration or review of a decision refusing to revive a provisional application upon petition filed pursuant to paragraphs (a) or (b) of this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision.

(d) The time periods set forth in this section cannot be extended, except that the three-month period set forth in paragraph (b)(4)(ii) of this section and the time period set forth in paragraph (c) of this section may be extended under the provisions of § 1.136.

29. Section 1.177 is revised to read as follows:

§ 1.177 – Reissue in divisions.

The Commissioner may, in his or her discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§ 1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in § 1.17(i), all the divisions of a reissue will issue simultaneously; if there is any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner orders otherwise.

30. Section 1.312 is amended by revising paragraph (b) to read as follows:

§ 1.312 – Amendments after allowance.

* * * * *

(b) Any amendment pursuant to paragraph (a) of this section filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in § 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

31. Section 1.313 is amended by revising paragraph (a) to read as follows:

§ 1.313 -- Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. Any such petition by the applicant must include a showing of good and sufficient reasons why withdrawal of the application is necessary and, if the reason for the withdrawal is not the fault of the Office, must be accompanied by the fee set forth in § 1.17(i). If the application is withdrawn from issue, a new notice of allowance will be sent if the application is again allowed. Any amendment accompanying a petition to withdraw an application from issue must comply with the requirements of § 1.312.

* * * * *

32. Section 1.314 is revised to read as follows:

§ 1.314 -- Issuance of patent.

If payment of the issue fee is timely made, the patent will issue in regular course unless the application is withdrawn from issue (§ 1.313), or issuance of the patent is deferred. Any petition by the applicant requesting a deferral of the issuance of a patent must be accompanied by the fee set forth in § 1.17(i) and must include a showing of good and sufficient reasons why it is necessary to defer issuance of the patent. [*20228]

33. Section 1.316 is amended by revising paragraph (d) to read as follows:

§ 1.316 -- Application abandoned for failure to pay issue fee.

* * * * *

(d) In all applications filed before June 8, 1995, any petition pursuant to paragraph (b) of this section not filed within six months of the date of abandonment of the application, must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought.

* * * * *

34. Section 1.317 is amended by removing and reserving paragraph (d).

§ 1.317 -- [Amended]

35. Section 1.666 is amended by revising paragraph (b) to read as follows:

§ 1.666 -- Filing of interference settlement agreements.

* * * * *

(b) If any party filing the agreement or understanding under paragraph (a) of this section so requests, the copy will be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person upon petition accompanied by the fee set forth in § 1.17(i) and on a showing of good cause.

* * * * *

36. Section 1.701 is added to Subpart F to read as follows:

§ 1.701 -- Extension of patent term due to prosecution delay.

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference proceedings under *35 U.S.C. 135(a)*; and/or

(2) The application being placed under a secrecy order under *35 U.S.C. 181*; and/or

(3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under *35 U.S.C. 141* or *145*, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under *35 U.S.C. 135(a)* not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under *35 U.S.C. 181*;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under *35 U.S.C. 134* and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under *35 U.S.C. 141* or a civil action under *35 U.S.C. 145*.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

PART 3--ASSIGNMENT, RECORDING, AND RIGHTS OF ASSIGNEE

37. The authority citation for 37 CFR Part 3 continues to read as follows:

Authority: *15 U.S.C. 1123*; *35 U.S.C. 6*.

38. Section 3.21 is revised to read as follows:

60 FR 20195, *

§ 3.21 -- Identification of patents and patent applications.

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, e.g., 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international number (e.g., PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b)(1) or § 1.62 is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended. [*20229]

39. Section 3.81 is amended by revising paragraph (b) to read as follows:

§ 3.81 -- Issue of patent to assignee.

* * * * *

(b) If the assignment is submitted for recording after the date of payment of the issue fee, but prior to issuance of the patent, the assignee may petition that the patent issue to the assignee. Any such petition must be accompanied by the fee set forth in § 1.17(i) of this chapter.

Dated: April 14, 1995.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

Note-The following appendix will not appear in the Code of Federal Regulations.

Appendix

See Appendix A--Provisional Application Cover Sheet on Page 20230 in Original Document.

See Appendix B--Declaration for Patent Application on Page 20231 in Original Document.

[FR Doc. 95-9838 Filed 4-24-95; 8:45 am]

BILLING CODE 3510-16-C



Provisional Applications and 35 USC 102(e) in View of *Milburn, Hilmer and Wertheim*

Andrew J. Patch¹

This paper considers what should be the effective date for reference purposes of a U.S. patent that claims the priority of a provisional application. In particular, should the “102(e) date” of such a patent be the filing date of the provisional application filed under 35 USC §111(b), or should it instead be the later filing date of the application for patent filed under 35 USC §111(a)?

BACKGROUND

The recently-enacted legislation implementing GATT, among many other changes, rewrites 35 USC §111 to allow filing so-called “provisional applications”. The terms of new §111 pertaining to provisional applications appear at 35 USC §111(b). The regular type of U.S. patent application is now described in 35 USC §111(a). Several of the more important provisions of new §111 which distinguish §111(b) provisional applications from §111(a) “normal” applications are:

1. Provisional applications cannot claim priority under §120 or §119 of any earlier-filed domestic or foreign application (35 USC §111(b)(7)),
2. A provisional application is automatically abandoned 12 months after it is filed (§111(b)(5)), and will not be examined (§111(b)(8), “. . . provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title”), and
3. No claim is required to be presented in a provisional application (§111(b)(2)).

¹ The author is a partner in the Arlington, Virginia firm of Young & Thompson.

The statute is elsewhere substantively amended to specify provisional application practice. Foremost among these substantive amendments are:

1. A new subsection of §119, 35 USC §119(e), allows a regular §111(a) application to claim the priority of an earlier-filed provisional application, subject to payment of fees and maintenance of copendency (as for §120 priority), and otherwise subject to similar requirements for claiming foreign priority under previous §119 (now §119(a)-(d)).

2. New §154, which deals with the new 20-year patent term, states at §154(a)(3) that priority under §119 (i.e. including §119(e)) shall not be taken into account when determining the term of a patent. So the twenty year term of a patent claiming priority under §119(e) of a provisional application, begins to run only from the later filing date of the regular §111(a) application.

The GATT-implementing legislation makes no change in 35 USC §102(e).

THE USPTO POLICY

Although neither the new statute nor the new rules specifically address the question considered by this paper, the USPTO has announced its view of the question. In particular, the current PTO policy is that the §102(e) date of a U.S. patent that claims priority under §119(e) of a provisional application, will be the filing date of the provisional application, rather than the later filing date of the §111(a) application. As support for that interpretation, the PTO relies on the language of new section §111, presumably §111(b)(8), whose text is as follows:

(8) APPLICATION PROVISIONS.—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

This portion of §111 seems to support the PTO view that a provisional application should be considered an "application for patent" when reading the statute, notwithstanding that a provisional application can by definition never become a patent.

What remains unanswered, however, is whether a provisional application can be properly considered as an "application for patent" *within the meaning of 35 USC §102(e)*.

THE MILBURN CASE

35 USC §102(e) owes its existence to the opinion of Justice Holmes in the case of *The Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), as that section of the statute was intended to be a codification of the ruling in that case. In *Milburn*, the effective date of a U.S. patent for reference purposes was held to be the filing date of the patent application, rather than the issue date of the patent. The rationale underlying that holding is all-important, and the reasoning of the court is reproduced in pertinent part as follows:

... if Whitford had not applied for his patent until after the issue to Clifford, the disclosure by the latter would have had the same effect as the publication of the same in a periodical, although not made the basis of a claim. . . . The invention is made public property as much in one case as in the other. But if this be true, as we think that it is, it seems to us that a sound distinction cannot be taken between that case and a patent applied for but not granted until after a second patent is sought. The delays of the Patent Office ought not to cut down the effect of what has been done. . . . [Clifford] had done all that he could do to make his description public. He had taken steps that would make the invention public as soon as the Patent Office did its work, although, of course, amendments might be required of him before the end could be reached.

In short, if the Patent Office were "divinely efficient"², a U.S. patent would issue the same day it is filed. The court in *Milburn* imputed to the Patent Office this divine efficiency in determining the reference date of U.S. patents.

The genesis of 35 USC 102(e) as embodied in the *Milburn* decision thus presents the single most compelling reason why the above-noted PTO policy is incorrect: a provisional application by definition could not become a U.S. patent on the same day it is filed (indeed, it can never become a patent), and therefore it cannot be considered an application for patent within the meaning of §102(e).

IN RE WERTHEIM AND MISHKIN

Further guidance on this question is provided by the case of *In re Wertheim and Mishkin*, 209 USPQ 554 (CCPA 1981)³. The *Wertheim* court was required to determine the §102(e) date of a patent that issued from a series of continuing applications which included a continuation-

² Kayton, 1 Patent Practice 4-28 (PRI 1993).

³ This case is sometimes referred to as *Wertheim II*, and is not to be confused with "*Wertheim I*", *In re Wertheim*, 191 USPQ 90 (CCPA 1976), which latter case is not relevant to this discussion.

in-part (CIP) application that added new matter to the original disclosure.

Judge Rich, writing for the court *en banc*⁴, held that the earliest 102(e) date available to the reference patent was the date on which the disclosure satisfied the requirements of §112, first paragraph, as to the invention claimed in the issued patent. In that case, the §102(e) date was the CIP filing date, as the new matter was essential for providing §112 first paragraph support for the issued claims.

The reasoning of the court in *Wertheim* relied heavily on the *Milburn* doctrine, and culminated at 209 USPQ 564 as follows:

For if a patent *could not* theoretically have issued the day the application was filed, it is not entitled to be used against another as "secret prior art," the rationale of *Milburn* being inapplicable, as noted above. In other words, we will extend the "secret prior art" doctrine of *Milburn* and *Hazeltine* only as far as we are required to do so by the logic of those cases. (emphasis original).

The *Wertheim* case certainly involved a quite different fact situation than that considered by this article. Nevertheless, the conclusion quoted above applies with equal force to the case of a patent claiming §119(e) priority of a provisional application.

Moreover, it is not only the conclusion of *Wertheim*, but also the underlying policy rationale, that applies equally to the different fact situation at hand. Even assuming that the disclosure of a provisional application is *identical* to that of a later-filed §111(a) application, the applicant, in filing the provisional application, has *not* "done all that he could do to make his description public" by taking "steps that would make the invention public as soon as the Patent Office did its work" as contemplated in *Milburn*. Instead, the applicant who files a provisional application has merely preserved for 12 months the option of so doing at some later time, without prejudice to his ability to prove his priority of invention.

HILMER I

In the case of *In re Hilmer et al*, 149 USPQ 480 (CCPA 1966), hereinafter "*Hilmer I*", the CCPA considered whether the §102(e) date of a patent claiming foreign priority under §119 should be the foreign priority date or only the actual U.S. filing date. Of course, the outcome of that case was that a patent is prior art under §102(e) only as of its

⁴ The CCPA always sat *en banc*.

actual U.S. filing date, and not as of any foreign priority date that it might claim under §119.

The holding in *Hilmer I* is accompanied by a very lengthy discussion of the policy considerations presented by the facts of that case. Much of the discussion involved the requirement that the application for patent mentioned in §102(e) must be filed in the United States, with the court holding that this was not true of a foreign priority application even considering the "shall have the same effect" language of §119. Thus, the court noted at 149 USPQ 497 that the "same effect" phrase does not have entirely the same meaning in §119, as it does in §120.

It is also interesting to note the court's discussion of *Milburn* at 149 USPQ 495, which reveals a certain antipathy toward the *Milburn* doctrine inasmuch as it creates a class of so-called "secret prior art", and an aversion toward extending that doctrine unnecessarily. The court in *Hilmer I* largely based its holding on the fact that a foreign priority application is not an application filed in the United States, as required by §102(e); however, it could equally have based its holding on the fact that a foreign priority application could not become a U.S. patent on the same day it was filed abroad, and therefore does not respond to the *Milburn* rationale.

HILMER II

The second Hilmer case, *In re Hilmer et al*, 165 USPQ 255 (CCPA 1970), "*Hilmer II*", decided whether a patent claiming foreign priority could be prior art under §102(g) as of the foreign filing date. The reader will recall that the answer in this case was also "no", with the court relying on its opinion in *Hilmer I* and in particular relying almost exclusively on the fact that §102(g) requires that the prior invention by another be made "in this country".

The reasoning in *Hilmer II* would therefore seem not to apply to the question at hand, because a provisional application is filed in the U.S., and should apparently be considered a constructive reduction to practice (i.e., a "making") by an applicant of his invention. For example, in an interference, a party whose case claims §119(e) priority of a provisional application, should be able to move pursuant to 37 CFR §1.633(f) to be accorded the benefit of that application. The content of such a motion would include the normal showing that the provisional application discloses in the manner required by the first paragraph of 35 USC §112, at least one embodiment within the scope of the count.

Moreover, §102(g), unlike §102(e), is not attended by the *Milburn/Wertheim* rationale limiting the effective prior art date to the first day when a patent could have theoretically issued with the claims that are eventually patented. Therefore, it would seem at first blush that the PTO policy would be more tenable if a U.S. patent were treated as prior art under §102(g) as of the provisional application filing date, rather than §102(e) prior art as of that date.

But on closer scrutiny, the PTO policy appears also to be untenable under §102(g). Indeed, it appears necessary to draw a distinction between constructive reductions to practice and actual reductions to practice. Although both types of reduction to practice may be relied upon by an applicant or patentee to establish priority of his own invention, only the latter type of reduction to practice may be relied upon as a patent-defeating prior art event available for use against someone else's application or patent.

Initially, it is noted that the author is unaware of any case in which a constructive reduction to practice has ever before been relied upon as §102(g) *prior art*, that is, outside the context of an interference priority context⁵. Of course, there has not before been any need of such reliance, with *Hilmer II* holding that a foreign priority application does not establish a §102(g) prior art date, and with §102(e) already specifically providing for the case of regular (§111(a)) applications.

The more compelling reason why a U.S. patent should not be §102(g) prior art as of a provisional application filing date, arises from an exercise in statutory construction. That is, if the filing of a provisional application secures a 102(g) prior art date, then so also would the filing of a regular §111(a) application. Thus, *any* type of U.S. patent application would become §102(g) prior art as of its actual U.S. filing date. It follows that, according to this interpretation, §102(e) *would be entirely redundant of §102(g)*.

But Congress, in enacting 35 USC §102(e), presumably intended to say something not already covered by §102(g). Therefore, only §102(e), and not §102(g), may be regarded as treating the case of a U.S. patent being prior art as of its U.S. filing date; and, consequently, a constructive reduction to practice cannot be a prior art event unless it also responds to the requirements of §102(e).

⁵ Which includes the *concession* of prior invention under §102(g) that can arise from refusing to copy claims suggested by the Patent Office in a "make or break letter", for the purpose of instituting an interference. See, e.g., *In re Oguie*, 186 USPQ 227 (CCPA 1975) and *In re Phillips*, 213 USPQ 353 (CCPA 1981).

Moreover, if the PTO policy were correct under §102(g), there would be created a new category of "secret prior art", which the courts consider to be contrary to public policy. See, e.g., *Kimberly-Clark Corp. v. Johnson & Johnson*, 223 USPQ 603 (Fed.Cir. 1984):

... the use of such secret art—as §103 "prior art"—except as required by §102(e), is not favored for reasons of public policy. 223 USPQ at 607.

It therefore appears that a U.S. patent that claims §119(e) priority of a provisional application, should be prior art only as of the later filing date of the regular §111(a) application for patent, since it would not qualify under any subsection of §102 as of the earlier provisional application filing date.

THE "EQUAL FOOTING" ARGUMENT

One of the reasons given by the PTO for the enactment of §111(b) and §119(e) is that it puts U.S. applicants on an "equal footing" with foreign applicants. And in some senses it does. The new law gives U.S. applicants, like foreign applicants, a mechanism for obtaining an early effective filing date, without starting the twenty-year patent term running. It also provides a convenient mechanism for showing an early constructive reduction to practice, which might in some cases obviate Rule 131 practice and simplify interference procedure.

But as to the prior art date of patents claiming foreign priority versus patents claiming §119(e) priority, the PTO policy would entrench the *unequal footing* that is otherwise largely alleviated by the amendments to §104. *Hilmer I* and *II* make clear that a U.S. patent is not prior art as of its foreign priority date; but if a U.S. patent *is* prior art as of its provisional application filing date, then the inequality of the *Hilmer* doctrine perceived by many foreign applicants would only be worsened. Although it is true that foreign applicants are theoretically free to file their own provisional applications, the prohibition in §111(b)(7) against a provisional application itself claiming the priority of any earlier filed applications (i.e., the foreign applicant's earlier-filed home application) means that as a practical matter this is not going to happen.

If the PTO policy were correct (under 102(e) or 102(g)), then on a cosmetic level the *Hilmer* doctrine would become rather unwieldy. In particular, the adage that "Priority under §119 is a shield, not a sword," would instead become—Priority under §119, subsections (a)–(d), is a shield, not a sword; however, priority under §119(e) may be both a

shield and a sword, provided the §111(b) application whose benefit is sought supports the claimed invention in the manner specified in the first paragraph of 35 USC §112—.

It is interesting in this regard to consider why the text of new §119(e) was included in §119, rather than in §120. Previously, there was a rather neat division between the two sections, in that the former governed claims to foreign priority, whereas the latter governed claims to domestic priority. Now, a new and different type of domestic priority has been created, which, however, is treated by §119.

But provisional applications have in common with foreign priority applications a feature not shared by regular §111(a) applications: provisional applications, like foreign priority applications can never become a U.S. patent. Thus, as to the U.S., provisional applications and foreign priority applications are both useful only for obtaining an earlier priority date. It therefore appears that a provisional application is more nearly akin to a foreign priority application, and that inclusion of the text of §119(e) in §119 is logical. Of course, the characteristics in common between provisional applications and foreign priority applications also give rise to the reasons why a provisional application filing date cannot be a §102(e) or §102(g) prior art date.

THE PCT ANOMALY

A particularly bizarre consequence of the PTO policy arises in the case of PCT applications entering the U.S. national phase, from an international application which in turn claims §119(e) priority of a provisional application. According to the PTO policy, a §102(e) date would be obtained upon filing the provisional application. That date would survive the filing of the PCT international application, but would then be extinguished, twenty or thirty months later, upon entry into the national phase under §371(c). This is because §102(e) expressly specifies, consistent with *Milburn*, that a U.S. patent issuing from the national phase of a PCT application is prior art only as of the day that the PTO could theoretically have issued the patent.

The effect of entry into the national phase under §371(c) can be avoided by exercising the so-called "by-pass route", which involves filing a regular §111(a) application during the pendency of the international application, in lieu of entering the national phase under §371(c), and claiming §120 priority of the international application. According to the PTO interpretation, this bit of gymnastics would preserve the early §102(e) date of the provisional application. However,

according to the reasoning of *Milburn* and *Wertheim*, the §102(e) date would in fact be only the date on which the §111(a) application was filed, as this is the first day that the PTO could theoretically issue a patent on any of the series of applications.

CONCLUSION

If the PTO maintains its present policy, then in another several years or so there will inevitably be a case determining the propriety of that policy, which case would be analogous to *Hilmer I* and *Hilmer II*, but would necessarily decide the question based on somewhat different considerations. We might think of this future case as "*Hilmer III*", although it will be the name of a different applicant that will be thereby memorialized in this wonderfully esoteric area of U.S. patent practice. It is believed that the outcome of "*Hilmer III*" will also be analogous to the decisions in *Hilmer I* and *Hilmer II*, perhaps based on a more fully articulated version of the reasoning offered in this article.